United States Court of Appeals
for the
District of Columbia Circuit

TRANSCRIPT OF RECORD

JOINT APPENDIX

United States Court of Appeals

838

FOR THE DISTRICT OF COLUMBIA CIRCUIT

APPEAL NO. 14,066

ROBERT C. WATSON, COMMISSIONER OF PATENTS,
APPELLANT
v.
THOMAS J. ALLEN, APPELLEE

APPEAL FROM THE JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

CLARENCE W. MOORE,
Solicitor, United States Patent Office.

S. W. COCHRAN,
Of Counsel.

United States Court of Appeals
For the
District of Columbia Circuit

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Joseph W. Stewart
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INDEX

Page
Complaint — 1a
Answer to the Complaint — 8a
Excerpts From Trial Testimony — 9a
Excerpts From Plaintiff's Exhibit 5, Transcript of Record, United States Court of Customs and Patent Appeals, *Allen* v. *Blaisdell and Cocklin,* Patent Appeal Docket No. 5838 — 32a
Plaintiff's Exhibit 5–A
Excerpts From Defendant's Exhibit 1 — 112a
  Flinn Patent No. 1,421,441 — 114a
  Decision of Board of Appeals — 116a
  Decision of Board of Appeals on Petition for Reconsideration — 134a
Memorandum Opinion of District Court — 139a
Findings of Fact — 140a
Conclusions of Law — 149a
Judgment — 150a
Notice of Appeal — 151a

INDEX

Page
Complaint ---------- 1a
Answer to the Complaint ---------- 8a
Excerpts From Trial Testimony ---------- 9a
Excerpts From Plaintiff's Exhibit 5, Transcript of Record, United States Court of Customs and Patent Appeals, *Allen* v. *Blaisdell and Cocklin,* Patent Appeal Docket No. 5838 ---------- 32a
Plaintiff's Exhibit 5–A ----------
Excerpts From Defendant's Exhibit 1 ---------- 112a
  Flinn Patent No. 1,421,441 ---------- 114a
  Decision of Board of Appeals ---------- 116a
  Decision of Board of Appeals on Petition for Reconsideration ---------- 134a
Memorandum Opinion of District Court ---------- 139a
Findings of Fact ---------- 140a
Conclusions of Law ---------- 149a
Judgment ---------- 150a
Notice of Appeal ---------- 151a

In the United States District Court for the District of Columbia

Civil Action No. 3236–55

THOMAS J. ALLEN, 1069½ EAST SPAZIER, BURBANK, CALIFORNIA, PLAINTIFF

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS, WASHINGTON 25, D. C., DEFENDANT

Filed July 22, 1955. Harry M. Hull, Clerk.

Complaint

To the Honorable Judges of the United States District Court for the District of Columbia:

1. Thomas J. Allen, plaintiff herein, is a citizen of the United States of America and a resident of Burbank, California.

2. Robert C. Watson, defendant herein, is the Commissioner of Patents of the United States, a legal resident of the District of Columbia, and is sued in his official capacity.

3. This action is brought under the provisions of Sec. 145, United States Code Title 35. No appeal has been filed in the United States Court of Customs and Patent Appeals.

4. Plaintiff Thomas J. Allen filed an application entitled Insert Bearing Structure and Shim Therefor on April 19, 1946, which was identified by Serial No. 663,494, and said application was filed in accordance with the laws of the United States and the rules of the Patent Office. The application was passed upon in the first instance by the Primary Examiner who al-

lowed claims 16, 17, 18, 19 and 20 in an Action of August 30, 1948, and suggested an additional claim for the purposes of interference. Such suggested claim was added to the application as claim No. 21.

5. Interference No. 83,587 was declared by the Patent Office on November 8, 1948, between this applicant Allen and parties Blaisdell and Cocklin with respect to claim No. 21. This interference was won by the party Blaisdell in the Patent Office, the decision being affirmed by the Court of Customs and Patent Appeals in a decision of March 18, 1952 and reported at 93 USPQ 428.

6. On November 8, 1948, the Patent Office declared Interference No. 83,588 between Allen and Cocklin with respect to the subject matter of Allen's claims 16 and 20. In this interference Allen was awarded priority by a decision of July 31, 1950, from which no appeal was taken.

7. The two interferences Nos. 83,587 and 83,588 were declared by the same Division of the Patent Office, were tried on a common record, and were argued together at the same hearing.

8. The party Cocklin at final hearing on the two interferences urged that the counts in both interferences were unpatentable because of public use estabilshed by records of the parties Allen and Blaisdell and requested a recommendation to the Commissioner of Patents that public use proceedings be instituted, but the Board of Interference Examiners disagreed and declined to make such recommendation.

9. On or about August 29, 1950, the party Cocklin petitioned the Commissioner of Patents to institute

public use proceedings and hold that the counts of the two interferences were unpatentable because of public use established by the record. Cocklin's petition was granted in a decision dated October 12, 1950.

10. The decision on the petition held that a prima facie case of public use against the counts of both interferences was made out by Allen's record and that a prima facie case aaginst the count of Interference 83, 587 was made out by Blaisdell's record.

11. After proceedings before the Primary Examiner, the Primary Examiner on May 14, 1953, rendered a decision holding that the record of Allen established public use against the counts of both interferences and that the record of Blaisdell established public use against the count of interference 83,587.

12. On June 15, 1953, the Primary Examiner entered an action on this application in which claims 16, 17, 19 and 20 were rejected because of the public use decision by the Primary Examiner; claim 18 was rejected for the same reason in combination with a new reference, and claim 21 because of res judicata. In response to the Official Action of June 15, 1953, applicant canceled claim 21 and added claims 22 through 28.

13. On September 29, 1953, all of the claims in the application were finally rejected by the Primary Examiner. On March 12, 1954, applicant filed an amendment adding claims 29 to 32 for the purpose of appeal and on or about March 22, 1954, filed an appeal to the Patent Office Board of Appeals.

14. The Patent Office Board of Appeals in a decision dated April 29, 1955, affirmed the decision of

the Examiner as to claims 16, 17, 18, 19, 20, 22, 25, 27 and 28, but reversed the Examiner as to claims 23, 24, 26, 29, 30, 31 and 32, but made a new rejection of claims 16, 17, 18, 19, 20, 22, 23, 24, 25, and 26, the net result being that claims 29, 30, 31, and 31 were allowed.

15. On May 6, 1955, applicant petitioned the Board of Appeals for reconsideration but such petition was denied as to making any change in the decision on June 24, 1955.

16. On July 6, 1955, applicant petitioned the Commissioner of Patents to exercise his supervisory authority and reverse the decision of the Board of Appeals, but no decision has yet been rendered on this petition.

17. The rejected claims are:

> 16. A shim for disposition between a shaft engaging bearing insert and its holder for compensating for a greater degree of wear over an intermediate portion of said insert than at the ends thereof, said shim comprising a metal sheet of foil-like thickness and of such thickness and flexibility as to be readily distortable about said insert, the intermediate portion of said shim which is designed to be disposed adjacent the portion of the insert having the greater degree of wear being at least substantially twice the thickness of one of the portions of the shim to be disposed adjacent the ends of the insert.
>
> 17. A shim designed for insertion between the insert and holder of a friction bearing for taking up wear on the bearing surface of the insert, said shim comprising a metallic sheet of foil-like thickness and of such flexibility as to

be readily distortable about said insert, said shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest wear of the insert.

18. A multiple shim stock sheet from which one or more shims can be detached for insertion between the insert and holder of a friction bearing for taking up wear, said sheet being of foil-like thickness and of such flexibility as to be readily distortable about said insert with each shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest wear of the insert.

19. In a bearing a bearing cap, a removable bearing insert carried by said cap, and a shim located between said cap and said insert, said shim comprising a metal sheet of foil-like thickness and of such thickness and flexibility as to be readily distortable about said insert, the intermediate portion of said shim which is designed to be disposed adjacent the portion of the insert having the greater degree of wear being at least substantially twice the thickness of one of the portions of the shim to be disposed adjacent the ends of the insert.

20. In a bearing a bearing cap, a removable bearing insert carried by said cap, and a shim located between said cap and said insert, said shim comprising a metallic sheet of foil-like thickness and of such flexibility as to be readily distortable about said insert, said shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest wear of the insert.

22. A shim for disposition between a shaft engaging bearing insert and its holder for compensating for a greater degree of wear over the intermediate portion of said insert than at the ends thereof, said shim comprising a flexible rolled metal sheet of foil-like thickness capable of being readily distortable about said insert, the intermediate portion of said shim which is designed to be disposed adjacent the portion of the insert having the greater degree of wear being rolled to a thickness substantially twice the thickness of the portions of the shim to be disposed adjacent the ends of the insert.

23. A shim comprising a rolled one piece flexible body of foil-like thickness readily distortable about a bearing insert with the intermediate portion of the shim designed to be disposed adjacent a portion of the insert having the greater degree of wear and of a thickness at least substantially twice that of the thickness of the portions of the shim to be disposed adjacent the ends of the insert.

24. A one piece flexible shim fabricated from metal and in which metal is transposed in a manner to provide a shim of foil-like thickness capable of being readily distorted about a bearing insert said shim being tapered from its central portion to both edges thereof.

25. A rolled multiple shim stock sheet from which one or more shims can be detached for insertion under a shaft bearing, said sheet being formed of shim stock and tapered from the center to both edges thereof.

26. A rolled multiple shim stock sheet from which one or more shims can be detached for insertion between the insert and the holder of

a friction bearing for taking up wear, said sheet being a one piece flexible body of foil-like thickness such that when a shim is detached it may be readily distortable about an insert and having a thickened portion intermediate its ends.

27. The method of producing a shim for disposition between a shaft engaging bearing insert and its holder comprising rolling metal into a flexible sheet of foil-like thickness with the intermediate portion of the sheet at least twice as thick as the edges thereof and a section of said sheet across said intermediate and edge portions of the sheet providing a shim readily distortable about a bearing insert and of greater length whereby the ends may be detached to make the shim conform to the size of the bearing insert.

28. A method of producing a bearing shim for disposition between a shaft engaging bearing and its holder comprising rolling a metallic sheet into a relatively thin foil-like body tapered from the center to both edges thereof.

18. The decision of the Board of Appeals adjudging that applicant is not entitled to a patent including the rejected claims was erroneous and contrary to law.

19. Plaintiff makes profert of a copy of the aforesaid application and of proceedings and papers in the file thereof together with a copy of the reference relied on and of the records in the interference proceedings to which reference has been made.

Wherefore, Plaintiff respectfully prays for judgment that the Commissioner of Patents be authorized to issue to the plaintiff Letters Patent of the United States including the rejected claims, namely, 16, 17, 18, 19, 20, 22, 23, 24, 25, 26, 27, and 28, or for any part thereof as the facts in the case may appear and for such other and further relief as may be just and equitable.

A. Yates Dowell, Jr.,
A. YATES DOWELL and
A. YATES DOWELL, JR.,
Attorneys for Plaintiff,
1158 Munsey Building, Washington 4, D. C.

WASHINGTON, D. C., *July 22, 1955.*

In the United States District Court for the District of Columbia

Civil Action No. 3236–55

THOMAS J. ALLEN, PLAINTIFF
v.
ROBERT C. WATSON, COMMISSIONER OF PATENTS, DEFENDANT

E. L. Reynolds, Solicitor, United States Patent Office, Washington 25, D. C., Attorney for Defendant.

Filed August 12, 1955. Harry M. Hull, Clerk.

(*Answer to Complaint*)

To the Honorable the Judges of the United States District Court for the District of Columbia:

1. The defendant admits the allegations of paragraph 1 of the complaint.

2. He admits that as Commissioner of Patents his official residence is in the District of Columbia and that he is sued in his official capacity.

3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15. He admits the allegations of paragraphs 3 to 15, inclusive.

16. He admits that a petition was filed as alleged in paragraph 16. He states that such petition was denied by an Assistant Commissioner, acting for the defendant, on July 29, 1955.

17. He admits the allegations of paragraph 17.

18. He denies the allegations of paragraph 18.

19. He admits the allegations of paragraph 19.

Further Answering, the defendant states that the plaintiff is not entitled to a patent containing any of the claims referred to in the complaint for the reasons given and in view of the references cited in the Examiner's answer and the decision of the Board of Appeals, in the application here involved. Profert of copies of the said answer, decision and references is hereby made.

Respectfully submitted.

E. L. Reynolds,
Solicitor, U. S. Patent Office,
Attorney for Defendant.

EXCERPTS FROM TRANSCRIPT OF PROCEEDINGS

Thereupon, Augustus P. Sasscer was called as a witness on behalf of the plaintiff, and being duly sworn, testified as follows:

Direct examination by Mr. Dowell, Jr.:

Q. State your name, please.

A. Augustus P. Sasscer.

Q. Your age?

A. Fifty-eight.

Q. And your residence?

A. 3133 Connecticut Avenue, Washington, D. C.

Q. What business are you in, sir?

A. At the time, sir, I am a fleet manager for a rather large trucking company in Washington, D. C.

Q. Will you tell us briefly of your background?

A. I was born in Southern Maryland, came into Washington when I was about 20 years old. I went to work for a Packard distributor here as a mechanic's helper. I worked with them a short time, and then went to work for the company which I am now working for, which is the Jacobs Transfer Company as a mechanic. I worked for them a short time and formed a partnership with another gentleman and we opened a public repair garage in Washington which we operated for about 15 or 16 years. He and I were the only mechanics when we opened the place. As time went on we grew a little bit and we had more mechanics. Then I sold my end of the business, went back to Jacobs Transfer Company as a fleet manager in charge of all their repairs and maintenance and rebuilding of their equipment. I have been with them ever since.

Q. In your work are you in personal contact with automotive and truck repair problems?

A. Yes, sir, I am definitely in charge of all of that.

Q. Are you familiar with the use of shims in the bearings of internal combustion engines?

A. Yes, sir.

Mr. Cochran. If Your Honor please, at this point I would like to raise an objection. It was my understanding that the issues in this case would be tried on the basis of a record made in the Patent Office of public use.

The COURT. That isn't what I got from this brief, sir.

Mr. COCHRAN. My assertion is that this should properly be so. I fail to see how any evidence which now could be offered could have any bearing on the issues which could not have been raised in the Patent Office as part of the regular public use hearing.

If it, on the other hand, should relate to Blaisdell's activities on which the Board made its rejection, the rule 196 (b) which I read to Your Honor invited the plaintiff to take further evidence back to the Examiner, have the Examiner decide the matter of Blaisdell's public use.

The COURT. Are you saying that he would be estopped thereby by not having gone back?

Mr. COCHRAN. It would seem to fall even more strongly than usual under the authority of *Schilling* vs. *Schwitzer-Cummins,* 78 Appeals D. C., 20, where the Court held:

> One who assumes the difficult burden placed upon a plaintiff in a Section 4915 proceeding does not aid his cause by giving ground for the impression that he deliberately failed to make a full disclosure to the Patent Office.

The COURT. You wouldn't say that that language would be involved, would you?

Mr. COCHRAN. Yes, I believe so, sir. In other words, if there were further evidence which had a bearing on Blaisdell's activities in connection with issues before Your Honor, the rule under which the Board of Appeals made its rejection specifically invited the plaintiff to present further testimony to the Examiner, reopen the case before the Examiner.

The COURT. Is that all the language that you have in that case that you would rely on?

Mr. COCHRAN. Yes, sir.

I could also refer to Boucher Inventions, Ltd.

The COURT. What does that say?

Mr. COCHRAN. This is 76 U. S. Appeals D. C., 160 which held:

> But we may point out that Boucher's action in resting his case before the Patent Office on his uncontested exhibit B, withholding the tested exhibit AR until the trial in the District Court, would raise serious questions whether in the peculiar circumstances the latter should have been received in evidence. The practice under Section 4915 as well as within the Patent Office itself contemplates a full disclosure to that office. Exhibits, drawings, et cetera. While the 4915 suit is de novo and permits introduction of evidence not presented to the Patent Office, it does not contemplate the suppression or withholding of evidence so readily available and of such importance as was Exhibit AR or oversight of such glaring proportions.

In neither one of those cases I don't believe Rule 196 B was involved. That rule specifically invited them to present further evidence to the Examiner.

The COURT. My recollection, and you can check me on that, is that the only time it constitutes a bar is where they show lack of good faith or deliberate concealment.

Mr. **Cochran**. I think the language "suppression or withholding of evidence" is the language used in Boucher.

The **Court**. I will deny your objection at this time, Mr. Cochran.

By Mr. **Dowell, Jr.**:

Q. In your work have you personally installed and supervised the installation of such shims in bearings?

A. Yes, sir.

Q. Has your work included the installation of tapered shims?

A. Yes, sir.

Q. What is your understanding of a tapered shim?

A. I would have to have something to demonstrate it with. Could I have that bearing that you have there?

Mr. **Dowell, Jr.**: If the Court will permit me.

The **Court**. Yes, sir.

The **Witness**. A tapered shim as used in a bearing of this type the shim would be of a certain thickness in the center and would taper from the center to each edge equally.

Does that answer your question?

Mr. **Dowell, Jr.** Yes.

By Mr. **Dowell, Jr.**:

Q. Why is a tapered shim necessary or desirable?

A. Well, in a bearing of this type as it is constantly used, the shaft that works in this goes up and down. In my language it hammers harder in the center than it does on these edges. Therefore this center wears faster than the edges.

The idea of the shim is to tighten this bearing back up to the shaft. Therefore you must tighten the center more than you do the sides, or the sides would adjust, when you would attempt to do it, bind and would not get a bearing down here in the bottom where you actually need it.

Q. What does the term "shim stock" mean in the trade?

A. To me a shim stock is a thin piece of metal. A good example would be the thickness of a newspaper or about that thickness. That to me is shim stock.

Q. Does that term "shim stock" have any relation to the expression "foil-like thickness"?

A. Foil-like thickness to me is a very thin piece of metal. We in the trade, for example, call foil-like the wrapping around a cigarette. That to me is foil, and that's quite thin. If that's what you mean.

Q. Do you think that a mechanic can make a tapered shim such as you have described out of shim stock of foil-like thickness by using a whetstone and doing the job by hand?

A. No, sir.

Q. Will you tell us why, please?

A. Well, take a piece of shim stock as I explained to you before, it is very, very thin. By thin I mean like the thickness of a newspaper. A piece of shim stock that would normally be used in this bearing would probably be as thick as two sheets of newspaper. If you attempted to taper that it is just so thin that you couldn't manage it. You couldn't hold it. It would tear up.

Q. Did you ever try to do that?

A. Yes, but not very successfully. It just wouldn't work.

Q. Will you tell us what happened?

A. It, as I said a few moments ago, when you attempted to do that, it is so thin, it is so flimsy, that it would just wouldn't work.

Q. Will you tell us what happened?

A. It, as I said a few moments ago, when you attempted to do that, it is so thin, it is so flimsy, that it would just tear up. You destroy it trying to do it.

Q. When have you tried that?

A. Well, I haven't tried it quite recently, but I have tried it many, many times before, as I told you, when I was in business for myself with a partner.

Recently I have tried it, but I mean I don't try it now as often as I used to.

Now it is my job to tell others how to do it.

Q. I hand you now a sheet of paper which during the Patent Office proceedings was identified as Allen's Exhibit 1, and I will hand the Court a copy of that if I may, sir.

If Mr. Cochran doesn't have a copy I will hand him one.

Will you look at the figures on here showing a process of making a shim?

A. You mean Figure 1?

Q. Figures 1, 2, 3, 4 and 5.

A. Yes, sir.

Q. Do you understand what those drawings represent?

A. Well the first one to me looks as if the workman had a piece of shim stock where he had a pair of shears of scissors and he is cutting off a shim from a sheet of stock to fit a bearing.

Q. In other words, is he taking a wide sheet of this type and holding the shim bearing up to it and cutting off a width corresponding to the width of the insert?

A. Yes, that is right.

Q. Such as I am doing now very roughly (demonstrating)?

A. Yes.

Q. I hand you now a copy of the patent to Flinn, 1,421,441, of which there is a copy at the rear of our brief, Your Honor.

Now Mr. Sasscer, have you examined this patent?

A. I have seen this, yes, sir. I am examining it now.

Q. But I mean, you have had an opportunity previously to read this patent, have you not?

A. Yes, sir.

Q. Do you find anything in the patent which suggests to you the making of a shim from a sheet of paper as shown on these drawings on Allen Exhibit 1?

A. No, sir.

Q. Will you just tell us briefly what your understanding is of this patent to Flinn?

A. This one to me, sir, the piece of shim stock that is the same thickness everywhere, all its portions. However, I don't know much about drawings. It looks like it is several pieces of shim stock put together, what I would call a laminated shim.

Q. Do you find in the patent the idea of making a shim of desired width from a wide sheet of shim stock such as you just demonstrated?

A. I am sorry. I don't believe I understand your question.

Q. Do you find in this patent a suggestion of making a shim of a desired width?

A. Yes, sir, I would say I would.

Q. I don't think that you understood me. Do you find in the Flinn patent the idea of taking a wide sheet of shim stock such as I hold here in my hand, and cutting from it a width of shim to correspond to the insert?

A. No, I do not.

Mr. DOWELL, JR. You may examine, Mr. Cochran. Before you do I would like to offer the shim and insert and also the sheet here. I would like to call this Allen Exhibit 1 as it was in the Patent Office.

Mr. COCHRAN. In stating I have no objection of course this is subject to the original objection. I have no new objection.

The COURT. I understand.

Mr. DOWELL, JR. And to offer this as Allen Exhibit 2. There were several of those. I don't like to burden the record, but this tinfoil in here is so flimsy and apt to come off that I would like to offer two of these; call one 2–A and one 2–B.

The COURT. That's the shim with the tinfoil.

Mr. DOWELL, JR. One question more.

By Mr. DOWELL, JR.:

Q. Mr. Sasscer, are tapered shims of this general type in use now?

A. Yes.

Q. Are they in very widespread use?

A. Yes, sir.

(Sheet of paper with five diagrams with letterhead "S. G. Fox Company" was marked "Plaintiff's Exhibit 1" and received in evidence.)

(Bearing and tinfoil insert was marked "Plaintiff's Exhibit 2–A" and received in evidence.)

(Bearing and tinfoil insert was marked "Plaintiff's Exhibit 2–B" and received in evidence.)

Cross examination by Mr. Cochran:

Q. Mr. Sasscer, you testified that something which was a foil-like thickness was very thin. In your opinion is foil-like thickness any particular thickness? Can you pin that down to thousandths of an inch which might constitute the boundaries of something that is a foil-like thickness?

A. Yes, sir, a foil-like thickness is a sheet of metal that is less than ten thousandths of an inch thick. That's as we term it in our trade. In other words, when it gets beyond ten thousandths of an inch it isn't foil any more.

Q. Something that is six thousandths of an inch is a foil-like thickness?

A. That would be foil-like thickness, yes, sir.

Q. When you made your attempt to taper a shim by a whetstone, how thick was that material?

A. We used about four thousandths of an inch. That would be about as thick as two sheets of newspaper.

Q. And it didn't work?

A. Tore it up.

Q. What kind of metal was that?

A. Brass.

Q. Coming to the Flinn patent, do you find in that patent a suggestion that a shim of a desired shape may be cut from stock material?

A. Would you repeat that, please?

Q. Referring now specifically to Figure 3, Figure 3 does show, doesn't it, a shim of a specified shape cut from stock material such as shown in Figure 2?

A. Yes.

Q. And that would involve necessarily, would it not, a shaping of the width as well as of the length?

A. Shaping of the width as well as the length, yes, sir.

3 **Application of Abram H. Blaisdell, Filed June 24, 1946, Serial Number 678,939, For Tapered Shim.**

5 Specification

To Whom It May Concern:

Be it known that I, ABRAM H. BLAISDELL, a citizen of the United States and a resident of Long Beach, in the County of Los Angeles, and State of California, have invented a new and useful improvement in TAPERED SHIM, of which the following is a specification:

This invention relates to a bearing shim particularly applicable to bearings of internal combustion engines, and especially those bearings in which no shims can be used between the flanges of the bearing caps and the bearing shell.

An object of my invention is to provide a novel tapered bearing shim adapted to be placed in the bearing cap or shell and under the bearing—that is between the bearing and its case or shell.

Another object is to provide a novel bearing shim which is arcuate in cross section, and the edges of which are thinner than the lower portion thereof.

Still another object of my invention is to provide a novel tapered bearing shim consisting of a plurality of superimposed shim stock, thus providing a tapered laminated structure, the laminations of which can be removed to provide a shim of different thicknesses.

Other objects, advantages and features of invention may appear from the accompanying drawing,
6 the subjoined detailed description, and the appended claims.

* * * * *

IN THE DRAWING

Figure 1 is a side elevation of a connecting rod showing a tapered shim above and below the bearing.

Figure 2 is an end view of my tapered bearing.

Figure 3 is an end view of my laminated tapered bearing.

Figure 4 is an enlarged fragmentary sectional view of a laminated tapered bearing.

Figure 5 is a top plan view of the bearing stock in assembled position, and showing the method of fabricating the shims.

Referring more particularly to the drawing, the numeral 1 indicates a bearing cap which is attached to the bearing shell 2, this bearing shell being part of the engine connecting rod, all of which is usual and well-known in the art. In modern internal combustion engines, the bearings are not provided with any means of adjusting the bearing surface against the shaft 3—that is, no shims are provided between the flanges of the bearing caps and the bearing shell. When the bearing wears, new bearings are purchased but, due to wear of the shaft or malformation of the cap, these new bearings do not fit smoothly against the shaft and as a result the new bearings do not wear for any appreciable length of time.

In reciprocating gasoline engines, the greatest wear occurs on the bearing at the top and bottom thereof. Consequently the greatest adjustment must be made at the top and the bottom. The sides of the bearing are worn to a lesser degree, and it will thus be seen that my tapered shim will compensate for the type
7 of wear experienced in a reciprocating engine.

My tapered shim 4, which may be solid as shown in Figure 2, is set in the bearing cap or between the upper half of the bearing and its shell or case 2. The edges 5 of the shim are thinner than the central portion 6—that is, the shim is tapered from the center portion outwardly to its edge. The purpose of this arrangement is to press the bearing 7 inwardly against the shaft and uniformly, so that the entire surface of the bearing will engage the shaft with equal pressure.

As previously stated, the greatest wear occurs at the top and bottom of the bearing, and also the cap or shell may be stretched in this same plane. Now, when my shim is inserted between the bearing and its case or house, and since the edges are thinner than the central portion of the shim, the bearing will be moved inwardly a uniform amount. If the shim were of uniform thickness throughout, the side portion of the bearing would be forced inwardly substantially twice the amount of the central portion of the bearing. Consequently the bearing would bind against the shaft at the sides, while the upper or lower portion of the bearing would not be touching the shaft. With my tapered shim, this difficulty is eliminated. My tapered shim can be made of suitable shim stock or other material, and may be molded, rolled, pressed or otherwise fabricated out of this material.

As shown in Figures 3, 4 and 5, my tapered bearing shim is laminated in form—that is, the various layers of shim stock 8 are of varying width, thus providing the same tapered effect as the tapered shim previously described. The center layer of shim stock is the narrowest, and they are succeedingly wider, thus providing a tapered effect substantially as shown in Figures 3 and 4. The adjacent layers of shim stock are at-
tached together by suitable means, such as an
8 adhesive 9, or by pressing or punching the ad-
jacent layers so that they will be held in assem-
bled position, but one or more of these laminations may be peeled off, if desired, to provide a shim of dif-

ferent thickness. The preferred form of fabricating the laminated type of shim, is shown in Figure 5. Long strips of shim stock are rolled on a surface, and the layers of different thicknesses 8 are placed one upon the other, thus building up the complete shim to the desired maximum thickness. This long strip is now cut on the lines 10 to provide a complete shim of the desired length. When the shim stock 8 is rolled out, a suitable adhesive, or the like, is spread on the surface upon which the adjacent shim stock is placed. When the adhesive dries, the shim will retain its tapered form, but one or more layers of shim stock can be peeled off to provide a thinner shim, if desired.

* * * * *

22 Application of Thomas J. Allen, Filed April 19, 1946, Serial Number 663,494, For Insert Bearing Structure And Shim Therefor.

23 My invention relates to insert bearing structures and particularly to shims therefor.

One of the principal objects of this invention is to provide a bearing or journal structure, and particularly an internal combustion or other engine bearing, in which the shaft-engaging bearing surface may be renewed or refitted around the shaft adapted to rotate therein, by inserting a shim between a removable [or] insert bearing member and the insert C^1 [bearing holder, that is, the rigid member of the bearing box.]

Another important object of this invention is to provide a novel and effective shim of this class reducing the size of the bearing and for taking up the particular and usual irregular wear in bearings, such as in the connecting rod and main bearings of internal combustion engines.

An important object of this invention is to provide a shim of this class which is relatively thick at the median portion and becomes thinner or tapers at the opposite sides thereof to relatively thin edges, an object of this invention being to provide a relatively flat thin or flat-like shim which may be readily distorted into semi-circular form to fit between a correspondingly shaped insert bearing member and a rigid bearing box member or [the] insert bearing holder.

A further important object of this invention
24 is to provide shim stock [of such cross section]
that shims of the desired width may be easily cut therefrom to fit a particular bearing.

With these and other objects in view, as will appear hereinafter, I have devised an insert bearing structure having certain novel features of construction, combination, and arrangement of parts and portions, as will be hereinafter described in detail and particularly set forth in the appended claims, reference being had to the accompanying drawings and to the characters of reference thereon, which form a part of this application, in which:

25 Fig. *1* is a fragmentary side view of the
crank-s*ah*ft end of a connecting rod used in internal combustion engines, embodying my invention in one form;

Fig. 2 is an exploded view of the elements thereof, showing the same in their normal conditions when not assembled;

Fig. 3 is a fragmentary sectional view thereof, taken through 3–3 of Fig. 1, showing the manner of securing the insert bearing member and shim to one of the elements of a connecting rod;

Fig. 4 is a fragmentary view of a bearing, such as employed as a main crank-shaft bearing in internal combustion engines, also incorporating my invention; and

Fig. 5 is a perspective view of a fragmentary portion of shim stock from which shims may be made for the bearing structure shown.

The connecting rod assembly, shown in Figs. *1* and 2, as employed in conventional internal combustion engine construction, consists of an upper
26 connecting rod member *1,* and a connecting rod bearing cap 2. Many of such connecting rods employ semi-circular insert bearings, or insert bearing members, designated 3 and 4, which are circularly coextensive with the bearing portions of the connecting rod members *1* and 2. When assembled with the connecting rod members *1* and 2 and secured in position by bolts 5 and nuts 6, the bearing members 3 and 4 form a perfect circular bearing for the countershaft which they embrace.

These insert bearings, or bearing members, are usually formed of thin steel, approximately three-thirty-seconds of an inch (3/32″) in thickness and are lined on their bearing sides with a few thousandths of suitable bearing material. These insert bearings or bearing members are normally slightly larger in diameter, that is, across their ends, than when in use, but are compressed within, or pinched into the semicircular recesses 1^a and 2^a in the connecting rod members *1* and 2, so as to form a perfect circular bearing for the crank-shaft 7. These insert bearings, or bearing members, may be secured against endwise movement within the connecting rod members by up-setting an edge portion of the insert bear-
27 ing members, as indicated by 3^a in Fig. 3, into recesses 1^b, also shown in this Figure.

The piston, which is attached to the opposite end of the connecting rod (not shown), transfers, during the explosion and compression strokes of the engine, extreme force, which is transferred against the inner side of the bearing, that is, the central portion of the bearing member 3. When the piston and connecting rod move in the opposite direction, there is exerted considerable force against the diametrically opposite side of the bearing, that is, at the central portion of the bearing member 4. This produces considerable wear against these portions, the wear being approximately twice the amount of the wear of the lateral side of the bearing, that is, at the ends of the bearing members 3 and 4.

I have developed a shim, designated 8 and 9 in Figs. *1* and 2, to compensate for such uneven wear. The shims employed are approximately one-half as thick at the ends, as indicated by 8^a and 9^a, than at the middle portions, designated 8^b and 9^b. The end portions of these shims therefore taper from the middle or ridged portion toward the opposite ends.

If the wear of the bearing at the upper and lower
portions thereof amounts to four thousandths
28 of an inch (.004″), the wear of the lateral por-
tions is approximately two thousandths of an
inch (.002″). If such amount of wear is to be taken up by the shim, the shim is relatively thin, and may be readily bent or formed into semi-circular shape and thus secured between, respectively, the bearing members 3 and 4 and the connecting rod elements *1* and 2 when the bearing members 3 and 4 are forced or pinched into position.

The middle portion of the shim may have a relatively wide uniform portion, instead of formed into a ridge, from which the shim tapers in the opposite direction.

This shim may be fabricated in this manner from resilient metal, C [such as] steel, or the like, by rolling the material.

A number of such shims may be fabricated in one piece by rolling a long strip in this manner to form shim stock, as shown in Fig. 5. The required lengths of such shim stock are then cut from the strip, as desired, the cutting lines being indicated by A in Fig. 5.

Instead of rolling the material into such shape, a uniform thickness sheet may be plated by providing a thinner layer or plating at the ends than at the middle portion, thus providing the desired taper.

This progressive decrease in thickness from the
middle portion toward the edges may be in
29 steps, as when several thin sheets of material
are brazed or otherwise secured together.

In Fig. 4 of the drawings, which shows a main bearing of an internal combustion engine, and in which the engine block is indicated by 11 and the bearing cap by 12, slightly different wear of the bearing takes place. In this instance, when insert bearings the used, the upper insert bearing member 13 may not receive any or only little wear while the lower insert bearing member 14 may receive considerable wear. But in this instance also the middle portion of the bearing member 14 receives approximately twice the wear of the end portions. Therefore, a shim 15 is used in this instance of the same description as that described above.

Though I have shown and described a particular construction, combination, and arrangement of parts and portions, and a certain modification thereof, I do not wish to be limited to the same; but desire to include in the scope of my invention the construction, combination, and arrangement substantially as set forth in the appended claims.

FIG. 1.

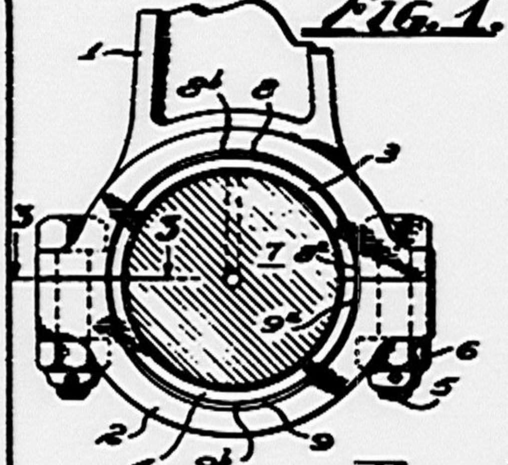


FIG. 2.

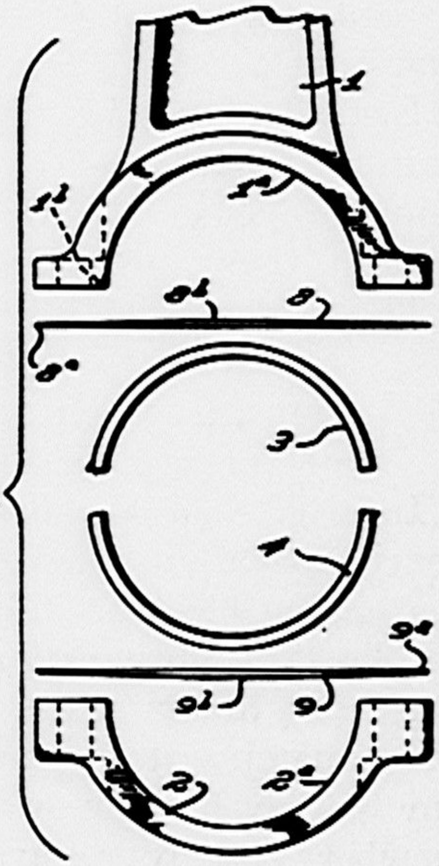


FIG. 3.

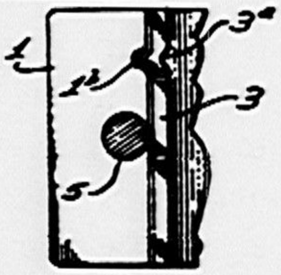


FIG. 5.

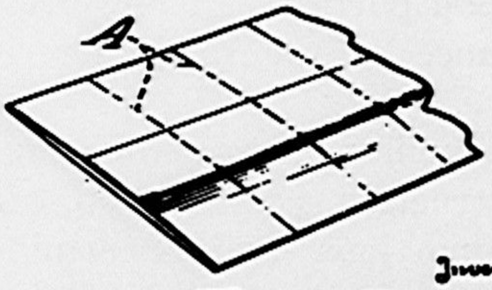
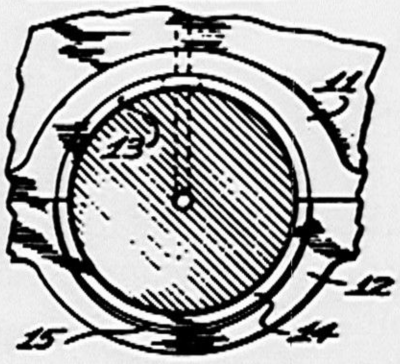


FIG. 4.



Inventor

THOMAS J. ALLEN

By William C. Hall

Attorney

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70 Application of Abram H. Blaisdell, Filed March 24, 1936, Serial Number 70,637, For Bearing Shim.

This invention relates to a bearing shim particularly applicable to bearings of internal combustion engines, and especially those bearings in which no shim can be used between the flanges of the bearing caps.

An object of my invention is to provide a novel tapered bearing shim adapted to be placed in the bearing cap and under the bearing.

Another object is to provide a novel bearing shim arcuate in cross section, the edges of which shim are thinner than the lower portion thereof.

Other objects, advantages and features of invention may appear from the accompanying drawings, the subjoined, detailed description and the appended claims.

* * * * *

IN THE DRAWING

Figure 1 is a perspective view of a bearing with my shim in position.

Figure 2 is a perspective view of the bearing shim.

Figure 3 is an end view of a complete bearing with two shims in position.

* * * * *

73 Referring more particularly to the drawing, the numeral 1 indicates a bearing cap which is adapted to hold the bearing 2, all of which is usual and well known in the art. In modern internal combustion engines the bearings are not provided with any means of adjusting the bearing surface against the shaft, i. e., no shims are provided between the flanges of the bearing caps. When the bearings wear, new bearings are purchased, but due to the wear of the shaft, these new bearings still do not fit snugly against the shaft.

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My tapered shim 3 is set in the bearing cap, as shown in Figs. 1 or 2, and the upper edges 4 of the shim are thinner than the lower portion 5. That is, the shim is tapered from the bottom to the top. The purpose of this arrangement is to press the bearing 2 inwardly against the shaft, this inward movement being uniform thruout the surface of the bearing. Due to the fact that the edges 4 of the shim are thinner than the bottom portion 5, the bearing can be moved inwardly a uniform amount. If the shim were of uniform thickness thruout the [upper] side portion of the bearing would be forced inwardly twice the amount of the lower part of the bearing. Consequently, the bearing would bind against the shaft at the sides while the bottom of the bearing would not be touching. With my tapered shi[p]m this difficulty is eliminated. Also in reciprocating engines, the most wear occurs on the top and bottom of the bearing.

My tapered shim can be made of suitable shim metal stock or other material and may be molded, rolled, pressed, or otherwise fabricated out of material.

74 Having Described My Invention, I Claim:

1. A bearing shim adapted to be placed under a shaft bearing and formed of shim stock, said shim being tapered from the center to both edges thereof.

2. A bearing shim adapted to be placed under a shaft bearing, comprising a semicylindrical body formed of shim stock, said body being tapered from the center toward both edges thereof.

3. A bearing shim for shaft bearings, said shim including a semicylindrical body formed of shim stock, said body tapered toward both edges thereof, the edges being thinner than the [inner] center portion of the shim, said shim being arranged in a bearing cap under the bearing.

In Testimony Whereof I affix my signature.

ABRAM H. BLAISDELL.

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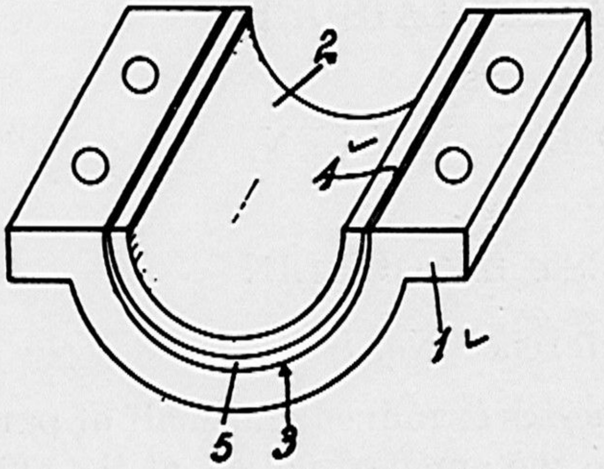
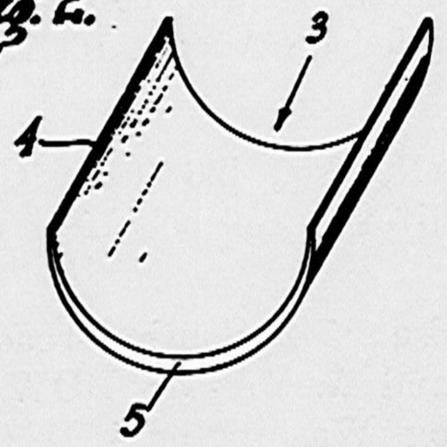


Fig. 1.

Fig. 2.



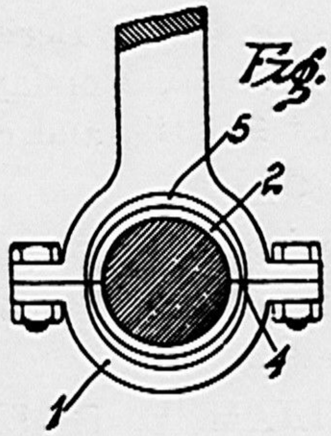


Fig. 3.

INVENTOR.
ABRAM H. BLAISDELL.
BY.

ATTORNEY.

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IN THE UNITED STATES PATENT OFFICE BEFORE THE EXAMINER OF INTERFERENCES

ABRAM H. BLAISDELL,

vs.

THOMAS J. ALLEN,

vs.

FOREST L. COCKLIN

Interference No. 83587

Depositions of witnesses examined on behalf of party Blaisdell, pursuant to the annexed notice, at the office of Harold A. Dreckman, Esq., Suite 426 Ocean Center Building, Long Beach, California, commencing ten o'clock a. m., Monday, August 8, 1949, continued on August 9, 1949, and concluded on August 10, 1949.

PRESENT:

HAROLD A. DRECKMAN, Esq., 426 Ocean Center Building, Long Beach, California, on behalf of party Blaisdell.

WILLIAM E. HALL, Esq., 542 South Broadway, Los Angeles, California, and A. YATES DOWELL, Esq., 1158 Munsey Building, Washington 4, D. C., on behalf of party Allen.

HARRY W. LINDSEY, JR., Esq., 332 South Michigan Avenue, Chicago, Illinois, on behalf of party Cocklin.

ABRAM H. BLAISDELL, being duly sworn, deposes and says, in answer to interrogatories proposed to him by Harold A. Dreckman, Esq., counsel for party Blaisdell, as follows:

Q.11. You are the Abram H. Blaisdell who is the applicant in Serial No. 70,637, forfeited application on tapered shims, as well as the applicant in this interference No. 83,587?

A. I am.

Q.12. When did you conceive the invention as disclosed in this forfeited application, Serial No. 70,637?

A. In October of 1934.

Q.13. How do you set that date?

A. Well, we were having trouble in getting undersized bearings of the sizes that we needed at that time. There were few bearing-turning outfits in Long Beach at that time, so consequently some provision had to be made to take up these bearings.

Q.14. By undersized, you mean those various sizes—

A. Oh, one and two and three.

Q.15. Thousandths, you mean?

A. Thousandths, yes.

Q.16. Following the conception of this invention, did you make any models of this invention?

A. I made shims almost immediately.

Q.17. What date do you state you made those?

A. In October of 1934.

Q.18. How did you make those models?

A. I ground them; cut a shim to size and then ground the ends.

Q.19. How did you grind them?

A. With a whetstone.

Q.20. By hand?

A. By hand.

Q.21. These models which you made, did you install them in an engine?

A. Yes.

Q.22. When did you install them in an engine?

A. In about November of the same year.

Q.23. You mean November of 1934?

A. Right.

Q.24. Did you operate the engine after these shims were installed?

A. I did.

Q.25. Were they successful?

A. They were.

Q.32. During the year 1935, were you conducting any further experiments on this tapered shim?

A. Yes. I tried to find someone to make them for me. I wrote letters.

Q. 33. Were you successful?

A. I was not.

Q.34. What was the reason that they could not make these shims?

A. Well, apparently there was no rolling process in existence at that time capable of rolling a shim which was thin on the ends.

Q.35. And for this reason the shim could not be economically made, is that right?

A. Well, as far as I know, it could not be economically made. I could not make it.

Q.83. Did any of these men see you install these shims in an engine?

A. George Mitchell did.

Q.84. During the years from 1936 and subsequently, did you ever sell any of these shims?

A. I did not until September of 1945.

Q.85. Your first actual sales, then, were in September of 1945, is that right?

A. That's right.

Q.86. When the first application, Serial No. 70,637, was allowed in 1939, why did you at that time fail to pay the final fee?

A. I didn't have the money.

Q.87. Were there any other reasons?

A. Well, in view of the fact I couldn't find anyone else to make them and hadn't succeeded in doing it myself, I didn't feel justified in putting forth the money.

Q.88. Were you able to make any of these shims at a price which the public would pay at that time?

A. I was not.

Q. 89. During the war years, were you able to obtain any materials from which tapered shims could be made?

A. No, not in quantities.

Q.90. Prior to September of 1945, when you testified that you sold the first shims, did you manufacture any of the shims for sale?

A. Manufacture them for sale—no, I did not.

XQ.29. Now, let's get that clear on the record. What do you mean, you didn't deal in either new or old cars, you were strictly a repair man?

A. I didn't buy or sell cars, either new or used.

XQ.30. Your business was simply to recondition and repair used cars?

A. That's right.

XQ.35. Now, as I recall your testimony on direct, you prepared a one-piece tapered shim, such as that shown in your abandoned application No. 70,637 or in figure No. 2 of your present application and interference No. 678,939, in the fall of 1934, is that correct?

A. That's right.

XQ.36. What material did you use, Mr. Blaisdell?

A. Used brass shim stock.

XQ37. Then you took a whetstone and rounded it off so that it was thicker at the center than at the ends?

A. That's right.

XQ.38. And you put those in a car, as illustrated in the drawings of your two applications, is that correct?

A. That's right.

XQ.39. And they were successfully used in that car?

A. To the best of my knowledge, they were successfully used.

XQ.40. What kind of a car was it?

A. One, as I remember, was a Plymouth, 1933.

XQ.41. There were several cars?

A. No, there were only two that I recall.

XQ.42. Do you remember the other?

A. Yes, it was an Oldsmobile.

XQ.43. What year was that?

A. That was later, 1936.

XQ.44. There was just the one car in November, 1934, is that correct?

A. That's right.

XQ.45. Now, who owned this Plymouth, 1933?

A. George Mitchell.

XQ.46. He saw you install these tapered shims in that car?

A. That's right. He owned both of those cars, in fact.

XQ.47. Did you do any other work on the engine at that time?

A. Not that I recall.

XQ.48. These bearings had a sloppy fit when the car was brought in, did they not?

A. Yes.

XQ. 49. And you inserted these shims to correct it?

A. That's right.

XQ.50. Was any charge made for that work?

A. No charge. This was purely experimental.

XQ.51. How long did Mitchell own that car with the shims in it.

A. That I don't know.

XQ.52. You don't know whether he sold it later or not?

A. I presume he did.

XQ.53. How long did you keep track of that car, if at all?

A. For a period of about four months.

XQ.54. At the end of four months, what happened?

A. It was still running quiet.

XQ.55. And you were satisfied that the job was successful?

A. I was satisfied, that's right.

XQ.56. And you were fully satisfied that this tapered shim had solved the problem at that time?

A. That's right.

XQ.57. Now, you testified, according to my notes, that during 1935 and later you tried to get some one to make the shims for you. Was that in 1935? I am not sure.

A. It was in 1936 when I was trying to get somebody to make them.

XQ.58. These letters marked as exhibits indicate that it was 1936, is that correct?

A. Yes.

XQ.59. As I understand your testimony, Mr. Blaisdell, you inserted these tapered shims of yours first in Mr. Mitchell's Plymouth in 1933 and then later in an Oldsmobile?

A. That's right.

XQ.60. Those were the only two cars that you personally inserted these shims in at that early date?

A. That's right.

XQ.61. When were the shims placed in the Oldsmobile?

A. In 1936.

XQ.62. Was that a 1936 model car?

A. That was an early 1936.

XQ.63. But that was later in the year of 1936?

A. That's right.

XQ.64. The car had been used?

A. The car had been down in the dust bowl at that time. Mr. Allen will substantiate this: there was a great deal of trouble with automobiles that came out of the dust bowl area.

XQ.65. Do you remember what part of the dust bowl?

A. No. In Oklahoma and Texas up around Amarillo they were having a lot of trouble.

XQ.66. Who owned the Oldsmobile?

A. George Mitchell.

XQ.67. Do you know if that car was used later in the dust bowl or not?

A. I haven't any idea.

XQ.68. Do you know what become of that car?

A. No.

XQ.69. Do you know whether Mr. Mitchell sold it or not?

A. I presume he did.

XQ.70. Did you ever take the shims out of either the Plymouth or the Oldsmobile?

A. As long as they run a reasonable length of time and they are quiet, I don't take them out.

XQ.71. Did you ever take the shims out of either of these cars at any time?

A. No.

XQ.72. You don't know whether or not Mr. Mitchell sold the Oldsmobile later?

A. No, I don't.

XQ.73. How long did you keep track of the operation of that car?

A. About the same period of time, four months.

XQ.74. And that confirms your previous conclusion and feeling that this was a satisfactory shim?

A. That's right.

XQ.75. There was no trouble developed, as far as you know?

A. Didn't show up.

XQ.90. Now, in March of 1936, you testified you talked to Mr. Dreckman about this shim.

A. Yes.

XQ.91. And I presume you told him you had tested the shim and found it to be satisfactory, is that correct?

A. I presume I did. I don't remember whether I did or not.

XQ.92. Now, you are familiar with your application file with respect to your abandoned application Serial No. 70,637, are you not?

A. Well, I am not exactly familiar with it.

XQ.93. During the prosecution of that application, you advised Mr. Dreckman, did you not, that you had worked on many cars and these shims had been used and that they were successful?

A. This was in 1935 that you are speaking of?

XQ.94. Well, this was in 1936, October, about six months after you filed.

A. Well, if it says so here, I presume it did.

XQ.95. I might say here on the record: I am not trying to trap anybody; I am just trying to look at this and drag out the facts for what they are; and if I help my case, all right, and if I hurt mine, all right. Mr. Dreckman stated in the amendment which was dated October 28, 1936—that being apparently the first amendment filed in the case, the following: "Applicant has worked on many automobiles in which the connecting rod bearings were loose on shafts, and he has placed his shims in position, thereby effectively and permanently (within the life of the bearing) adjusting the bearing to the shaft." Now, that was information that Mr. Dreckman had obtained from you, is that correct?

A. That would be correct.

XQ.96. That is correct information?

A. That is correct.

XQ.97. Those installations were successful?

A. That's right.

XQ.98. Then Mr. Dreckman states in these remarks accompanying this statement: "Applicant's shim is simpler to install, is less expensive and is more effective than any of the structures shown in the patents. Furthermore, applicant's shim can be applied to the modern connecting rod used in automobiles and the like, and very little time is required to adjust and position the shim. Furthermore, applicant's shim provides a solid and unyielding back for the bearing, thereby preventing the bearing from breaking down under the stress of engine operation." Now, Mr. Dreckman got that information from you?

A. I presume so.

XQ.99. Do you know of anybody else he could have gotten it from, Mr. Blaisdell?

A. No, he got it from me.

XQ.100. That is an accurate statement, isn't it?

A. Yes.

XQ.101. In Mr. Dreckman's remarks accompanying the amendment, responding to the official action of February 6, 1937, Mr. Dreckman stated: "For information of the Examiner, applicant's shim is .006 of an inch at the thickest part and .002 at the thinnest."

And that is information, of course, that Mr. Dreckman must have gotten from you?

A. That's right.

XQ.102. And that statement is correct?

A. That is right.

XQ.162. Now, as far as these various installations which were made in the early days, that is, in the thirties, were concerned, you didn't follow them for over three or four months?

A. No.

XQ.163. Then, you didn't know what became of these cars?

A. I haven't any idea.

XQ.178. Well, you were well satisfied with the device before you filed your second application, were you not?

A. I was well satisfied, yes.

XQ.179. And before you filed your first application, too, is that right?

A. That's right.

XQ.184. When did you make your first laminated shim, Mr. Blaisdell?

A. That was in July of 1945.

XQ.185. That was the earliest date?

A. Yes.

XQ.186. That was just a few days before Long Beach Engravers Ltd. invoiced you for the zinc etching?

A. That's right.

XQ.187. Then, as soon as you made your first tapered shim you decided that it was satisfactory, too, is that correct?

A. I made that first tapered shim back in 1935.

XQ.188. I mean laminated—I am sorry.

A. Yes.

XQ.189. Was the laminated shim tested before you placed the order for this zinc etching?

A. No, only on the bench.

XQ.190. And that was satisfactory proof to you?

A. That's right. The fundamental idea remained the same.

XQ.191. That it was perfectly commercial and satisfactory, is that right?

A. That is right.

XQ.192. So that you made your decision with respect to the laminated shim largely on the experience which you had had with the one-piece, ground shim, is that correct?

A. That is right.

XQ.193. Now, in the specification of your abandoned application, Serial No. 70,637, is this statement—the paragraph as it stood at the time your application was filed: "My tapered shim can be made of suitable metal stock or other material and may be molded, rolled, pressed or otherwise fabricated out of material." The first tapered shims you made were made of brass stock, is that correct?

A. That is right.

XQ.194. And then your laminated shims have been made of aluminum, is that correct?

A. That is correct, .00035 aluminum.

XQ.195. Have you made any of your laminated shims out of brass stock?

A. We piled one shim on top of another, if that's what you mean.

XQ.196. Will you explain that?

A. There has been no such thing as a shim constructed in that way.

XQ.197. Out of brass? I think maybe we are talking at cross purposes. I am just trying to get this clear. Did you make any of your laminated shims with brass stock?

A. Yes.

XQ.198. What did you glue them together with?

A. No, didn't glue them together, just put them in there one on top of the other.

XQ.199. How were they; were they satisfactory?

A. No.

XQ.200. Why?

A. Because the ends of the stock would cause high spots to appear in the bearing.

BY MR. DOWELL:

XQ.210. Mr. Blaisdell, when did you find out that you could roll shims? You said a moment ago, I believe, that they could be rolled.

A. In 1946.

XQ.211. How did you happen to find that out?

A. Some one came in the shop with a rolled shim made out of copper.

XQ.212. Do you recall who that was?

A. No, I don't recall who that was.

XQ.213. Up to that time you didn't believe that it could be rolled?

A. I didn't know that it could be rolled.

HAROLD A. DRECKMAN, being duly sworn, deposes and says, in answer to interrogatories proposed to him by Harold A. Dreckman, Esq., counsel for Party Blaisdell, as follows:

Q.1. State your name, age and address.

A. My name is Harold A. Dreckman; age fifty-four; address, Ocean Center Building, Long Beach, California.

Q.2. You are the attorney of record in the Abram H. Blaisdell applications, Serial No. 70,637 and Serial No. 768,939?

A. Yes.

And in answer to cross-interrogatories proposed to him by A. Yates Dowell, Esq., counsel for Party Allen, he says:

XQ.43. Well, then, according to this claim, the issue of the interference, all the claim calls for is some sort of material; it doesn't say what kind of material; perhaps twenty thousandths in thickness, tapered from the center to both edges, is that correct?

A. That is correct.

XQ.44. Well, if we took a little piece of this desk pad and dug out a little bit, you would have it—cut a short strip and dug out—or filed it down or reduced the ends a little bit, it would meet the claims then, wouldn't it?

A. Yes, it would.

XQ.45. In other words, the claim is not even limited to metal, is it?

A. No.

HERMAN CAMPBELL, being duly sworn, deposes and says, in answer to interrogatories proposed to him by Harold A. Dreckman, Esq., counsel for Party Blaisdell, as follows:

Q.1. State your name and address.

A. Herman Campbell, 3816 Cedar Avenue, Long Beach, California.

Q.16. You never saw an actual tapered shim made by Mr. Blaisdell during the years 1934 to 1939?

A. Not actually made, no.

XQ.18. Was the structure which he discussed back in 1936 and 1937 like that shown in this blue print?

A. I couldn't say. Like I say, I never seen one; all we talked about was the making of them.

XQ.19. That was a one-piece shim at that time, was it not?

A. That's what he was talking about.

XQ.20. And the center was to be thicker than the end, isn't that right?

A. That was one of his ideas.

XQ.21. Do you recall that he told you that the way he made that tapered shim was to use a whetstone and grind off the ends?

A. That's right.

ROBERT CHARLES REDD, being duly sworn, deposes and says, in answer to interrogatories proposed to him by Harold A. Dreckman, Esq., counsel for Party Blaisdell, as follows:

Q.1. State your name.

A. Robert Charles Redd.

Q.2. What is your age, Mr. Redd?

A. Fifty-six.

Q.4. Are you in business in Long Beach?

A. I am.

Q.5. What is the address of that business?

A. 1724 American Avenue.

Q.6. What is the business?

A. Automobile parts and machine shop.

Q.7. Are you acquainted with Mr. A. H. Blaisdell?

A. I have been for the fifteen years that I have been in Long Beach.

Q.8. You came to Long Beach about what year, then?

A. That was in 1933, I guess it was.

Q.9. Were you acquainted with Mr. Blaisdell in 1934, 1935 and thereafter?

A. Well, I was acquainted with him in this way: I was calling on him, soliciting business.

Q.10. Soliciting business for what?

A. For sale of my parts.

Q.11. Automotive parts?

A. Automobile parts and the labor we had in conjunction with that, of course.

Q.12. Did Mr. Blaisdell ever talk to you about tapered or feathered shims?

A. That's all he ever talked about, that and different gadgets he had in mind. Every time I would go in there, he would talk about that. The reason for that talking so much to me: I was attempting to sell him bearings; that was my job. He always said that if he could build a shim to prevent buying new ones, he would save a lot of old ones.

Q.13. When did he first talk to you about tapered shims?

A. That's a hard thing for me to answer; that's years ago and something I never tried to keep in mind. He was in the garage on Tenth Street in the block this side of California Avenue, and that must have been—oh, previous to the war, I know, and that must have been twelve years ago anyway. He was always talking about building a shim but he couldn't do it—trying to get somebody to try to build or make them. He knew I had a machine shop and he was trying to get somebody and have them grind or build them up or do something with them. As far as I knew, he was only talking, and I never figured he would go any further with them.

Q.14. Did Mr. Blaisdell ever show you a tapered shim, an actual shim?

A. No, he never did.

Q.21. When Mr. Blaisdell first talked to you, as you have testified, ten or twelve years ago, did he explain to you as to the difficulties that he had encountered in making these shims?

A. That was his difficulty. The reason he talked so much, he was trying to get me to give him ideas as to how it should be done, trying to figure out who he could get to make it—thought he would have to go east to have it made.

Q.22. Did he ask you if you could make it?

A. He asked me if I had any ideas, and I didn't have. I didn't know how, in other words.

Q.23. Did you ever see Mr. Blaisdell insert any of these shims in an automobile?

A. No, I never did.

LYLE M. LANE, being duly sworn, deposes and says, in answer to interrogatories proposed to him by Harold A. Dreckman, Esq., counsel for Party Blaisdell, as follows:

Q.11. Did you talk to Mr. Blaisdell before 1942 about this invention?

A. No. I didn't know him.

Q.12. You have known Mr. Blaisdell since 1942?

A. Yes.

Q.13. Did Mr. Blaisdell ever show you a tapered or feathered shim?

A. Well, the first one I saw—I saw two or three that he was working on—was a—looked like a heavy brass deal. He was making them tapered to fit under the bearing, which you could adjust; and then later this thin business that feathered off.

Q.14. This first one you saw him work on was of what material, do you know?

A. I believe it was either brass or bronze.

Q.15. He was making this feathered shim by hand, was he?

A. Yes.

Q.16. And using what in tapering the shim?

A. I think he used a plain ordinary whetstone or hand rock. I don't know whether it was carborundum. When he was working on it the day I saw him, he was working by hand and stone.

Q.17. Did you ever see him place one of these feathered shims in an engine?

A. No, not actually. When I saw him was at his bench when he was actually working on the shim himself. I was never down in his pit to see him put one in an engine.

GEORGE A. MITCHELL, being duly sworn, deposes and says, in answer to interrogatories proposed to him by Harold A. Dreckman, Esq., counsel for Party Blaisdell, as follows:

Q.1. What is your name and address?

A. George A. Mitchell, 1705 Rose Avenue.

Q.2. What is your business or occupation, Mr. Mitchell?

A. I am retired at present.

Q.3. Prior to your retirement, what was your business?

A. Used cars and trucks.

Q.4. That is, the sale of used cars and trucks?

A. That's right.

Q.5. For how many years were you in that business?

A. Twenty-five years.

Q.6. Prior to what date?

A. To January 1, 1947.

Q.7. That is, you retired January 1, 1947?

A. Yes.

Q.8. Were you in business selling used cars and trucks in 1934, 1935 and 1936?

A. Yes.

Q.9. Are you acquainted with Mr. A. H. Blaisdell?

A. Yes.

Q.10. How long have you known him?

A. Well, approximately twenty-five years.

Q.11. You were acquainted with him then in 1934, 1935 and 1936, in that era?

A. Yes.

Q.12. Did Mr. Blaisdell ever talk to you about a tapered shim, or feathered shim, as he calls it?

A. Yes.

Q.13. Do you remember when he talked to you about it the first time?

A. Well, I'd say about in 1935.

Q.14. How do you fix that date? How do you determine it was 1935?

A. Well, we were repairing Chrysler products, 1933 Plymouths and stuff like that.

Q.15. What did Mr. Blaisdell show you at the time he told you about this tapered shim, if anything?

A. Well, at first he didn't show me anything, but he was successfully repairing this bearing situation on dust bowl cars and cars that we had to buy bearings for, and he repaired them without buying the bearings.

Q.16. Did you observe how this work was done, Mr. Mitchell?

A. Well, after a time he told me to come down and he showed me what he was doing.

Q.17. What was he doing?

A. Well, he was tapering off a metal—tapering off a shim, I would say, tapering off the ends.

Q.18. How was he tapering this shim material?

A. He was doing it with a file or machine or stone or something. I couldn't say as to that.

Q.19. You didn't observe him actually preparing these tapered shims?

A. No.

Q.20. But you did observe that he put these shims in the automobiles?

A. Yes, that's the way he done.

Q.21. What was the date of this work that was done on the cars?

A. 1935.

Q.22. Do you know approximately what month in 1935?

A. I couldn't say exactly, no.

Q.23. It was during the year 1935?

A. Yes.

Q.30. Did Mr. Blaisdell place these tapered shims in more than one automobile for you?

A. Yes.

Q.31. How many?

A. Well, I couldn't say exactly how many.

Q.32. It was more than one?

A. As I recall, a 1936 Oldsmobile and a 1933 Plymouth—particularly the Plymouth, because it had a small crankshaft and required something.

Q.33. Your recollection is that there were at least two?

A. Pardon me?

Q. 34. In your recollection, there were at least two automobiles that were so repaired?

A. That's right.

Q.35. Did you buy these shims, that is, did you pay for the shims themselves?

A. No.

Q.36. You did not?

A. No. My material was the guinea pig, I guess.

Q.27. Since 1935 or 1936, have you had Mr. Blaisdell repair other automobiles for you, in the years following 1935 and 1936?

A. Yes.

Q.28. In what years?

A. I'd say in 1942.

Q.29. Commencing in 1942?

A. Yes.

Q.30. What other years?

A. Well, that's about all I can recall. I installed my own equipment and opened my own shop after the war came on.

Q.31. This repairing of the car in 1942, was that the same type of shim, as you remember?

A. The same type of shim, but was used in a 1941 Lincoln Zephyr.

MR. DRECKMAN: I think that is all, gentlemen.

MR. DOWELL: Go ahead, I don't have any.

And in answer to cross-interrogatories, proposed to him by Harry W. Lindsey, Jr., Esq., counsel for Party Cocklin, he says:

XQ.1. Mr. Mitchell, what concern were you with from 1934 to 1942?

A. With my own.

XQ.2. That was your own business?

A. I was twenty-two years at the same location.

XQ.3. Where was that place of business?

A. 1901 East Anaheim Street.

XQ.4. That business was repairing and selling used cars and trucks?

A. General, used cars and trucks, yes, used car business.

XQ.5. Now, does that mean that some of these cars would be repaired and reconditioned by you?

A. Prior to sale, yes.

XQ.6. Prior to sale?

A. That's right.

XQ.7. In other words, in those days, if somebody brought in a used car, you would buy it and have it repaired and put in condition and then resell it?

A. That's right.

XQ.8. And that was also true of the trucks, I suppose?

A. That's right.

XQ.9. Now, when you first discussed this matter of a tapered shim with Mr. Blaisdell in about 1935, Mr. Blaisdell, I suppose, told you that he had already installed some of these shims and that they had been successful, had he not?

A. I couldn't say as to that; I don't remember.

XQ.10. That was a one-piece tapered shim, was it not, as shown in this blue print, Exhibit No. 11?

A. Yes.

XQ.11. And you recall that that was made of brass, do you not? Mr. Blaisdell so testified.

A. I couldn't say as to the material, sir.

XQ.12. But it was a metal?

A. That's right.

XQ.13. And it was a pliable metal?

A. That's right.

XQ.14. That could be bent around the bearing insert, is that correct?

A. Yes.

XQ.15. Now, you testified as to two cars in which these Blaisdell one-piece metal shims were inserted for you. There may have been other cars, is that correct, that you brought over for repair in that fashion?

A. Well, I wouldn't take an oath as to that, sir.

XQ.16. You just don't recall how many there may have been?

A. No.

XQ.17. But there were at least two?

A. That's right.

XQ. 18. Now, this 1933 Plymouth, have you any records with respect to that car?

A. Do I have any records?

XQ.19. Yes, sales or—

A. I have it some place, I suppose.

XQ.20. You have them some place?

A. Record of all of them, as far as that goes.

XQ.21. Do you have records of the 1936 Oldsmobile?

A. I am sure I do have.

XQ.22. Do you have records of the 1941 Lincoln Zephyr?

A. I am sure I have.

XQ.23. After these shims were placed in these cars, did you operate the cars?

A. I didn't, no, but I watched them closely.

XQ.24. Was the operation satisfactory?

A. Yes, that's right.

XQ.25. Mr. Blaisdell testified that he kept track of the operation for about four months. Would that be in accordance with your recollection?

A. Well, I wouldn't say the exact months or days, but we checked on the cars.

XQ.26. But these cars were in your possession and under your ownership, and then you later sold them, did you not?

A. Yes.

XQ.27. And your records would show these were sold, would they not?

A. That's right.

XQ.28. And to whom?

A. That's right.

XQ.29. After they were sold, you didn't pay any more attention to them, did you?

A. Well, no more than to check as to the oil pressure and so forth when the cars came in. I carried my own paper on these cars—contracts—and it was easy to check them when the man came in every two weeks to make his payment, or every thirty days.

BY MR. DOWELL:

XQ.34. Mr. Mitchell, you spoke of those cars. Did you stand by and actually see the complete installation of these shims?

A. No.

XQ.35. You did not?

A. No.

XQ.36. You believe they were installed, according to your testimony, but could you actually swear that they were installed? Not what you actually believe, but what you actually know, your personal knowledge. Unless you saw them installed, you couldn't swear that they were there, could you?

A. Well, I didn't crawl down in the pit and watch them installed, no, it's a cinch.

XQ.37. Now, you said yes, I believe, when words were put into your mouth by opposing counsel to the effect that the shim was pliable. Did you take it and examine it before it was put in there and know it was pliable?

A. Well—

XQ.38. Please answer me yes or no.

A. The question again, please.

(Question XQ.37. read).

A. No.

XQ.39. Is that also true relative to the three cars?

A. That's right.

XQ.40. Now, relative to this satisfactory operation, how long after these cars were repaired did you hold them before you delivered them?

A. I couldn't say as to that exactly, sir. The cars weren't in operation when I owned them, they were just in the line for sale.

XQ.41. When were they repaired?

A. Well, when I acquired possession of them.

XQ.42. I thought you said they weren't in operation after you owned them.

A. Pardon me?

XQ.43. I thought you just stated that they weren't in operation when you owned them.

A. Well, general operation was after I sold them.

XQ.44. What do you mean by general operation?

A. Well, I was in the automobile business, I wasn't using these automobiles. Naturally, they set for sale on the line.

XQ.45. Well, you didn't sell cars that weren't in operating condition, did you?

A. No, I didn't.

XQ.46. How do you reconcile that statement with the statement a few moments ago that they weren't in operation when you owned them?

A. Well, they were capable of being operated, but what I mean is that I didn't operate them.

XQ.47. Then, they were repaired after you acquired them; after you acquired them, they were repaired, is that right?

A. That's right.

XQ.48. And then you sold them?

A. That's right.

XQ.49. How long was it after they were repaired before you sold them?

A. Well, it might vary, maybe from a week to—or maybe a few days to two or three months.

XQ.50. Well, now, let's talk about the Plymouth; would you say it was a week or two or three months?

A. I couldn't on all three cars know.

XQ.51. Well, could you on any one of them?

A. No, I couldn't, that's a cinch, I couldn't.

XQ.52. Well, you said you observed them, that they operated satisfactorily.

A. We did after the cars were sold, whatever time that was.

XQ.53. Did you have supervision of those cars after they were sold?

A. Only just to check on them in experimental—

XQ.54. What do you mean, check on them; how did you check on them?

A. Well, as the customer when he came in, and go out and check the oil pressure.

XQ.55. That is a pretty accurate test, whatever the customer told you?

A. Pardon me?

XQ.56. Whatever the customer tells you, you always accept?

A. If the thing was operating successfully, naturally, yes.

XQ.57. It is possible that your customers may have had those cars in another garage?

A. Well, the cars were sold to him under a guarantee, so he naturally wouldn't take them to another garage, I don't think.

XQ.58. What kind of guarantee?

A. Well, a mechanical guarantee, as to mechanical condition.

XQ.59. What is a mechanical guarantee? Anything is in a mechanical condition of some kind or other. What is a mechanical guarantee?

A. Well, we guarantee their cars for thirty days unconditionally. That is, if a man had oil consumption, probably, or loose mains or loose rods, why, he came back.

XQ.60. Well, you went further than thirty days in your statement a moment ago.

A. Pardon me?

XQ.61. Your statement of a few moments ago went much further than thirty days.

A. That's right, these particular cars we observed longer than thirty days because we didn't put new bearings in them.

XQ.62. But you couldn't swear nothing was done to them?

A. No, I couldn't swear that the owner didn't take it out and have it overhauled, no, but I don't think he did under those conditions.

XQ.63. You said that you observed these for a period of time, but you don't know just how long you observed them, do you?

A. Not exactly.

MR. DOWELL: That is all.

BY MR. DRECKMAN:

Q.32. Mr. Mitchell, did you ever actually see one of the shims made by Mr. Blaisdell?

A. I saw the shim, yes.

Q.33. Did you ever have it in your hands?

A. I couldn't say as to that.

Q.34. Did you ever see Mr. Blaisdell place a shim in a bearing cap?

A. Yes.

Q.35. In placing a shim in the cap, how did he do it?

A. Placed it around the back of the cap or the bearing.

Q.36. With his hands?

A. Yes.

Q.37. So that the shim conformed to the bearing, is that right?

A. Yes, that's right.

Q.38. When, as you have testified, Mr. Blaisdell was working on these automobiles, the 1933 Plymouth as an example, did you observe whether he placed any of these shims on a bearing while he was working on the car?

A. Well, he had a bearing in his hand and he showed me how it worked, that's all. I didn't crawl down in the pit and watch him put it in, no.

C. S. PROWELL, also known as **COURT PROWELL**, being duly sworn, deposes and says, in answer to interrogatories proposed to him by Harold A. Dreckman, Esq., counsel for Party Blaisdell, as follows:

Q.18. How did you become acquainted with Mr. Blaisdell?

A. He was a mechanic and we were sending work out to his place and another place at the time, and he finally went to doing practically one hundred percent of my mechanical work along about that time.

Q.19. Did Mr. Blaisdell ever talk to you about a tapered shim that he had developed?

A. Yes, he did.

Q.20. When did he talk to you about this tapered shim?

A. My first recollection of that is in with a particular automobile. I bought a 1934 DeSoto that was about a year old at the time. As near as I can recollect it, it was approximately one year old, and the bearings were loose on it, and I sent it over to his place to get new inserts put in; and we were having a lot of trouble with the insert bearings on different insert model automobiles because they didn't stay put too well; and he—I sent it over and he came over himself—he either called me over to his place or came over to my place; and he said he had a new deal that he wanted me to try. I was going to use this car for a trip and he had something new that he wanted me to try, and he showed me some kind of a laminated shim that was all in one piece, and it was brand new to me; but he said that he had just rigged the thing up—or had been working on it, or something of that nature. But anyway he had the thing and it was brand new to me at the time, and I was going to take this car on a trip. See, I happen to be from the northwest part of the country and was going to use it for a trip going up there and back. And he wanted me to try it—said that the labor or anything else wouldn't cost me anything, if I just tried it out and gave him and report on it. It was a cinch to me; if I can save a dollar, it was a dollar made, so I did it.

Q.21. What was this date as you remember it?

A. The car was a 1934 DeSoto and the deal came about—about a year from that time. The car was a 1934 and it was approximately a year old.

Q.22. So it was during the year 1935, is that right?

A. It would have been in the year 1935 somewhere, or fall of 1935, as near as I can recall. I remember the car well enough because I used it for several months.

Q.23. Did you observe the tapered shims as they were put into the automobile?

A. Oh, yes, they were put into the car, yes, because they were something brand new and he wanted me to try it out for him.

Q.24. Did you see it go into the automobile; did you see it placed in the automobile?

A. Well, now, just a minute here. If I remember rightly, the kid that was working for me and myself watched the darned thing being done. I think that there were two of us that looked at the thing being done, because it was something new, and any time I can see something new being done, if it goes into my pocketbook, I am going to look into it.

Q.25. To your recollection, then, you actually observed these tapered shims being placed in this DeSoto automobile, is that right?

A. Yes. I saw the—he brought the shim either over to me or called me over to his place to look at it; and I looked the doggone thing over, and other than knowing that it was in one piece—

Q.26. Did you observe that the shim was tapered?

A. Give me a definition of tapering. I will say this much, that it was thicker in the center than it was on the edges. Further than that, I don't recollect, but it was in one piece and it was thicker in one place than in another.

Q.27. That is what I mean by tapered, thicker in the center than at both edges.

A. Yes.

Q.28. You say that you drove this DeSoto automobile?

A. Yes.

Q.29. For how long did you drive it?

A. Oh, some months. Further than that I wouldn't remember, but I did have it for some months.

Q.30. It was satisfactory as far as its operation is concerned?

A. It worked out fine, which was a surprise in those days, because a lot of things weren't as good as they are now.

Q.31. Do you know where this DeSoto automobile is at the present time?

A. I haven't any idea. I suppose it is junked along with the rest of them.

MR. DRECKMAN: That is all.

MR. DOWELL: I have no questions.

And in answer to cross-interrogatories proposed to him by Harry W. Lindsey, Jr., Esq., counsel for Party Cocklin, as follows:

XQ.1. You had purchased this 1934 DeSoto from some user, had you, when it came into your possession?

A. I don't remember where I got it. Now, I do know that I bought the 1934 DeSoto because the particular car had a new type paint on it that they had brought out and I was a little bit proud of it because it looked pretty darned good. In those days, we were all a little hard up, and when we got a car that wasn't over a year old, it was something.

XQ.2. Have you any idea as to how long you drove that car?

A. I wouldn't attempt to say. It might have been three months and it might have been six months.

XQ.3. You drove it until you sold it?

A. Yes, I drove it until I sold it. I do know that it went to the Pacific Northwest with me and back.

XQ.4. That may have been a month or six months after you put in it?

A. It was definitely more than a month because I was on this trip at least three weeks or a month, and I do know that I had it around in Long Beach some while afterwards, probably two, three, four or five months afterwards.

XQ.5. These shims that you testified to, they did the business, did they?

A. When I got rid of it, they were in yet.

XQ.6. When you had it, the car operated satisfactorily?

A. Operated satisfactorily to me.

XQ.7. There weren't any loose bearings?

A. Not to my memory.

XQ.8. Or any loss of oil because of loose bearings?

A. No, I don't think so.

XQ.9. When you sold the car, why, the shims were in it?

A. It was in good enough shape to sell, anyway.

XQ.10. With the shims?

A. They were still there.

XQ.11. The car was bought from somebody up in the northwest, you say.

A. No, the car was bought in Long Beach or Los Angeles. We used to buy some stuff up there and some stuff down here.

XQ.12. Do you know who bought that car from you?

A. I have no idea in the world. I moved my lot to the next door lot about four years ago. I got another lease. The man died next door to me and he had a nice office and I incorporated the two lots at that time and I destroyed all the records that were way back; and I just looked high and low for this situation when Mr. Blaisdell called me up about it. I don't seem to have anything on it, except I remember that car particularly because of the paint job, that when I first got it, oh, it was something for sure. I think it had iridescent paint on it—it stood out. That was when they first brought that stuff out. It might not have been that, but it was a finer paint job.

XQ.13. After this Blaisdell installation of these shims on this DeSoto car, did you talk to Mr. Blaisdell later about the car, and particularly the shims?

A. I imagine I did because he would have wanted to know how it was standing up. That was one of his ideas in getting it into the car that I was going to drive, because I had a pretty heavy foot.

XQ.14. Heavy what?

A. Pretty heavy foot on an automobile.

XQ.15. After you sold this car, you weren't interested in it any more; I don't suppose you followed it?

A. No, I didn't follow the car at all.

XQ.16. You forgot about it entirely?

A. Yes.

XQ.17. Were any of these other Blaisdell shims placed in any of your cars?

A. I presume so, but I wouldn't even know, because he did work for me for quite a number of years.

XQ.18. You were satisfied with this first job?

A. I was satisfied with this particular job, but whether another one ever went into a particular car or not, I would not know; but I still use this type of shim even today.

XQ.19. If you put them in more recent cars than the 1935 installation, you would probably have paid for that job?

A. I wouldn't have known; I have no record of that at all.

XQ.20. I mean, so far as you know, you never had another free deal with him?

A. I don't know whether I have had another set of shims put in. I just don't remember.

XQ.21. I show you a blue print marked Exhibit No. 11, Mr. Prowell, and I ask you if that illustrates the bearing and the bearing cap and the tapered shim, such shim having been the one that Mr. Blaisdell showed you in 1935.

A. Well, now, I am not positive whether this thing was a complete smooth circle or whether it had bumps on the outside edge where it was built up, or not. I remember it was thicker in the center than it was on the ends, but whether it was completely flush or not, or whether there was little notches where they stepped off, I can't remember. I tried to think of that, but I can't.

XQ.22. It was made of brass?

A. It was made of shim stock. I suppose it is of brass. I do know it was thinner on the edge than on the center part; that's the thing that struck me as being different.

XQ.23. It was flat and you just fit it around the bearing?

A. It was flat—for different size shafts; one shim would fit different size shafts as long as it wasn't too wide.

(Pursuant to agreement, further cross-examination of Mr. Mitchell was had at 10:30 a. m., Wednesday, August 10, 1949).

XQ.91. And as I recall, you testified yesterday that you had no recollection as to whom either the 1933 Plymouth or the 1936 Oldsmobile or the 1941 Lincoln Zephyr with the Blaisdell shims were sold, is that right?

A. What is the question again?

XQ.92. You don't know whom any of these cars were sold to?

A. No, I don't.

XQ.93. You had quite a large used car business?

A. That's right.

XQ.94. And these were just sold to whoever wanted to buy them and did buy them?

A. That's right.

XQ.95. Would you recall what other repairs were made on any of these cars?

A. Positively not.

XQ.96. They were just simply reconditioned and put in as good shape as the cars would permit, considering the price you wished to charge for them, is that correct?

A. Yes.

XQ.97. And, of course, the price that you charged for these used cars depended to a large extent upon their condition and operation, isn't that correct?

A. Yes.

XQ.98. In other words, you weren't selling used cars that were very defective in any respect unless they were pretty old cars?

A. Tried to.

XQ.99. You tried to do the best job you could?

A. That's right.

XQ.100. And you charged according to the condition of the car and the age of the car?

A. That's right.

XQ.101. Now, when you sold any of these used cars, the three I mentioned, did you tell the customer that they had these Blaisdell shims in them?

A. No.

XQ.102. You didn't ask the customer to keep track of the oil consumption?

A. No.

XQ.103. In other words, they just bought the whole cars and they didn't know what repairs you had made in them?

A. That's right.

XQ.104. And the price of the car was reflected partly in these repairs, isn't that correct, whatever repairs may have been made?

A. Right.

XQ.105. And as I recall, yesterday your testimony was to the effect that to your own personal knowledge these Blaisdell shims were never taken out of any of these cars, to your own personal knowledge.

A. That's right.

BY MR. DRECKMAN:

Q.32. Mr. Mitchell, have you any recollection at all as to whether you paid Mr. Blaisdell specifically for the installation of any shims in any of these cars that we have been discussing?

A. No, it was strictly an experimental operation; I didn't pay for them.

BY MR. LINDSEY:

XQ.118. But you were satisfied that when you sold the cars they were going to perform the job, were you not?

A. Well, to a certain extent, yes.

XQ.119. You would not have sold the cars if you had any doubts, would you?

A. That's right. That was the reason we observed them.

Rebuttal testimony of **ABRAHAM H. BLAISDELL**, examined in behalf of the party **BLAISDELL**, pursuant to the annexed **NOTICE OF TAKING REBUTTAL TESTIMONY**, at the office of Harold A. Dreckman, Esq., Suite 426, Ocean Center Building, Long Beach, California, commencing at ten o'clock a. m., Thursday, December 8, 1949, the proceedings having been continued from the preceding day by stipulation of all parties.

Q.117. I will show you Cocklin's Exhibit No. 6, a photostatic copy of a letter, and ask if you recognize this letter.

A. I do.

Q.118. Is your signature affixed to the letter?

A. That's right.

Q.119. To the best of your knowledge, you did mail this letter to the Wilkening Manufacturing Company on or about August 6, 1936?

A. Yes.

Q.122. In your letter, Cocklin Exhibit No. 6, the last paragraph on page one of that letter, you state as follows: "In my organization I have extensively used this new method for adjusting bearings. Barring only out-of-round shafts, we have not had a failure." How extensively was your use of these bearing shims at that time?

A. I think we brought that out in the direct testimony. It was two automobiles.

Q.123. No more than two?

A. Not to my memory.

Q.124. At the time that you were writing these letters to these various companies, of which Cocklin Exhibit No. 6 is one, were you attempting to secure national distribution of these shims?

A. Primarily, I was interested in getting engineering skill interested in the manufacture of the items.

And in answer to cross-interrogatories proposed to him by Leonard S. Lyon, Jr., Esq., counsel for party Cocklin, he says:

XQ.240. Mr. Blaisdell, referring to the letter which you wrote to Wilkening Manufacturing Company, which was Cocklin's Exhibit No. 6, are the statements you made in that letter true?

A. They are true to this extent: that the product had been proven and patent had been applied for. However, we did exaggerate as to the number of cars on which it had been tried.

IN THE UNITED STATES PATENT OFFICE BEFORE THE EXAMINER OF INTERFERENCES

BLAISDELL

v.

ALLEN

v.

COCKLIN

Interference No. 83,587

Testimony on behalf of Thomas Jasper Allen

Record for Thomas J. Allen

THOMAS JASPER ALLEN, a witness on behalf of himself, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. State your name, residence, age and business.

A. Thomas Jasper Allen, forty-six years old, address 1069½ E. Spazier Avenue, Burbank, California; business address, 4101 E. Valley Blvd., Los Angeles 32, California; my business is the manufacture of Paramount tapered shims.

Q.2. I hand you a box and ask you to state what it is.

A. It is a box containing twenty-four Paramount tapered shims.

Q.3. Where did you obtain the filled carton?

A. From warehouse stock in Los Angeles.

BY MR. LINDSEY: I will stipulate these shims are manufactured by the Thomas J. Allen Company.

Q.4. Will you briefly describe what the box contains?

A. The box contains twenty-four tapered shims nearly six inches in length, five inches in width, tapered from their center toward their outer edges, terminating in a thickness not over one-half the thickness of the center, packed in celophane bags and each shim covered with a pasteboard of four distinct colors. There are eleven shims .002″ in thickness in yellow pasteboard. There are six .003″ shims packaged with blue cardboard. There are three .004″ shims packaged in pink and there are four .005″ shims packaged in green cardboard.

Q.5. Why the different number of packages of the different thicknesses?

A. Over a period of approximately a year . . .

Q.6. From when until when?

A. Over a period of approximately a year, starting at the beginning of my manufacture, it was found by packing the number of shims used by various shops, auto dealers and used car lots, that use of every twenty-four shims, they were used in these proportions.

Q.7. Explain how these shims are used.

A. The mechanic must first determine the thickness of shim to be used in the bearings. First the oil pan is removed—any other part of the engine such as oil pump, etc., is removed out of the way so you can get to the bearings necessary for adjustment. The bearing cap of the connecting rod or main bearing, depending on which bearing is adjusted, is removed and one way of determining the clearance in that particular bearing would be to cut a thin strip of material of a given thickness, the strip should be very narrow as well as thin. Usually in fitting up these shims they cut a strip off the end of each different thickness of shim, laying the strip on the inside of the insert—that is, the crank shaft side, with the tapered edges of the shim extending toward bearing splitline. Then replace the cap and insert back in position tightening the bolts or nuts which hold the bearing cap and feel the drag on the fly wheel. If a thin strip of this shim just mentioned is of too thick material, the drag of the bearing will be heavy and in some cases the crank shaft could not be turned by hand. Therefore, the cap should be loosened and a thinner strip placed in the insert in the same position as the first, removing the first thick shim and replacing it with the thinner shim, going through the same procedure in replacing and tightening the cap back on to the connecting rod or upper portion of the crank case or shoulder block, as the case may be, and continue through trial and error stepping down gradually in the thickness in this foregoing explained procedure until a point of tightness is reached to where there will be no drag on the crank shaft by the bearing.

Q.8. In installing a shim and knowing about how thick the shim is designed how does the mechanic actually obtain and apply the shim from one of your packages?

A. After he has established the thickness that he needs, he will select his shim by the thickness of the shim's figure in thousandths of an inch which is printed on each package of the cardboard folder and on the back thereof. After removing the bearing cap that he has just checked for clearance, he removes the insert, placing it over the shim at one end, leaving the end of the shim and one side of the insert even, and with a pair of scissors or tin snips cut through the cardboard package celophane bag, shim and all—then remove the portion which is cut the width of the insert bearing from the celophane bag and placed it around the outside diameter of the insert bearing, bending over the thinner outer edge of the shim, leaving the thickest section of the shim as near the lower center of the insert, holding the shim tightly by the bent-over edges. He then replaces the insert with the shim tightly held to the back in the bearing cap. Then scribing or tearing the protruding ends off, being sure to leave no material at the split line of the cap or bearing insert, he places the assembled insert shim and cap back into position.

Q.9. I hand you a sheet marked for identification Allen Exhibit No. 1 and ask you what it shows with particular reference to the illustrations marked or numbered from one to five.

A. It shows the five steps of the installation beginning with No. 1 step all the way through as I have tried to explain it.

Q.10. As you have made your last explanation?

A. Yes, with the exception that it does not show the assembled or assembly on the connecting rod on the engine.

Q.11. Mr. Allen, you have described the product that you sell; when did you begin to sell that product?

A. The first shims that went on the market were in July 1946.

Q.14. Mr. Allen, will you tell us the different positions you have held?

A. I will itemize the following as positions I held up to the time I worked for the government:

1. Father's garage, Clarendon, Texas.
2. Night engineer at Clarendon, Texas.
3. Maintenance chief of a number of tractors in Texas Wheat fields.
4. J. E. Duncan, Ford Dealer, Wichita Falls, Texas, advanced to shop foreman.
5. Fritz Motor Co., Morman Dealer, Wichita Falls, Texas, mechanic.
6. Dixon Motor Co., Buick Dealer, Wichita Falls, Texas, mechanic.
7. Dixon Motor Co., Electra, Texas, advanced to shop foreman, 1923.
8. Worsham Buick Co., Dallas, Texas, advanced to shop foreman.
9. Worsham Highland Park Buick Co., Dallas, Texas, service manager.
10. Worsham Buick Co., Main Office, Dallas, Texas, tester and service salesman.
11. Dixon Motor Co., Buick Dealer, Wichita Falls, Texas, shop foreman.
12. Buick Factory, Dallas, Texas, Branch, service representative, overseeing service department of 55 dealers.
13. Buick Specialty Service, Dallas, Texas, own business.
14. Cord's Piston Ring Agency (own business) oil fields of East Texas. Sold this business and took the Cord agency for Beaumont, Texas. Sold this business and took the Cord agency for El Paso, Texas. This territory had been worked by Cord's ring agent and did not come up to expectations; therefore, returned

to Houston, Texas, with the state representative of Cord.

15. Took the Coil Piston Ring agency at Beaumont, Texas. Sold this and took the Coil agency at San Antonio, Texas. With this agency, I sold these Coil Piston Rings and then turned my attention to developing a spring type piston expander that would give me what I needed in the way of expansion.

Q.21. Tell us why you waited to continue with the expanders, or if you had some other product in mind.

A. During the latter part of this period I had another product in mind.

Q.22. Will you explain it?

A. On or about October 16th 1939 my car, a 1934 Oldsmobile, was pumping oil.

Q.23. Is this the car referred to in the first sheet of Allen Exhibit #5?

A. Yes.

Q.24. Proceed.

A. So I decided that I was going to try an experiment that I had thought about on several different occasions before. I saw the need of some way to re-fit insert bearings to crank shaft to help overcome oil pumping. On an automobile it is generally impossible to place a shim of equal thickness all the way around the outside diameter of the main bearing inserts due to the fact that an oil hole is provided in the cylinder block immediately over the insert bearing box or holder—the hole indexing with the upper half of the insert bearing and the crank shaft being in the way for complete removal of the upper half of the insert bearing without sliding the insert bearing out of its upper half around the crank shaft. By placing a shim on the upper half it would probably wrinkle and you could not index a hole in a very thin shim as you forced the upper half of the insert bearing back in position; therefore, for an efficient job the main insert bearing would have a shim for the lower half only. Knowing that we could not place a shim in the lower half of equal thickness from end to end because it would extend only half way around crank shaft the cap splitline being in a horizontal plane, the lower center or the vertical center of the center line of the crank shaft would be—for example, of even thickness of shim stock, would have that single thickness at lower center, its ends would be of equal thickness on each side of splitline causing a pinch at the splitline of the amount equal to the amount of the thickness of the shim. Therefore, realizing that the end portion of a shim placed behind the insert bearing between the insert bearing and cap would have to be at least one-half the thickness of the center and in some cases with extreme bearing wear, less than one-half the thickness of the portion that was placed at the center in the lower portion of a bearing cap between the insert bearing and cap, I proceeded with the thought in mind to use this experiment on my car. However, at this particular time I did not know exactly how I was going to make it, but I had planned to use a thin layer of some material and build it up in steps in lamination. I made arrangements with Mr. Lee A. White, who owned and operated a piston ring, piston expander shop and small machine shop located at 403 Brooklyn, San Antonio, Texas. Arrangements completed, I brought my car down early one morning to the Brooklyn Street entrance of this establishment and waited for them to open up. Immediately after they opened, I drove my car into the door as far as possible. A portion of the rear end of the car extended out on the sidewalk. I proceeded to drain the oil, remove the crank case and pull the connecting rod bearing caps. I looked at the insert bearings and they were in good condition, and I took a roll of tinfoil out of the car which I had brought from home. I knew I would have to straighten this tinfoil out because it was in a roll, so I brought an iron down with me.

Q.25. Is this the iron marked for identification as Allen Exhibit No. 3 to which you refer?

A. Yes.

Q. 26. Whose iron was that?

A. It belonged to my wife and I.

Q.27. Where has this iron been since that time?

A. It has been in our possession.

Q.28. You said something about this roll—was it in a ball?

A. It was a ball of tinfoil.

Q.29. You also stated you tore the engine down—did you do anything to any other part of the engine?

A. After placing the shims that I made in the connecting rod insert bearing . . .

Q.30. Please proceed with what you started to tell us about how you made the shims.

A. I took the ball and I pulled the layers off the ball, laid them down and ironed them out. They were not of the same material because I remember definitely that some of them cracked and were brittle as if a foil made of lead or something. They suited me because I was thinking about the steps that would be created with the lamination in the extreme ends of the shim that laid together and I wanted considerable for them to be soft so there would be not such abruptness. After ironing these out I took some pieces cut off to check the clearance. I cut these pieces off this material I had ironed out flat. I don't remember how many pieces I put together—I don't know if they were all the same throughout the job—I don't remember as to the number in excess of three—it could be possible I only placed two in some of the bearings, but I am almost positive that I placed three or more in each bearing. I made the shim by laying the pieces I had pulled off out flat on either the bench or board, it seems I had a board—I am not sure—but it might have been the bench. There was some wrapping paper there that I used over the board and laid the material on top of the wrapping paper and pressed it out. This was with a cold iron—I did not have it hot. After pressing these pieces out I remember that I was trying to figure out what to stick them together with. I didn't want to use grease or heavy oil because in some cases I have seen where heavy oil used, when you start to put extreme pressure, causes slippage. The thought came to my mind I would have some trouble with it slipping out. After laying the pieces out and getting them large enough to cut a shim, I procured some wax, paraffin wax, and I shaped this. It came in a package the size of a flat cake about six inches long, about two and one-half to three inches wide and one-half to five-eighths inches thick. I shaped the paraffin or rather scraped it off on top of the piece I had laid down, placing another piece on top of this, then shaving off more paraffin and placing another piece on top of it. In other words, I put paraffin in shavings between the layers of the shim I was going to stick together. These layers were trimmed to the length I was going to leave them when I finally laid them on top of each other, but they weren't trimmed to the width of the insert bearing. Then with the iron heated, I pressed over these layers, and I found that the shim stuck to the paper. I thought at the time that the paraffin melted, would penetrate the paper and when it cooled, which was very rapid, that was the cause of its sticking so tightly, so I tried to cut the celophane off a cigarette package and with the iron heated I found that they wrinkled up and it blackened a portion of that iron—the center portion—not on the edge but on the bottom. I tried celophane on one side and on both sides. My reason for trying the celophane was that the heat melting the paraffin caused it to saturate the brown wrapping paper and the shim was stuck to it and it was hard to get it loose without bending up the shim or mutilating the shim. I found that did not work and I finally got a rag, placed it underneath on the bench under the shim and it worked fairly good, leaving the top part as I ironed this shim exposed. That is, I used nothing on the top except just the iron and I had no more trouble.

Q.31. In other words, you placed the cloth on the bench doubled, placed a strip of foil on that with some wax on top of that and a shorter strip of foil on top of that and still a shorter strip on that so that you had the thicker portion in the center and pressed with an iron.

A. I had the pieces laid out with a large piece that would extend to the approximate ends of the insert bearing, then a piece that would extend a lesser distance and then a shorter piece and then a shorter piece—then I ironed it together with the paraffin in between them. Then I took the insert bearing and laid it with the cupped side up on this lamination setup I just pressed together, and I rocked the insert bearing back and forth to get the width and took a pair of scissors or a small pair of tin snips and cut the same out where it had been marked. Then this was done for all the connecting rod bearings at this time. Then I took the insert and placed the shim on the back side of the insert, trying to form it, which I did, with my fingers so that it would conform to the outside diameter; then I placed one edge of the insert in the bearing cap, and forced it into position. I then placed the cap back on the connecting rod in the engine. I did one of these at the time and placed it back in the engine on the connecting rod and tightened it up. I did not have to disturb any of them as far as changing the thickness of the shim after the first installation. When I drained the oil before I removed the pan, I observed the oil as being very dark and had a very strong odor of burnt oil, but I did not decide to do anything to the piston rings or any portion of that section of the engine until after I made the installation of the shims. The dark oil and the burnt smell indicated to me blow-by, which is the gases of the combustion chamber moving down in some manner by the pistons and rings in the crank case. I decided that I would remove a piston or two to see just what the trouble was. The reason that I had not given this any thought before was due to the fact that in re-fitting bearings, it is better to re-fit the bearings before you remove the pistons or do anything to the upper section of the engine as far as removing the piston rings because you could not feel the drag of the bearings if the piston rings were installed before the bearings were taken up, especially if you were to use the expander type ring. So after fitting up the connecting rod bearings, I removed one or two or three, I don't remember exactly, but on one of the pistons I removed at that particular time I found a top piston ring stuck in the grove at one end and it was blackened—a portion around the ring from the stuck end. I removed the other pistons then and I found one or two more that the rings were stuck in the top grove. I removed these rings carefully without breaking them and when I examined them to see how much they were worn, I found that the wear was normal and not excessive and not willing to spend any more money than I had to on my car, I decided to clean the edges of the rings off, remove the carbon, clean out the groves and if necessary, remove a little material to give the ring proper clearance. Mr. White, the last time I was in his shop prior to this day, had back in the back end of his shop a Hastings Piston Machine. I will call it a piston machine—it may be some other name technically, but it was a ring fitting machine. This machine was gone this day. I contacted Mr. White and he told me he had sold the machine to Mr. Gailey of Simplex Motor Parts. I took my pistons with the rings off in a box—I don't remember whether a pasteboard box or what—over to Mr. Gailey's and asked him if I could use the grove machine to turn the groves.

Q.32. Are you referring to the Hastings Machine?

A. Yes. I do not remember his exact words, but he let me use his machine. I know he had just gotten the machine because he had it sitting away from the wall—it was not in position, and I had trouble getting my pistons in there because I had not used that machine before myself. I had the rods on the pistons; therefore, I asked for some assistance in centering the piston on the turn table. The reason I asked for this assistance was when I pushed the top rotating block that holds the piston down on a convexed turning table and began to try to center that piston with the roller which were forced up against the piston moving it to the center as the table turned, I found they didn't know anything about it either.

Q.33. Why didn't they know how to use the machine?

A. I suppose they just got it and that was the reason and had done no work on it. In centering the piston, I found it impossible to get the piston exactly centered, so I proceeded to remove the carbon and possibly widen the ring grove slightly, cutting the ring groves on down to the solid bottom. I cleaned out the carbon all the way down to the bottom of the groves and I cleaned the oil rings and the metal ring by using a fine emery cloth or sandpaper Mr. White had and using my windshield on my car to rub, using windshield as a perfect surface to surface each side of the ring. I cleaned the carbon out of the oil rings and I did this to each side.

Q.34. Did you return these pistons or put in new rings?

A. I put the same rings back on the piston after bringing the pistons back to Lee White's shop. I then proceeded to re-fit the four main bearings with the shim set-up as used on the connecting rods. Then I removed the bearing caps, replaced the pistons in the cylinders, fastened the caps back on the rods without disturbing the lower half of the insert I had fit up with the shim and completed the assembly of the automobile.

Q.35. How long did you keep that automobile?

A. I kept the automobile until approximately January 30th, 1942.

Q.36. How do you explain that this first sheet of Allen Exhibit #5 has 3–1–42?

A. 3–1–42 I think was when the application was given and sent out to Mr. James to whom I sold the car. The application was applied for on 1–30–42. That is the day I applied on the court house books over here. They did not have the titles back of 1934 and at the time I sold the car I had registered it but title was not required until the selling of the car or transfer; therefore, I applied for a title and at the same time I transferred it to Mr. A. M. James. That day I applied for the first title which I never did receive because they had turned my registration certificate and made notation on the back.

Q.37. How long was that after you made this overhaul and inserted the shims?

A. A little over two years.

Q.38. During that period of time how much did you drive the car? Did you drive it hard or light?

A. I would say my route which I covered about once every six months was about nineteen hundred miles. We made trips to Corpus Christi, Texas; we made one or two trips to St. Louis, Missouri—one trip I believe. I would say I probably drove the car—this is merely an estimate—about six or seven thousand miles per year. I didn't drive it too much but drove it fast and hard when I drove it.

Q.39. What was the situation relative to oil pressure when you overhauled it—before the overhaul and afterwards?

A. I had low pressure and the car was smoking at the exhaust pipe before I installed the shims.

Q.40. And afterwards?

A. The oil pressure was back up to normal.

Q.41. Approximately how many pounds?

A. I don't remember whether you have a gauge graduated within five pounds, but it is about half way on the gauge if a thirty pound gauge, fifteen if a sixty pound gauge—it would be thirty pounds or slightly over half center, so generally I would say about thirty pounds.

Q.42. What was the result of the use of these shims?

A. The result I obtained and what I made the installation for was very satisfactory.

Q.43. By very satisfactory, do you mean completely or partially satisfactory?

A. I was using about one quart of oil to every 250 miles before I put the shims in and before I cleaned the rings up and re-installed them and then I used one quart of oil to about every 1,000 miles after I made the installation. Therefore, I would consider it satisfactory. When I quit using the car myself about

December 1940, I was still obtaining that oil consumption.

Q.44. You have described how you produced the shim. Did you ever hear or get any information from any source relative to this shim before you produced it in 1939?

A. No.

Q.45. Had you ever heard of any of the parties of this interference at that time?

A. No.

Q.46. Was this idea entirely and completely and absolutely original with you?

OBJECTION BY MR. LINDSEY AS LEADING QUESTION.

A. Yes.

Q.47. You stated this Oldsmobile operated satisfactory. In other words, you made this shim or a number of them, installed them in your Oldsmobile, tested them and found them satisfactory. What did you do after that?

A. At the time I made this installation I was not satisfied with the product, even though I found it did the job at that time. I was not satisfied due to the fact that I knew the steps would not form a perfect seat in which the insert was to ride, and I began thinking of a tapered shim—a gradual taper to be placed around the insert bearing and reduce the diameter of the lower half. I did not know how to make it. I studied on how to make it. I had never had any experience in rolling those, but I knew at the time to make the shim in a wide piece out of hard material or harder material than this foil I had used would take an extreme amount of pressure. I began to think how I could build up any amount of pressure that I wanted on rollers. I had been around a few machine shops where they had dies and punch presses.

I didn't figure you could take a shim of this size out of hard material and make with a die. I knew it would have to be rolled or possibly ground. I gave up the grinding idea, knowing that brass, copper and aluminum would load up the grinding wheel rapidly and the material would have to be so thin using it as a shim that it would heat up, so I did not experiment with that. I decided to use all my efforts and thoughts to think of a machine of some manner in which I could roll the shim.

Q.48. When did you conceive of a one piece relatively thin shim thicker in the center and tapering away from the center to more or less feather the edge and to whom did you disclose such a venture?

A. It is possible around the time I thought of the solid tapered shim before I tore my car down, but I made the installation on my car in 1939. At that time I talked to Lee A. White and told him that I didn't believe I would have too many difficulties—that if this proved out alright, which I was sure of, we were talking about the possibilities of selling it out on the road as a by-product or product to go along with my expanders. My thought was that any mechanic could take any kind of thin shim stock and make installation in his own shop as good as that product would be in the manufactured product, and that we would not have any selling point and I couldn't meet distribution. I told White if I could make a shim with a gradual taper where the mechanic could make the installation and have a perfect fitting bearing that I knew this thing would sell and sell fast. We could sell a lot of them.

Q.49. Was anything said about a come-back?

A. Yes. I told White I had been looking for something I could sell that would stay sold without a come-back and that a tapered shim would be that.

Q.50. Was White in accord with your ideas or what was his idea?

> OBJECTION BY MR. LINDSEY: I object as to what someone's attitude was.

Q.51. I will rephrase it—did White evidence that he had confidence in your proposed judgment?

> OBJECTION BY MR. LINDSEY SAME AS ABOVE.

A. When I first spoke and told him of this idea, he laughed and told me he didn't think it was worth a darn. That was before he knew the exact function of this shim. After I had explained to him that I was going to make it thinner on the edges and thicker in the center and that I proposed to make it tapered instead of in steps, he told me he thought that might be a pretty good thing and agreed with me.

Q.52. To whom, if any others, did you explain your invention at that time—in 1939?

A. I showed this thing to Mrs. White and I am confident I did because I remember she was at the station as usual, her job being to answer the telephone. I remember her coming back into the shop on several occasions, but I don't know if I explained this to her in detail. If I did, I don't remember it.

Q.53. Did you show it to anyone else in 1939.

A. I don't think so—not at that time. However, when I carried these pistons over to Mr. Gailey's I showed him a portion of the shim through the insert bearing oil hole. The bearings were assembled with the shim in them and fastened together with the cap and connecting rod. I didn't want to disturb them, so I told him I was experimenting by putting a laminated shim in there. I showed him the portion of the shim that could be seen through the oil hole in the insert bearing.

Q.54. Who else knew about what you were doing about that time?

A. My wife.

Q.55. How long have you been married?

A. Sixteen years.

Q.56. You were married around 1933?

A. In 1933.

Q.57. What did you do between the time you disclosed it to Mr. Lee White, Mrs. White, Mr. Gailey and your wife until the time you began manufacturing. Account for that period will you please, if you can.

A. As I said, I was thinking of how to build a machine. This began after I made the installation in 1939. I began to think how to build the machine to put enough pressure on rollers to roll a shim holding it to the accuracy I would like to hold it to, and I began to make drawings. I would spend some portion of nights very often sitting on the side of the bed thinking. I would go back to the table in the trailer and make a sketch of a new idea I had thought up, sit down and analyze it after I had drawn it up, figure it would not work, start thinking of another machine, different type, make sketches of it, try to analyze it, figure it wouldn't work and I kept this up fairly consistent and when I say fairly consistent, I did this often. I don't believe it was a matter of over just a few days that I didn't spend quite a lot of time thinking and making drawings on how I was going to build this machine because it was so vital to me if I could build it, I knew I could make the shims and sell them.

Q.58. Why didn't you purchase a machine already in existence?

A. I don't think there was any machine in existence.

OBJECTION BY MR. LINDSEY AS HEARSAY.

A. I had never seen anything that was rolled down to that thinness in the form of a taper and I knew that the average roller could not exert that much pressure; therefore, I decided to design my own machine; also I didn't want to go out trying to get this thing made because I was afraid I might lose my invention and that I could make more money on it if I could design a machine that would make it to where I could make it myself.

Q.59. You speak of sitting on the side of the bed in a trailer, how long did you live in a trailer?

A. I lived in a trailer from the latter part of 1936 or early in 1937, or I will say approximately the first of 1937 I lived in a trailer constantly until the latter part of November 1948.

Q.60. What were you doing during these years to bring you in an income?

A. What years?

Q.61. 1939 to 1946?

A. From 1939 until April 7th, 1942, I manufactured and sold piston expanders. On April 7th, 1942, I went to work at Kelly Field, Texas, in Civil Service. I remained in Civil Service until the first of May, 1945, at which time I terminated from Civil Service, returning to San Antonio and then to California for the purpose of manufacturing and making the tapered shim. On an expander machine I had discarded in 1945, I had some expanders made up, and I carried these expanders with me to California to sell at the same time I was developing the machine. When I arrived there, I found I could not sell expanders in the zone where I was living. I found I could not manufacture in the zone in which I was living, finding that an "M" zone in Los Angeles in one, or two or possibly three zones (manufacturing zones) would allow manufacturing. You could also handle wholesale automotive parts if you wanted to in an "M" zone. I put in an application in the latter part of 1945, at 4101 East Valley Blvd. to move into this "M" zone, so that I could sell expanders and also sell shims if and when I could produce them. I registered with the State Equalization Board and got a permit where I could buy material used for resale without tax. This was as an automobile accessory and parts, something like that, because that was the business I was going to work at the same time I manufactured the machine. I asked at the same time I applied for this what about manufacturing in this zone. They said it was alright—that I wouldn't have to come down and change because I would sell wholesale—to just continue under "T. J. Allen"—They said that it would make no difference whether I manufactured or whether I sold automotive parts and equipment. I started to sell expanders. I found by selling expanders I could not spend my time on the machine that I had decided to manufacture at that time. That was alright after the first of the year in 1946. I had to wait until I could move down to this place before the sale of any expanders. I believe we moved in February or early part of March in 1946. I sold these expanders a short time because I couldn't continue to work selling expanders and spend time designing and building this machine.

Q.62. Why didn't you manufacture right away, or rather why didn't you move right down to the location at 4101 East Valley Blvd.?

A. Because I intended to sell expanders and sell shims if and when I could produce them. I was going to sell expanders and try to offset the cost of the machine. The location was not available until this place had been refinished. It was torn up in putting water lines in. We couldn't get it until that time. We moved in it before it was completed in order to get it.

Q.63. How much delay did that cause you?

A. Approximately three months.

Q.64. Did you know you had a machine in mind? Did you have a mental picture in mind, that is to say?

A. I had a mental picture.

Q.65. Did you build such a machine?

A. I did. I not only had the mental picture but I had quite a few sketches.

Q.66. Did you make sketches throughout the years from 1939 to 1946?

A. Yes.

Q.67. What did you do with them?

A. I made so many. I would make a sketch, tear it up and throw it down. I did this up until some time after I went to Miami, Florida from Kelly Field. I kept a lot of those sketches I had made previously before I went to Miami. I had them in a trunk that was in storage out at the place where we used to live on the Austin Highway. They were thrown away with all my old expander papers at the time we threw away the machine I had built for building expanders.

Q.68. Why did you throw this away?

A. I didn't think I had any need for them because I had some sketches I had drawn up which I had decided I would follow very closely.

Q.105. Why did you go to the Chase, Brass & Copper Co.?

A. I found out they handled copper and in the early stages of my experiment, I had gone down there on several occasions and Mr. Grady has been nice enough to give me copper in small quantities, two, four or five hundred pounds.

Q.106. Do you mean sell it to you?

A. Yes, sell it to me, and I kept going back as long as I experimented and on these dates here you will notice on the invoice I purchased my first large amount of stock. There were invoices prior to these beginning in the first quarter of 1946 but were for small quantities—very small—and I never found them.

Q.107. Did you have any discussion with Mr. Grady about the possibility of making shims and did you show him the shim?

A. When I went in to buy a large quantity of material in the first part of 1946, there was an employee there, either working out of there or down from Cleveland, I don't know which. Mr. Grady asked me what he was, I mean what I was doing to use so much copper for and I told him I was going to make a tapered shim for automotive insert caps. The copper I was going to buy from him and had bought was for .005 thickness. I was taking .004 and rolling down to .002 or under on the ends or edges, tapering from the center to those edges and on the .005 I was rolling down to .002¼ and in some cases .002½. He says you haven't done that yet or something to that effect, and I told him I had. He said he didn't believe it could be done. I walked out to my car and picked up a shim and some pieces that I had been experimenting with rolling, and I brought them in and handed one piece to him and laid the other on the sales counter. I took the piece, I mean the one I had handed to him he miked and told me that I had gotten the taper in there, but he still didn't believe it could be rolled. He took the piece of shim and the micrometer and went to the back of the store and came back with this man, he introduced as an employee. He said he had never seen anything like it, and said I was having some difficulty, which I still have in rolling the shim to where when it is unrolled, it doesn't look flat when pulled out, although in miking it, it is close to perfection and accuracy—miking it the long direction, and he said he might be able to assist me if I would let him come out to the shops and see my machine. I refused to let him come out to the shop and I left. That is the last I ever heard of him until the other day.

Q.130. All through the years you said you were working on how to produce a solid shim not laminated but with thinner edges. Why didn't you file your application for patent on that before 1946?

A. At first I did not know whether I could make the shim or not. A patent on the product I have made would not be any good to me, money was scarce and I wanted to see if I couldn't figure out some way to make it to where I would be satisfied that I could produce a shim without spending the money necessary to make out an application.

XQ.66. Did you testify yesterday as to how far you had driven this car after you had done work in October 1936?

A. I made an estimate, I believe, which was a guess—around six or seven thousand miles a year, basing my testimony on a few trips to Corpus Christi and one to St. Louis. I believe that was my testimony on an estimate.

XQ.67. Between October 1939 and the time you gave up possession of the Oldsmobile, early in 1942, what other work did you do on this Oldsmobile?

A. I am bound to have done some other tune-up work, but I don't remember any other major work I did on the work. But, I didn't drive the car from October 16, 1939, on through until January 30, 1942. I put this car up at the trailer park in December, 1940, because I had bought a new Ford and I drove that Ford. This car sat there until July, 1941. It was not registered nor license bought until that date in July,

1941. We had friends who had a new baby. He lived in the south part of town. He had to come to the other side of town for goat milk for his wife who had a bad stomach. I let him drive the car two or three months.

XQ.68. Shortly after this you sold this Oldsmobile automobile? You were then employed by the U. S. Government at Kelly Field?

A. To be exact, I went into service April 7, 1942.

XQ.69. Were you in San Antonio from the time you turned over possession of this car until you went to Kelly Field?

A. In and out. I don't say I was in San Antonio all this time. I was selling piston rings.

XQ.70. How much territory did you cover?

A. My territory extended from here to Houston, to Galveston, and back in here by Victoria. My route was from here to Mexia, up to Corsicana, to Sherman, across to De Kalb, this side of Texarkana, into Dallas, and it ended there and I drove back to San Antonio.

XQ.71. So you were out of town considerably?

A. Not considerably, because I had expanders on consignment, and I left them on consignment five or six months.

XQ.72. You had driven the car after October, 1939, sufficiently to satisfy yourself that the laminated shims which you placed in the car were performing satisfactorily; correct?

A. As far as I could tell, I was perfectly satisfied with the performance for the mileage that I drove the car. I had no reason to believe the shim was not doing the job, but it was not the shim I wanted to make and sell.

XQ.73. Otherwise you thought it was performing the function very satisfactorily?

A. As far as I believe, yes.

XQ.74. You were more concerned with the commercial aspect of the situation rather than with the practicability?

A. I was interested in both. When I have an idea I try to develop that idea to where it will be the best instead of something half way.

XQ.75. You are not answering my question. I was not referring to the late shim, Mr. Allen. Remember my question: At the time you sold this car you were satisfied that the shims you placed there were satisfactorily performing the function for which you inserted them?

A. Yes; up until that time.

XQ.76. The bearings were satisfactory, as far as you know, at the time you sold that car?

A. I think so.

XQ.77. The oil consumption was satisfactory for a car of that age?

A. Yes.

XQ.78. Who did you sell the car to?

A. A. M. James.

XQ.79. Did you tell Mr. James at the time you sold the car that these shims were in the car?

A. No.

XQ.80. You told him the car was in pretty good condition?

A. No.

XQ.81. Who sold the car?

A. I did.

XQ.82. Did he know anything about the car?

A. I don't remember. I believe he drove it home one night. I sold it cheap.

XQ.83. How much?

A. $75.00.

XQ.84. Was it a trade-in?

A. No.

XQ.85. Why so cheap?

A. Because at that time I needed the money. I had no use for the car and it was sitting there deteriorating, and that is why I sold it so cheap.

XQ.86. Were you a close friend of Mr. James?

A. No.

XQ.87. Do you know where he lived at the time you sold the car to him?

A. I think I might have seen his address. I know he lived on Lullwood, and I am pretty sure of this, but I am not positive because I had a mortgage on the car. It was not all cash.

XQ.88. Do you know when the mortgage was paid on?

A. Yes.

XQ.89. Please state.

A. I want to answer this question differently because I don't know exactly when he paid me. He paid me $15.00 or $20.00. As I remember, I sold him the car for $75.00. He paid $37.50 down and $37.50 over a period of two or three weeks, and the reason I answered yes to the question, I was thinking of title charge.

XQ.90. What was Mr. James' job at the time you sold him the car?

A. He was a night watchman, for a project on Military Highway where the Austin Highway crosses Military Highway.

XQ.91. How far out of San Antonio is that?

A. From the City Limits, around four miles.

XQ.92. Do you know if he ever had the car serviced by any one?

A. No.

XQ.93. After you sold the car you did not follow it any further?

A. Not until recently.

XQ.94. Until these interferences were declared, then you had the title of the car traced and the car was in San Antonio?

A. Yes.

XQ.95. The car was partly disassembled in San Antonio last Saturday before you arrived; correct?

A. Yes.

XQ.96. Did you ever ride in the car after you turned possession of it over to Mr. James?

A. No.

MARY ALICE ALLEN, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. State your name, age, address, and business or occupation.

A. Mary Alice Allen, thirty-eight, address 1069½ E. Spazier Avenue, Burbank, California; housewife.

Q.2. State whether or not you are the wife of the Thomas Jasper Allen involved in these interferences who just testified?

A. I am.

Q.14. What is the next thing he did after he overhauled this car relative to this shim?

A. I do not understand the question.

Q.15. What was the next work he performed, if any, relative to the shim?

A. I can tell you that because he disturbed my sleep many nights by sitting up on the bed, running to the table to make drawings—he said it was for machines that he intended to develop for a shim. I mean for manufacturing a shim.

Q.16. When did you say this period of restlessness began?

A. It began from the time he put the shim in the car up through the war and on into California until he completed his designs for the machine.

Q.17. Was that about the time he put the shim on the market?

A. He didn't put the shim on the market until 1946.

Q.18. Did this period of activity extend until that time?

A. Yes, and after that and still is.

Q.19. Was this periodic, constant or how?

A. Well, before he entered the service, it was very, very often—I would say every day or night. Then when he took the job with the Civil Service due to extremely heavy duties, perhaps he skipped three or four days at a time, but many nights he worked until twelve and one on designs. He intended to devote his efforts for manufacturing this machine as soon as the was was over.

Q.33. What was your financial condition in 1939 until he entered Service?

A. We lived very moderately. We did not have too much financially; everything we had we had to invest in our business to keep it going. When he entered Civil Service we made it a point to save everything in order to get into a better position. I worked along and taught school in San Antonio. I worked in Civil Service as a production clerk. I saved $1,100.00, of which I gave him all, except a $25.00 bond, for use on tapered shims. When we completed our machine we were very, very worried; in fact, when we went to Los Angeles my health was very bad because I had worked very hard. I was so exhausted and worried that our money was going down so fast, so I took a job with the Los Angeles News Company as a clerk. I made $1.00 an hour and I figured $8.00 a day, plus overtime, would give us enough to live on that he could terminate his expander business and put his time on this machine, which he did. When he got ready to come on the market with this product about all we had left was the $25.00 bond, and that was all. From there it has been very successful so far. May I also state, while working at the Los Angeles News Company I worked eight hours a day. We lived in a 20′ trailer. Because our funds were exhausted I spent those eight hours at the office and I helped him cut steel; I mean by that, I worked each night four hours. I did our cooking and the laundry. I got up at 5:30 in the morning and fixed breakfast for us. That lasted from April until next May. I also turned our trailer and the little porch it had into a packing house, in which I had to move out before I moved in each night, until it just about broke us both down. It was most embarrassing for people in the trailer park to come by and see us packing and doing this work with the shims, but that was the best that we could do.

LEE A. WHITE, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. State your name, residence, age and business.

A. Lee A. White, 42 years old, 706 Elmira St., San Antonio. I operate an advertising agency.

Q.8. What kind of automobile did Mr. Allen have then, if any?

A. T. J. Allen, from the time I met him had a 1934 Oldsmobile.

Q.9. Did he ever do any work on this car?

A. Yes; he worked on that car in my place of business.

Q.10. What did he do to it?

A. He installed these tinfoil shims under the insert bearing in my place.

Q.11. About what time was this?

A. I couldn't establish an exact date, but I would say sometime after the middle of October; as a matter of fact, about October 16, 1939. Because of something that happened, I remember this date.

Q.17. Did you observe him putting in these shims?

A. Yes. We had quite a discussion.

Q.18. Tell us about it.

A. Mr. Allen pulled a piston, I mean the pan, and pulled the cap, and then came over and showed me what he proposed to do, and I laughed. I said I did not think the idea was worth a darn. Then be elaborated and said, "I know what you are thinking," but that he hadn't told me the whole story and that he intended to put these in in lamination, which would make it thick. I asked him if he meant with tinfoil. He said, "No, not in the final development, but as an experimental deal." I asked him if it would stay in and he said yes. I told him I didn't think it would, but that it looked like a heck of a good idea. He said he would use a long one, and a short one, and a shorter one in order to achieve a lessening which would take up bearing slack. I later saw him pressing out tinfoil which he got off of a ball and cutting it to exact sizes and making these shims, and he showed me how he was putting them under the insert.

Q.25. According to your testimony, Mr. Allen tore down his car and inserted shims, and you told us what those shims were. Please tell us what happened after that.

A. The car was reassembled and he went on.

Q.26. Did you have any knowledge of the operation of that car for the period of time after that?

A. Yes, for several days. The oil pressure had gone back up to between 40 to 45 pounds and it was operating in a quiet manner.

Q.27. What was the oil pressure before?

A. About eight to ten pounds.

OBJECTION BY MR. LINDSEY: This is merely a conjecture.

BY MR. DOWELL:

Q.28. Did you notice whether it was low or not, that is, the oil pressure, before?

A. Yes, it was.

Q.29. And after he made the installation, what was the oil pressure, normal, high or low?

A. Normal.

Q.34. Did you have any occasion to become acquainted with the oil consumption or operation of the car after that?

A. Not definitely. I asked him several times how the car was running, and he said he was tickled to death with its operation.

Q.49. What did Mr. Allen propose to do after he made this installation of these shims. I believe you stated, but I would like to have you restate it.

A. His statement was this: that if this experiment worked out using lamination in order to achieve a tapered effect, he was going to start working on a device to manufacture a tapered shim. He remarked further that "wouldn't it be nice to have something like this on which you would have practically no comeback".

OBJECTION BY MR. LINDSEY AS HEARSAY.

Q.50. What do you mean by "no comeback"?

A. In any sale of piston rings or bearings it is possible to have mechanical failures. Our analysis of this was that it was more or less a foolproof item to sell. You put it in there, fit your bearings, and it could not get out, as has been proved, and would be a nice thing to make and sell.

Q.51. In other words, piston rings could break up, and you have to stand behind your guarantee. This was a thing that could not get away?

A. Yes.

Q.52. In other words, what you gathered from the situation at that time was that Mr. Allen was going to try to manufacture a tapered shim?

A. Yes.

MRS. DORA JAMES, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. Please state your name and whether you are of legal age, your residence and occupation.

A. My name is Mrs. A. M. James; now, since my husband's death, I am known as Mrs. Dora James. My age is 52. My residence: 1722 Rigsby, San Antonio; my occupation: seamstress.

Q.2. Do you recall your late husband purchasing a 1934 Oldsmobile, 2-door coach, engine No. F–384865, from T. J. Allen, Rt. 3, Box 112, San Antonio, Texas, on or about January 30, 1942?

A. Yes.

Q.3. Do you recall the sale of that car on or about May 7, 1942, about five months later?

A. Yes.

Q.4. Do you know whether any work was done on this car during the time that it was owned by your husband?

A. I know that there was no mechanical work done on the engine.

Q.5. How do you know that?

A. Just in my way; I know when my husband put the car in the shop because I would write a check for it.

Q.6. Could you testify to the fact that the car was sold to Rev. G. F. Giese?

A. Yes sir.

BY MR. LINDSEY: There will be no cross examination.

REV. G. F. GIESE, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. State your name, residence, age and business.

A. Rev. G. F. Giese, 406 Wilcox St., San Antonio, Texas, Pastor of the Pentecostal Church.

Q.2. State whether you purchased a 1934 Oldsmobile, and give us particulars.

A. Yes, I did. I purchased a 1934 Oldsmobile tudor coach, engine No. F384865, from Mr. A. M. James, at that time living at 1130 W. Lullwood, San Antonio. Since, he has passed away, about May 7, 1942. I retained this automobile until about June 21, 1943.

Q.3. Do you know to whom this car was sold?

A. Do you mean after that?

Q.4. Yes.

A. Well, I do not know to whom it was sold.

Q.5. Do you know Albert C. Romirez?

A. No, I do not know him.

Q.6. Have you ever seen him?

A. No, sir, I have not.

Q.7. Who sold your car for you?

A. The company across from the Lincoln Motor Co. I believe at that time it was the Milam Finance Company.

Q.8. You stated you owned the car until June 21, 1943, and that at that time you sold it, having purchased it from a Mr. James. During that time did you have motor trouble or have the motor overhauled?

A. No.

Q.9. Did you have the pan removed?

A. No.

Q.10. Did you have anything done to the engine?

A. Nothing.

Cross Examination

BY MR. LINDSEY:

XQ.1. When was it in 1942 that you purchased this car?

A. It was about May 7.

XQ.2. You have been reading from a memorandum, have you not?

A. I have notes from the Highway Department in Austin, Texas, that can be checked.

XQ.3. You remember these facts now because you checked up with the Highway Department?

A. That is why I know for sure.

XQ.4. How many miles had that car run at the time you purchased it?

A. I do not remember how many miles.

XQ.5. Was it a great many?

A. It had a great many number of miles. Mr. James had driven it a lot.

XQ.6. How far did you drive it?

A. I used it for insurance at that time. I drove it every day.

XQ.7. You possibly drove ten or twelve thousand miles?

A. That many at least.

XQ.8. When you got this car from Mr. James you paid money for it, did you not?

A. Yes.

XQ.9. How much?

A. Around four hundred dollars.

XQ.10. Did you operate the car before you purchased it?

A. I just took it out and drove it. It ran good and the motor was good.

XQ.11. How did you know that?

A. I took it out before I bought it.

XQ.12. You were satisfied that the motor was exceptionally good, and you had no bearing trouble, is that correct?

A. That is correct.

XQ.13. Did you know anything about the history of this car before you bought it?

A. No.

XQ.14. You did not know what could be in the bearings, for example?

A. No.

XQ.15. You were told about what was in the internal mechanism?

A. No.

XQ.16. You were satisfied you were buying a good operating car with a satisfactory engine, correct?

A. Yes.

XQ.17. Do you know Mr. Allen sitting here in the room?

A. Yes.

XQ.18. When did you first meet Mr. Allen?

A. Possibly a year ago.

XQ.19. At that time he asked you about this particular car?

A. Yes.

XQ.20. When you sold this car in 1943 you were paid money for it, were you not?

A. I traded it for a Chevrolet coupe.

XQ.21. How much credit were you given for this Oldsmobile?

A. About $350.00.

XQ.22. And the car was in good operating condition?

A. Yes.

XQ.23. You were paid for the car, isn't that correct?

A. Yes.

ALBERT A. RAMIREZ, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. Please state your name, age, residence and business.

A. My name is Albert A. Ramirez; I live at 106 Guerra St. My occupation is a Kelly Field worker.

Q.2. Do you recall purchasing a 1934 tudor Oldsmobile coach from Rev. G. F. Giese on June 21, 1943, and selling that car on July 19, 1944, to Mr. Gonzales?

A. I took it to a fellow on North Flores Street and he sold it for me.

Q.3. You did not know it was sold to Mr. Giese? You didn't sign any papers for selling it? You must have executed the papers.

A. Yes, sir. I did execute the papers.

Q.4. Do you recall executing this paper, giving the engine number as F-384865?

A. Yes, sir; that is right.

Q.5. This states you purchased a 1934 tudor coach Oldsmobile, engine No. F-354865, from G. F. Giese, 406 Wilcox Street, South San Antonio, Bexar County, on or about June 21, 1943, and you surrendered the automobile to W. S. Bonner, 446 Cooper Street, San Antonio, Bexar County, Texas, on consignment to sell. Now, prior to the time that car was sold, do you remember signing an affidavit of the facts I have just given you?

A. Yes, sir.

Q.6. While you owned that automobile, up till the time it was sold and you signed away title, did you have any work done on the engine of the car?

A. No, sir.

Q.7. You never had the oil pan removed or the bearings removed?

A. No, sir.

BY MR. LINDSEY:

XQ.1. This affidavit that Mr. Dowell handed you—was it executed in April of this year? It was signed by you in April, 1949?

A. Yes, sir; that is right.

XQ.2. How long was it you had this car?

A. It was about six months.

XQ.3. How much did you pay for this car?

A. At the time I bought it? I don't exactly remember. It was somewhere about $100.00—it was better than $100.00—I don't exactly know the amount. I bought it on terms.

XQ.4. Did you trade in a car for it?

A. I did not.

XQ.5. You paid something like $140.00. Was that a down payment?

A. I paid about $90.00 as a down payment.

XQ.6. How much did you sell it for?

A. $150.00.

XQ.7. And that was a cash deal?

A. That was right.

. . . .

XQ.8. How did the engine operate?

(Question not answered.)

XQ.9. Had you driven the car for some time?

A. I made about three trips to Corpus Christi and back and had no trouble.

XQ.10. How many miles did you drive the car?

A. I don't know exactly—about 10,000 miles.

XQ.11. How long was the car in the possession of Mr. Bonner?

A. It was quite a while.

XQ.12. Some months, wasn't it?

A. That is right.

XQ.13. Did you drive the car while it was in his possession?

A. Yes sir.

BY MR. DOWELL:

RDQ.1. Do you know whether he did any work on the car?

A. To my knowledge, he did not.

FRANK GONZALES, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. State your name, residence, age and business.

A. Frank Gonzales, age 42, address: Rt. 4, 83–D, San Antonio, Texas.

Q.2. Are you the owner of the 1934 tudor Oldsmobile?

A. Yes.

Q.3. When did you buy it?

A. 1943.

Q.4. The records show that one Frank Gonzales purchased this Oldsmobile, engine No. F384865, on July 19, 1944. Are you that Frank Gonzales?

A. Yes.

Q.5. Where is that automobile now?

A. On Broadway.

Q.6. You mean the General Oldsmobile Company?

A. Yes.

Q.7. Did you see the pan removed Saturday?

A. Yes, Saturday morning.

Q.8. During the time you have owned this automobile have you had anything done to the engine?

A. Nothing.

Q.9. Are you positive?

A. Yes.

Cross Examination

By Mr. Lindsey:

XQ.1. Who did you buy this car from?

A. From Mr. James.

XQ.2. How much did you pay for the car?

A. About $275.00, if I remember correctly.

XQ.3. How did the engine operate? Satisfactorily?

A. Perfectly.

FRED B. MORGAN, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. State your name, age, address, and business or occupation.

A. Fred B. Morgan, Service manager of the General Oldsmobile Company, age—forty-five, residence—155 Cromwell Drive, San Antonio, Texas.

Q.2. We are now here in the General Oldsmobile Company standing beside a car—I will ask that you state what model car this is.

A. It is a 1934 Oldsmobile.

Q.3. When was this car brought to this shop?

A. Last Saturday morning, August 13th.

Q.4. What did you do?

A. We pulled out the pan and by orders removed one bearing.

Q.5. Is this the cap?

A. Yes, we marked the bearing. Jess C. Fleming took it off.

Cross Examination

BY MR. LINDSEY:

XQ.1. Can you tell us how many layers of foil there is here?

A. No.

XQ.2. Mr. Fleming, can you tell how many layers there are?

A. I would say that there are two. There are two different pieces here it appears.

XQ.3. Then, it is hard to say there are more than one piece, correct?

> The Notary is requested to mark one insert removed Allen Exhibit #2b which will be in the custody of Mr. Lindsey until final hearing and Allen Exhibit #2 in the custody of Mr. Blaisdell. We request that Notary mark this foil Allen Exhibit #2c. Exhibits may be obtained until final hearing which are in custody of counsel, subject to inspection at reasonable hours. Each counsel will be furnished copies of the testimony.

JESSE C. FLEMING, a witness on behalf of Thomas J. Allen, first being duly sworn, testifies as follows:

Direct Examination

BY MR. DOWELL:

Q.1. State your name, age, address and business or occupation.

A. Jess C. Fleming, age forty-nine, residence 850 W. Harreman Place, San Antonio, Texas, occupation—automobile mechanic for General Oldsmobile Company under direction of Mr. Fred B. Morgan.

Q.2. Please state the kind of car we are standing beside here at the General Oldsmobile Company.

A. This is a 1934 Oldsmobile.

Q3. When was it brought in?

A. Last Friday.

Q.4. When was it torn down?

A. The same day.

Q.5. Was it Friday or Saturday morning?

> BY MR. LINDSEY: I will stipulate it was last Saturday morning.

Q.6. What did you do?

A. Pulled the pan off and that is all, besides removing a bearing.

Q.7. Was this bearing marked and could you recognize it?

A. Yes.

Q.8. Is this it I am holding in my hand?

A. Yes.

Q.9. Did you know when you took it off that it had aluminum shim in it?

A. Yes.

Q.10. Did you yourself know it was thicker in the center?

A. I started to pull it off, but they told me not to.

Q.11. Will you examine it and see if you can tell at this time.

A. There is only a single thickness.

Q.12. What is this portion in the middle part?

A. I didn't notice that before. There is another thickness— I never tore it off before.

BY MR. LINDSEY: For the record I wish to state this witness ruffled up the edge of the lower layer of tinfoil when examining same.

Q.13. Is this shim composed of more than one layer, thicker in the center?

A. Yes.

BY MR. DOWELL: The car is here and if you wish any other bearing caps and inserts removed, Mr. Lindsey, we would like to have you do so.

BY MR. LINDSEY: I would like to have two more bearing caps removed and a shim and bearing insert on one of the mail bearings. (Bearing #2 and #6 were taken out).

Cross Examination

BY MR. LINDSEY:

XQ.1. You have just taken out of this 1934 Oldsmobile the cap and insert of one of the main bearings, correct?

A. Yes.

XQ.2. And you have same in your hand right now, and we are all looking at it, correct?

A. Yes.

QX.3. There appears to be a shim which adheres to the cap, correct?

A. Yes.

XQ.4. That shim is relatively smooth and it extends from one edge of the cap almost to the other edge, being substantially the length of the outside diameter of the insert, correct?

A. Yes.

XQ.5. Will you please pull up one end of this shim? Now you have raised one end of the shim haven't you?

A. Yes.

XQ.6. That first piece looks like copper, doesn't it?

A. It is what we call regular shim stock—bronze.

XQ.7. Right under it appears to be a shim of the same width and length of tinfoil, correct?

A. It appears to be tinfoil.

XQ.8. Will you please lift one end of the piece that looks like an aluminum shim. It rather sticks to the cap and is hard to remove. How many layers of foil do you see?

A. You are asking me a question, I do not know.

93 Decision of Board of Interference Examiners, July 31, 1950.

The invention herein involved relates to shims for
placement under bearing inserts, characterized by be-
ing thicker in the middle and tapering to both ends.
In internal combustion engines bearings wear most in
the middle portion thereof and where inserts are part
of the original equipment, new inserts can be
94 installed to replace the worn bearings. With
the present invention it is sought to avoid in-
stalling new inserts by shimming up the old inserts in
a manner restoring the proper contour and compen-
sating for wear. The sole count is as follows:

> A bearing shim adapted to be placed under a shaft bearing and formed of shim stock, said shim being tapered from the center to both edges thereof.

Cocklin's main contention is not that Blaisdell and Allen did not establish early dates of reduction to practice but that assuming that they did, all of the parties are barred by public use of the invention due to the sales of the automobiles incorporating it more than a year prior to the earliest filing date. Cocklin recognizes that public use proceedings are independent of interference proceedings and that this Board in its discretion could only make a recommendation under Rule 259.

The burden of proof for establishing public use is a heavy one and in view thereof it is considered that such recommendation should not be made except in a clear case. We are not convinced after a study of the authorities cited by the parties that a case free from doubt exists herein. In this view we are largely persuaded by the case of Goodwin *et al.* v. Borg-Warner Corp., 157 F. (2d) 267, 70 USPQ 387, 71 USPQ 22 (C. C. A. 6th Cir., 1946), cited by counsel for Allen. In that case the Court considered the various authorities and stated:

> Nor is the patent invalidated by any public use on the part of Daukus prior to the two-year period before his application. This claim is asserted because of Daukus' testimony that the Cadillac car owned by a friend of his in which Daukus says he inserted his first clutch plate was later sold with the plate in it. The plate, so far as this record shows, was never used for a profit, nor was it within the terms of the statute "put on sale." 35 U. S. C., § 31. It was placed in the
> 108 Cadillac purely for experimental purposes,
> and this record does not show that it was sold with Daukus' knowledge or consent. This neither constitutes a public use nor sale within the statute. Elizabeth v. Pavement Co., 97 U. S. 126, 135. As stated therein, even if profit is derived from the sale of a device under similar circumstances and the profit is merely incidental to the experimental use, the character of the use is not changed. But here there was no profit, and the use was entirely for the purpose of testing. To the same effect are Smith & Griggs Mfg. Co. v. Sprague, 123 U. S. 249, 255; Jenner v. Bowen, 139 F. 556, 559, 560 (C.C.A. 6); Austin Machinery Co. v. Buckeye Traction Ditcher Co., 13 F. 2d 697 (C.C.A. 6); Reo Motor Car Co. v. Gear

Grinding Machine Co., 42 F. 2d 965, 968 [6 USPQ 9, 12] (C.C.A. 6).

Here Blaisdell, as did Daukus, made his installations without charge and at a loss to himself. The sales of the cars were without his specific knowledge or consent. In Allen's case there was no profit, the car being sold for practically junk value. Neither of the parties was interested in anything more than the performance of the shims and in each instance they were placed in the cars for experimental purposes only so far as the inventors were concerned.

Counsel for Cocklin urges that the shims might have been removed and new inserts put in to avoid implication of public use. However, this procedure, had it taken place, could well have given rise to inference of abandoned experiment since the shims were for the purpose of avoiding putting in new inserts.

It is also suggested that the junior parties might have filed sooner. It appears that Blaisdell tried this and found that he had wasted his money since he could not secure manufacture of the one piece shim. Allen had no money for such purpose since he 109 concentrated all his available energy and resources into making the machine. As his wife pointed out, by the time the machine started producing, they were reduced in health by the effort and in resources to a twenty-five dollar bond. The law provides no penalty for delaying to file for good reason after actual reduction to practice provided there is no concealment or abandonment, although an inventor may avoid much litigation by so doing.

Under the circumstances no recommendation under Rule 259 is made and since the proofs show Blaisdell was the first to conceive and reduce to practice the invention of the count he is entitled to the award of priority.

Cochran

SOLICITOR

APR 24 1957

U. S. PATENT OFFICE

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

THOMAS J. ALLEN,
Plaintiff
v.
ROBERT C. WATSON,
Commissioner of Patents,
Defendant

Civil Action No. 2236-55

STIPULATION

It is stipulated by and between the parties hereto that the attached photocopy is an accurate reproduction of the drawing as originally filed in the application of Abram E. Blaisdell, Serial No. 678,939, filed June 24, 1946.

April 24, 1957

A Yates Dowell Jr
A. Yates Dowell and
A. Yates Dowell, Jr.
1345 Pa. Ave., N. W.
Washington 4, D. C.
Attorneys for Thomas J. Allen

April 24, 1957

CWMoore
C. W. Moore
Solicitor, United States Patent Office
Washington 25, D. C.

Div. 45 678939

PRINT OF DRAWING AS
ORIG

#2

Fig. 1.

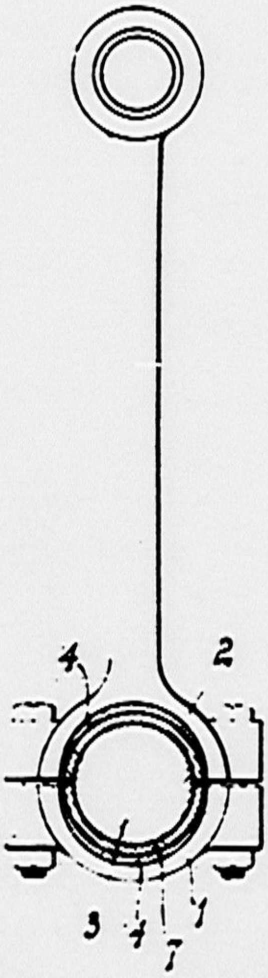


Fig. 4.

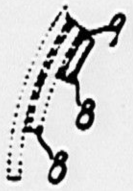


Fig. 3.

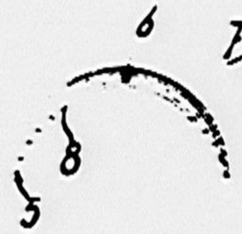


Fig. 2.

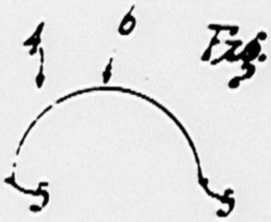
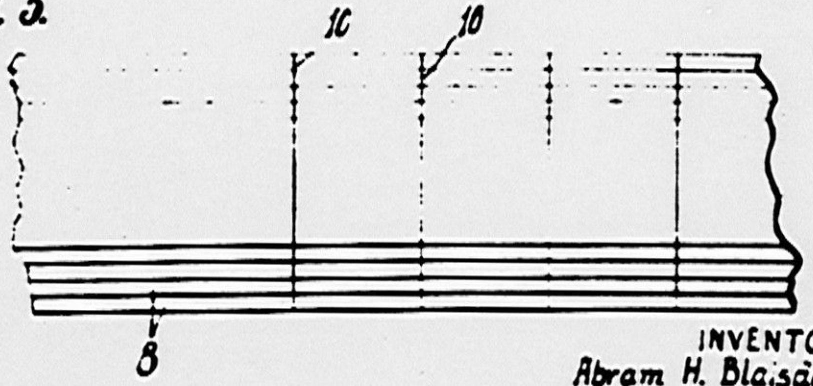


Fig. 5.



INVENTOR.
Abram H. Blaisdell.
BY
C. A. Neckman
ATTORNEY.

114a

F. J. FLINN.

SHIM.

APPLICATION FILED JAN. 29, 1920.

1,421,441. Patented July 4, 1922.

Fig. 1.

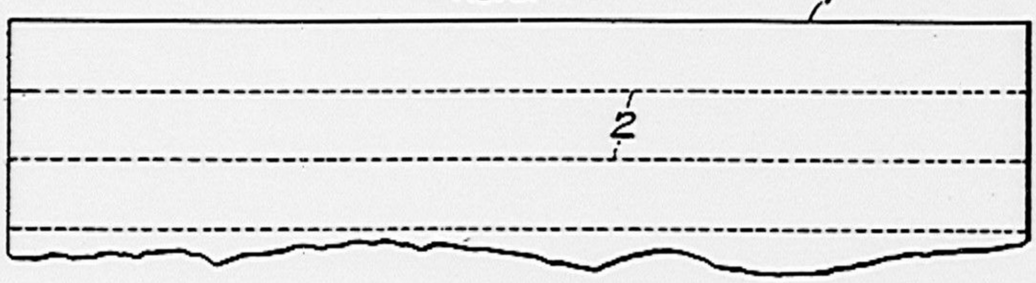


Fig. 2.

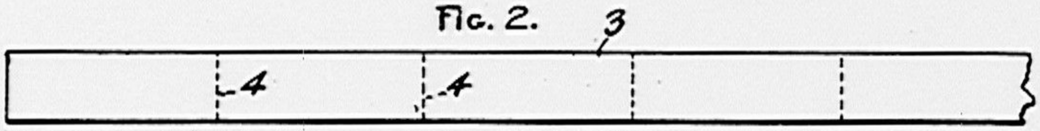


Fig. 3.

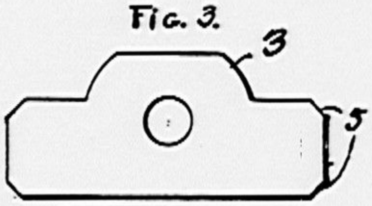


Fig. 4.

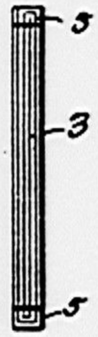


Fig. 5.

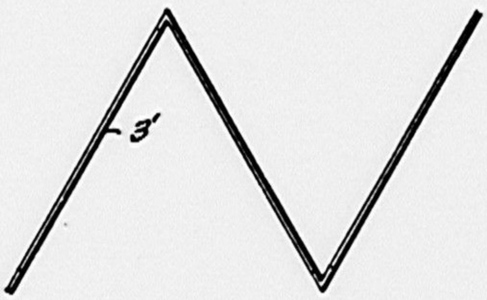
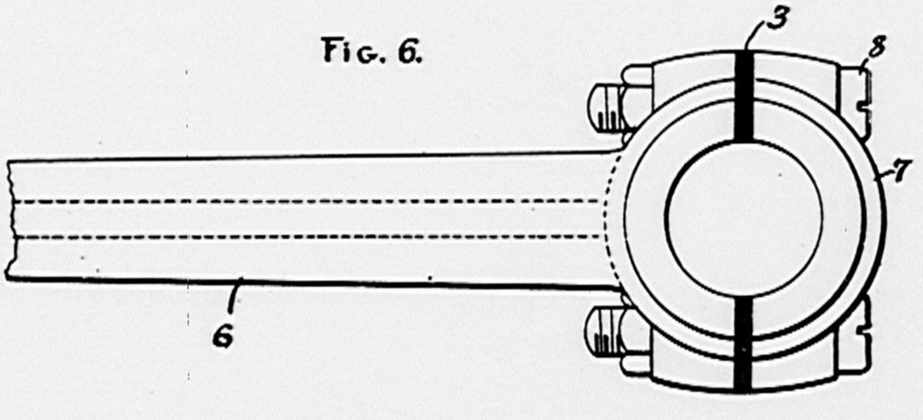


Fig. 6.



Inventor
F. J. Flinn

By W.N. Roach, J.

Attorney.

UNITED STATES PATENT OFFICE.

FRANCIS J. FLINN, OF BROOKLYN, NEW YORK.

SHIM.

1,421,441. Specification of Letters Patent. **Patented July 4, 1922.**

Application filed January 29, 1920. Serial No. 354,923.

To all whom it may concern:

Be it known that I, Francis J. Flinn, a citizen of the United States, residing at Brooklyn, in the county of Kings and State of New York, have invented certain new and useful Improvements in Shims, of which the following is a specification.

This invention relates to shims adapted to be interposed between the pillow-block and cap in machine bearings and analogous situations, or in the bearings of connecting rods of gas engines.

It is necessary, as the bearings become worn, to reduce the thickness of the shims so that the distance between the block and cap may be reduced and the bearing tightened. To accomplish this a very slight reduction in the thickness of the shims is necessary. This object is usually accomplished by introducing a thinner shim or by scraping the face of the shim to properly reduce its thickness.

The main object of the present invention is the provision of a shim the thickness of which may be readily and easily changed and which will at all times present a spacer of uniform thickness.

Another object of the invention is the provision of a shim consisting of a series of layers or plates so connected that one or more layers may be readily removed when desired.

The invention also contemplates the provision of strips from which shims of desired form may be readily cut or stamped.

It is also within the province of the invention to generally improve the construction and enhance the utility of shims.

With these and other objects in view, the invention resides in the novel arrangement and combination of parts and in the details of construction hereinafter described and claimed, it being understood that changes in the precise embodiment of the invention herein disclosed can be made within the scope of what is claimed without departing from the spirit of the invention.

A practical embodiment of the invention is illustrated in the accompanying drawing, wherein—

Figure 1 is a plan view of a fragment of a blank from which the shim may be cut;

Figure 2 is a similar view of another form of blank;

Figure 3 is a plan view of a shim;

Figure 4 is a side elevation of the same;

Figure 5 is a side elevation of a shim made from a strip folded in a different manner, the shim shown partly open;

Figure 6 is a fragmentary view in elevation of a connecting rod showing the shims in place.

Referring to the drawing by numerals of reference:—

In carrying out the invention a sheet 1 of thin sheet steel or other suitable material is provided which is folded upon itself, as indicated by the dotted lines 2, to a desired thickness. From this blank, so folded, shims of the desired size and form may then be cut or stamped. The plan view of such a shim would resemble that shown in Figure 3, but the strips or folds of the shim would be connected along the sides of the shim.

To form a shim from the strip 3, shown in Figure 2, the strip is folded upon itself substantially along the lines 4 to assume the form shown in Figure 4. To properly fold the strip in this manner, it is wound on a cylinder then removed and placed under pressure and flattened out. From the strip, so folded, the shim is stamped. When stamped out, the corners are angled off, as indicated at 5—5, Figure 3, to assure a straight tear at the fold when a leaf of the shim is to be removed.

In the modified form of shim, 3′, shown in Figure 5, the strip, similar to the strip 3, is folded upon itself, instead of being wound, and the shim is then stamped therefrom.

In Figure 6 a connecting rod 6 is shown with its end yoke held in place thereon by means of the bolts 8 and the shims 3 in place therein.

Having thus described my invention, what I claim as new and desire to secure by Letters Patent, is:—

1. A shim comprising a blank of metal folded upon itself to provide a plurality of leaves.

2. A shim comprising a blank of metal folded upon itself to provide a plurality of superimposed sheets separable by tearing along the fold between adjoining sheets.

3. A shim comprising a blank of metal folded upon itself to provide a plurality of superimposed sheets, each sheet connected to the adjoining sheet along one edge and having indentations at the ends of the connected edges.

In testimony whereof I hereunto affix my signature.

FRANCIS J. FLINN.

Paper No. 27

MAILED

Appeal No. 419-48 APR 29 1955 MSP

Hearing:
February 7, 1955

U. S. PATENT OFFICE
BOARD OF APPEALS

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Thomas J. Allen

- - -

Application for Patent filed April 19, 1946, Serial No. 663,494. Insert Bearing Structure and Shim Therefor.

A. Yates Dowell and A. Yates Dowell, Jr. for appellant.

This is an appeal from the final rejection of claims 16 to 20, inclusive, and 22 to 28, inclusive. Subsequent to the final rejection the Examiner entered additional claims 29 to 32, inclusive, for purposes of appeal. No claims have been allowed by the Examiner.

The following claims are representative of the appealed subject matter:

17. A shim designed for insertion between the insert and holder of a friction bearing for taking up wear on the bearing surface of the insert, said shim comprising a metallic sheet of foil-like thickness and of such flexibility as to be readily distortable about said insert, said shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest

wear of the insert.

18. A multiple shim stock sheet from which one or more shims can be detached for insertion between the insert and holder of a friction bearing for taking up wear, said sheet being of foil-like thickness and of such flexibility as to be readily distortable about said insert with each shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest wear of the insert.

20. In a bearing a bearing cap, a removable bearing insert carried by said cap, and a shim located between said cap and said insert, said shim comprising a metallic sheet of foil-like thickness and of such flexibility as to be readily distortable about said insert, said shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest wear of the insert.

26. A rolled multiple shim stock sheet from which one or more shims can be detached for insertion between the insert and the holder of a friction bearing for taking up wear, said sheet being a one piece flexible body of foil-like thickness such that when a shim is detached it may be readily distortable about an insert and having a thickened portion intermediate its ends.

29. A multiple shim stock sheet from which one or more shims can be detached for insertion between the insert and holder of a friction bearing for taking up wear, said sheet being of foil-like thickness and of such flexibility as to be readily distortable about said insert with each shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest wear of the insert, said sheet being composed of a single piece of homogeneous material of minimum density in said thickened portion and of progressively greater density extending therefrom.

The reference relied upon is:

Flinn, 1,421,441, July 4, 1922.

The appealed claims are directed to a shim for use in compensating for wear in bearings such as those at the crankshaft end of an automobile engine connecting rod. As indicated in Figs. 1 and 2 of appellant's drawings, such bearings may have relatively thin bearing inserts which surround the crankpin and are clamped in position by a bearing cap which is bolted against the end of the connecting rod. The wear on the inserts is greatest in a direction longitudinally of the connecting rod. Appellant proposes to insert shims which are thicker at the middle than at the ends between the bearing inserts and the connecting rod and cap with the thickest portions of the shims adjacent the areas of greatest wear of the inserts. The thickness of the shims at their mid-portions is so selected as to compensate for the wear on the inserts in order that when the bearing cap is bolted against the body of the connecting rod, the inserts will be deformed in such a manner as to bring the bearing surface back to circular configuration and in proper fit with the crankpin. The shim stock is formed as shown in Fig. 5 so as to enable shims of desired width to be cut from the stock as required. The shim stock sheet is formed by rolling a single piece of metal so that the thickest part at the mid-portion is about twice the thickness of the stock at the edges and since this cross-sectional shape is produced by a rolling process, the metal is denser at the edges where it is compressed to greater degree than at the center.

The rejection of the claims on appeal is based upon a holding that some of the claims are readable upon and others do not patentably distinguish from a structure that was in public use more than one year prior to the filing of the instant application, that is prior to April 19, 1945. In order to understand the basis for the rejection it is necessary to review the historical background of this application.

The instant application was involved in an interference No. 83,587, Blaisdell v. Allen v. Cocklin, on the following count:

> "A bearing shim adapted to be placed under a shaft bearing and formed of shim stock, said shim being tapered from the center to both edges thereof."

Allen and Blaisdell took testimony but Cocklin did not. Priority was awarded to Blaisdell by the Board of Interference Examiners and this decision was affirmed by the Court of Customs and Patent Appeals on appeal by Allen. During the interference, Cocklin urged the Board of Interference Examiners to direct the attention of the Commissioner, under Rule 259, to the fact that public use had been found on the basis of the testimony by Blaisdell and appellant. This, the Board declined to do. On appeal by appellant from the award of priority to Blaisdell, the Court stated that the question of public use was not before it.

When the Board of Interference Examiners refused to recommend that public use proceedings be instituted, Cocklin filed a petition to the Commissioner requesting that this be done. Action on the petition was held in abeyance pending termination of Allen's appeal to the Court. After the decision by the Court the Examiner was directed by the Commissioner to conduct public use proceedings. Neither Allen nor Blaisdell took any additional testimony but stood upon the testimony taken in the interference proceeding. Since the acts of either Blaisdell or appellant, if found to constitute public use in a legal sense, would bar certain of the claims involved in this appeal, it will be necessary to review briefly the acts of both parties pertinent to the question.

In October 1939, appellant, Allen, had an Oldsmobile car that was using excessive amounts of oil due to bearing wear and he made up some shims that were thicker at the center than at the edges and installed them behind the bearing inserts of the connecting rods in the manner already described. These shims, however, were not one-piece articles like those disclosed in the instant application but were made by ironing out pieces of metal foil and superimposing several layers of progressively decreasing width upon one another in pyramid fashion with paraffin wax between the layers and then causing the laminations to stick together by applying pressure with a hot iron. Shims of proper size were then cut from this stock material. The construction and manner of use of these laminated shims were not kept secret in any way but were disclosed to several people, one of whom was Mr. Lee White in whose shop the installation was made.

The shims were installed experimentally to see if they would effectively reduce the oil consumption in the Oldsmobile. (R 169, Q 22, 24).* After the shims were installed appellant drove the car for about two years at the rate of about 6,000 to 7,000 miles per year or about 12,000 to 14,000 miles in all. (R 175, Q 38). From the standpoint of reducing the consumption of oil appellant was satisfied that the performance of the shims was a success since the consumption of oil was reduced from about one quart every 250 miles to one quart per 1,000 miles. (R 176, Q 42, 43; R 199, XQ 72 to 77, inclusive). Although the shims placed in the Oldsmobile were considered by appellant to be satisfactory from a functional standpoint, he thought that the steps at the ends of the laminations might not form a good seat for the bearing insert and so he lost interest in the laminated shim and turned his thoughts to the production of a continuously tapered unitary shim. (R 176, Q 47). Appellant sold the Oldsmobile to Mr. A. M. James about January 1942 for $75 without telling him about the shims that had been installed in the bearings. (R 175, Q 35; R 200, XQ 78, 79 and 83). He made no attempt to follow up the performance of the shims in the car until the instant application became involved in interference more than six years later. (R 201, XQ 93, 94). During that time the car had passed through the hands of several owners who did not know of the presence of appellant's shims therein.

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*Reference to page numbers in the record are to the the printed transcript of record filed in the United States Court of Customs and Patent Appeals in Patent Appeal No. 5838, Allen v. Blaisdell and Cocklin.

Appellant spent several years developing a machine for rolling unitary shims and finally produced his first rolled shim for sale in July 1946. (R 165, Q 11). The instant application for patent was filed on April 19, 1946. Of the sixteen claims involved in this appeal claims 16 to 20, inclusive, and 28 are broad enough to read on the laminated shims installed in appellant's Oldsmobile in October 1939.

Blaisdell started out by making experimental installations of one-piece tapered shims in several cars. The shims were made by hand-grinding solid pieces of shim material to obtain the necessary taper from the center toward the side edges. The testimony in the interference shows that a man by the name of George A. Mitchell operated a used car business and employed Blaisdell to do mechanical reconditioning work on cars that were to be sold. One of these cars was a Plymouth which was sent to Blaisdell's shop because of worn bearings. Blaisdell installed hand-made tapered unitary shims in this Plymouth without charge to Mitchell on an experimental basis about November 1934. (R 74, Q 22). This car was sold by Mitchell with a mechanical guarantee. Blaisdell kept track of the Plymouth for about four months after installation of the shims and was satisfied that they were effective for their intended purpose. (R 74, Q 25; R 86, XQ 39; R 87, XQ 53-56). When the car was sold, the purchaser was not told of the presence of the shims. (R 143, XQ 101).

Blaisdell also installed his tapered shim in 1936 in an Oldsmobile owned by Mitchell which had loose bearings. (R 87, XQ 61). He kept track of this car also for about four months and was satisfied that the shims were functionally effective. (R 88, XQ 73-75).

There was another used car dealer by the name of C. S. Prowell who sent cars to Blaisdell for mechanical work. In 1935 Blaisdell installed unitary tapered shims on an experimental basis and free of charge in a De Soto car owned by Prowell that had loose bearings. Prowell drove the car for several months and then sold it with the shims still in place. He stated that the shims operated satisfactorily in eliminating the loose bearings and reducing oil consumption. (R 136, Q 6-10).

Blaisdell made no attempt to preserve the construction and manner of use of his shims in secrecy but freely explained them to various people including Mitchell and Prowell.

Blaisdell filed an application for patent on his unitary tapered shim on March 24, 1936, Serial No. 70,637, which was prosecuted to allowance on November 23, 1937 and was forfeited and abandoned for failure to pay the final fee. He testified that he was well satisfied with his tapered shim before he filed his first application. (R 96, XQ 178, 179). However, he tried unsuccessfully to get someone to manufacture his unitary tapered shim for him and it was because of that fact and the fact that he could not make the shim himself at a price the public would pay and because he was short of money that he abandoned the application. (R 81, Q 86-88).

Blaisdell ceased his attempts to manufacture a unitary shim and turned his attention to the production of a laminated shim for the reason that it would enable a mechanic to remove as many layers as necessary to bring the shim to the desired thickness. (R 100, Q 228). He made his first laminated shim in July of 1945 (R 96, XQ 184) and put it on the market in September 1945. (R 81, Q 84, 85).

Claims 16 and 17 of this appeal are drawn to a tapered shim and claims 19 and 20 are drawn to the tapered shim in combination with a bearing insert and bearing cap. All of these claims are broad enough to read on either a unitary or a laminated shim and they stand rejected on the ground of public use or sale more than one year prior to the date of filing of the instant application, which was April 19, 1946. The rejection is founded on the Examiner's holding in the public use proceedings previously referred to that the satisfactory operation of appellant's Oldsmobile for about two years after the Fall of 1939 and the sale of the car in 1942 with the shims in place and without any strings attached and the use of the car by others thereafter and prior to the critical date constitutes a statutory bar to the allowance of these claims.

Appellant's position is that although at the time he sold his car he was satisfied with the performance of his laminated shims, in so far as their mechanical function in correcting loose bearings and reducing oil consumption was concerned, he was not satisfied that the laminated shim was a good commercial article and for that reason he continued his experiments to try to develop a machine that could produce a rolled unitary shim. He points out that it is well established that even though a device is used by the public it is not a public use in the legal sense which would constitute a statutory bar if the use is experimental in character and he contends that the period of experimentation with regard to his shim extends all the way from the time when the laminated shims were installed in the Oldsmobile car in 1939 up to the time when he finally put a unitary rolled shim on the market in July 1946, which date was after the date when the instant application was filed.

Among the authorities cited by appellant in support of his position reference is made to the famous case of Elizabeth v. Pavement Company, 97 U.S. 126, as stating the principle that an incidental use by the public for the purpose of experimentation does not constitute a public use bar under the statute. The case of Reo Motor Car Company v. Gear Grinding Company, 42 F. (2d) 965; 6 USPQ 9, is also cited by appellant for the proposition that,

> "* * * so long as the use by the inventor, or even sales to the public, can fairly be considered experimental and collateral to the development of the invention in its complete form, the bar does not begin to run."

He relies heavily on the case of Goodwin et al v. Borg-Warner Corp., 157 F. (2d) 267; 70 USPQ 387, which he regards as directly in point here. In that case a man named Da~~n~~mkus invented a clutch and installed it in a Cadillac car owned by #2; a friend as an experiment. The friend later sold the car with the Da~~n~~mkus clutch in it without Da~~n~~mkus' knowledge or consent. The Court held there was no public use under the circumstances.

After careful consideration of the arguments and the authorities cited in appellant's brief, as well as those presented at the hearing, we find ourselves in agreement with the Examiner's position. It must be conceded that the shims were originally placed in the Oldsmobile on an experimental basis and that some portion of the twelve or fourteen thousand miles that appellant drove the car can be said to have been experimental use to ascertain whether the shims would be satisfactory.

The citations from the Allen record in the interference to which we have referred above clearly show, however, that during the time appellant drove the Oldsmobile with the shims installed he became satisfied that in so far as the operation of the laminated shim was concerned it was a success and no further experimentation with that form of shim was necessary. He lost interest in the laminated shim when he sold the car to James and all of his further experimentation was with respect to the development of a machine to roll a unitary shim. It is doubtless true that from the original installation of the laminated shim in 1939 all the way through to 1946 when he put the unitary shim on the market appellant was seeking to develop what he thought was a commercially acceptable product. Unfortunately for him, however, he turned the laminated shim loose to the public when he sold the car to James without any strings attached and did not follow it any further. We think this act clearly constituted an abandonment of any control of the laminated shims for experimentation and marked the end of the period of experimentation and the beginning of public use. There was use of the car with the shims therein for many thousands of miles by four successive owners, each of whom sold it to the next one for a valuable consideration. The use by the subsequent owners was obviously not any part of appellant's experimentation on either the laminated or the unitary shim.

As to the sale of the car to A. M. James, we think it is immaterial that appellant received only the low price of $75. James bought the car as an operating automobile and since the presence of the shims contributed to the good mechanical condition of the car, they must have had some influence on the price even though it was a low one. This is not a case where the sale was incidental to further testing of the shim. The car was sold merely because appellant had acquired another car and the Oldsmobile was sitting idle and deteriorating and appellant needed the money. (R 200, XQ 85). Appellant apparently was no longer interested in testing the laminated form of shim installed in that car.

While the Elizabeth v. Pavement Company case relied upon by appellant is an often cited authority for the proposition that an invention may be used by the public and yet not form a basis for the statutory bar of public use provided the use is experimental, it is apparent from a study of that case that the inventor visited the pavement installation almost daily, walking over it and examining its condition, and the Court held that it was apparent from these acts and the fact that he had filed a caveat in the Patent Office that he had never let the invention get beyond his control and consequently there was no public use bar.

The Court said, however, in discussing the matter of experimentation:

> "But if the inventor allows his machine to be used by other persons generally, either with or without compensation, or if it is

> with his consent, put on sale for such use, then it will be in public use and on public sale, within the meaning of the law."

We think that appellant's unqualified sale of his Oldsmobile car to James and the unrestricted use and sales of it by several others constituted a public use and sale under this principle. The fact that the purchasers were not aware of the presence of the shims in the car is immaterial. Hall v. Macneale, 107 U. S. 90.

As to the quoted excerpt from the Reo Motor Car Company v. Gear Grinding Company case, supra, we believe it to be in accordance with the weight of authority on the subject of experimentation. However, we do not think that the uncontrolled use of appellant's laminated shims by others after he had turned his attention to development of a unitary shim can properly be said to be experimentation with respect to either the laminated or unitary shim.

The facts of the instant case are distinguishable from the facts of the Goodwin et al v. Borg-Warner case, supra, in that appellant Allen knowingly disposed of his car without preserving to himself any right to inspect or otherwise follow up the performance of the laminated shim. This was a deliberate abandonment of control over the shim which is quite different from the involuntary loss of control over his clutch by Da~~n~~ukus. There was no positive evidence in the Da~~n~~ukus case as there is in the instant case that the inventor had lost interest in his invention and had terminated his experiments with it.

For the reasons stated the rejection of claims 16, 17, 19 and 20 on the ground of public use of appellant's laminated shim more than one year prior to the date of filing of the instant application is sustained.

Claim 18 is also broad enough to read on either a laminated or a unitary tapered shim and it adds the idea of making the shim stock in sheet form of sufficient size to enable the mechanic to cut off a shim of suitable size for the job at hand. This claim stands rejected as unpatentable over the Allen public use in view of the patent to Flinn. In the Flinn patent a sheet of shim material 1 is folded repeatedly upon itself along the lines 2 and from the thus folded stock shims of desired size may be cut. The Examiner holds that in view of this teaching it would not amount to invention to form the laminated shim stock of appellant's public use of sufficient size that individual shims of desired size can be cut from the sheet.

Appellant points to Fig. 4 of the Flinn patent and argues that the cutting of an individual shim such as shown in Fig. 3 from the folded article shown in Fig. 4 which is only large enough for one shim is not the same concept as appellant's. The Examiner, however, referred to the embodiment shown in Fig. 1 of Flinn's patent. As described in lines 65-74 on page 1 of the patent specification the sheet 1 is folded on the lines 2 to form an elongated piece of shim stock and then a number of shims of desired size and form may be cut from the thus laminated stock. We agree with the Examiner that claim 18 does not patentably distinguish from the public use which we have held to have occurred more than a year before appellant filed his application. The rejection of claim 18 is sustained.

Claims 22 and 23 recite that the shim stock is rolled and claim 24 states that the metal is "transposed". The Examiner has rejected these claims on appellant's public use on the theory that the references to the shim stock as "rolled" or that the metal is "transposed" are statements of how the article is made and are immaterial insofar as patentability of the article per se is concerned.

Appellant contends that these expressions are structural limitations which serve to distinguish from the article which the Examiner holds was put into public use by appellant.

We note that claim 22 does not recite that the shim is of one-piece construction so the claim must rely upon the word "rolled" to distinguish from appellant's laminated shim which went into public use. There is nothing in this claim that implies that the rolling operation had anything to do with the tapered configuration. Insofar as recited the rolling could have been to compact the laminations as appellant did by pressure with a heated iron. (R. 171, 172, Q 30). In this broad sense we see nothing patentable in applying pressure by rolling rather than by pressing with an iron. The rejection of claim 22 as unpatentable over appellant's public use is sustained.

Claims 23 and 24 in addition to stating that the shim is rolled or that the metal is transposed recite that it is of one-piece construction. The Examiner makes no comment on this point. Since the shim which appellant put into public use prior to the critical date was of laminated construction, we do not think that claims 23 and 24 calling for a one-piece construction can properly be rejected on the public use of appellant's laminated shim and the rejection of these claims on that basis is not sustained.

Claims 25 and 26 were rejected on the same ground as claim 18. As in the case of claim 22, claim 25 is broad enough to read on a laminated shim and there is nothing in this claim that requires that the tapered shape is the result of the rolling operation. For the reasons we stated in our discussion of claim 22, we sustain the rejection of claim 25.

Claim 26, however, requires the shim stock sheet to be of one-piece construction. For the reasons stated in our discussion of claims 23 and 24, we do not sustain the rejection of claim 26.

Claims 27 and 28 purport to be method claims and recite a simple step of "rolling" metal to form tapered shims. These claims do not specify any details of the rolling procedure. The Examiner has rejected these claims on the ground that they are drawn to a necessary or obvious method of producing the article.

Appellant in his brief argues that the fact that it took appellant six years to invent a machine to roll the shim and he was told by others that it could not be done controverts the Examiner's statement that the method is obvious.

The Examiner points out that rolling is, generally speaking, a common process of metal working. It seems to us that if those skilled in the art thought that the shim could not be produced by known rolling machines and procedures and it took appellant about six years to produce a machine that could roll the tapered shim, it is obvious that appellant's success is attributable either to a novel machine, novel rolling procedures, or both. Claims 27 and 28 which recite the one broad step of "rolling" the shim to tapered configuration merely state the problem which confronted appellant when he first conceived the desirability of producing a unitary shim by rolling and in no way suggest appellant's solution of the problem. No light is thrown on the subject by appellant's specification since neither the details of the rolling procedure nor the machine by which it is accomplished are disclosed. We agree with the Examiner that it is obvious that the only method by which a rolled shim can be produced is by "rolling." Since none of the details of the rolling procedure by which the rolling is made possible are recited in the claims, it is apparent that they define nothing unobvious. The rejection of claims 27 and 28 accordingly is sustained.

Claim 29 is drawn to a shim stock sheet and stands rejected on the same ground as claim 18. Claims 30, 31 and 32 drawn to an individual shim stand rejected on the same ground as claim 22. All of these claims recite that the density of the metal in the shim increases from the center toward the edges. The Examiner's position is that this variation in density is a direct result of the method by which the shim is formed and it is not apparent that an article having these characteristics is any different from a patentability standpoint than an article produced by other methods.

We do not sustain this rejection. The basic reference on which the rejection is based is the public use of appellant's laminated shim. In our opinion the shim of varying density recited in these claims is so different from appellant's laminated shim of uniform density that the public use of the laminated shim cannot constitute a statutory bar against the allowance of these claims. Likewise we do not think claims 29 to 32, inclusive, are barred by the use of Blaisdell's unitary shim which was ground to tapered form and consequently was homogeneous in density. The rejection of claims 29 to 32, inclusive, is not sustained.

We have outlined above Blaisdell's acts with respect to his unitary shim. In our opinion Blaisdell's period of experimentation ended when he became fully satisfied that his unitary shim was functionally effective and turned his attention to development of the laminated shim. It is our opinion that when he let the three cars in which it was installed go into general use without retaining any control over them for inspection or further experiment he abandoned control of the unitary shim and further use of the cars by the public was a public use such as constitutes a statutory bar to the allowance of claims 16, 17, 19, 20 which read directly on Blaisdell's unitary shim. There is no distinction between public use by another and by the inventor himself. A. Schrader's Sons, Inc., v. Wein Sales Corporation, 9 F. (2d) 306, 308. These claims accordingly are rejected by us on the public use of Blaisdell's shim.

Claims 22 and 23 which call for a rolled shim and claim 24 which says that the metal is "transposed" to produce the tapered shape are rejected by us as unpatentable over the public use of Blaisdell's one-piece shim. These limitations relate to the method by which the shim is made and cannot serve to distinguish patentably from Blaisdell's unitary shim which was tapered by grinding. It is immaterial insofar as the performance of the shim is concerned whether it is rolled or ground.

Claims 18, 25 and 26 which call for a multiple shim stock sheet are rejected by us as unpatentable over the public use of Blaisdell's shim in view of Flinn. We see nothing patentable in making Blaisdell's unitary shim in the form of a sheet of such length that individual shims of any desired length can be cut off as taught in lines 69-71 on page 1 of the Flinn specification.

The rejection of claims 16 to 20 inclusive and 22 to 26 inclusive based on the public use of Blaisdell's unitary shim is made under the provisions of Rule 196 (b).

The decision of the Examiner is affirmed as to claims 16, 17, 18, 19, 20, 22, 25, 27 and 28 but is reversed as to claims 23, 24, 26, 29, 30, 31 and 32.

A new rejection of claims 16, 17, 18, 19, 20, 22, 23, 24, 25 and 26 is made under the provisions of Rule 196 (b).

Mark Taylor
Examiner-in-Chief)
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)
B H Carpenter) BOARD
Examiner-in-Chief) OF
) APPEALS
)
M. H. Friedman)
Examiner-in-Chief)

April 29, 1955

Mr. A. Yates Dowell and
Mr. A. Yates Dowell, Jr.,
1158 Munsey Building,
Washington 4, D.C.

Paper No. 29

MAILED

JUN 24 1955

Appeal No. 419-48 MSP

U. S. PATENT OFFICE
BOARD OF APPEALS

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Thomas J. Allen

- - -

Application for Patent filed April 19, 1946, Serial No. 663,494. Insert Bearing Structure and Shim Therefor.

A. Yates Dowell and A. Yates Dowell, Jr. for appellant.

ON PETITION FOR RECONSIDERATION

Appellant requests reconsideration and reversal of our decision of April 29, 1955 in so far as it affirmed the Examiner's rejection on the ground of public use by Allen and with respect to our rejection of certain claims under Rule 196(b) on the ground of public use by Blaisdell. Appellant alleges error by the Board of Appeals in the following respects:

I. The Board lacked jurisdiction to make the rejection under Rule 196(b).

II. The rejection under Rule 196(b) is unwarranted, even if the Board had jurisdiction.

III. The distinguishing of the Goodwin et al. v. Borg-Warner case from the case at bar is not supported by the record.

As to the first point, appellant contends that the Commissioner's holding that a prima facie case of public use was made out by Blaisdell's acts did not go beyond the count of Interference No. 83,587, and that there was no intimation that Blaisdell's acts constituted a prima facie case of public use against appellant, Allen, as to other claims. He states that the jurisdiction of the Board is limited to a determination of the question of public use set forth in the prima facie case.

With this contention we cannot agree. The excerpts from pages 3 and 4 of the Commissioner's communication of October 12, 1950, quoted on page 2 of appellant's petition, when read in context, merely indicate that Blaisdell installed shims according to the count of Interference No. 83,587 under such conditions as to indicate a prima facie case of public use. In lines 20 to 26, page 4 of the same paper, the Commissioner said:

> "While I believe that a prima facie case of public use has been made by the records of both Allen and Blaisdell, public use proceedings will not be instituted at this time because the party Allen has filed an appeal in Interference 83,587, the outcome of which may have some bearing on the alleged reduction to practice of Blaisdell and Allen and the public use following thereafter." (Underscoring added).

After the appeal referred to in the paragraph quoted above had terminated, the Commissioner ordered the Primary Examiner to conduct public use proceedings and the following paragraph appears in the order which was dated June 11, 1952:

> "The matter of whether Blaisdell is

> barred under Section 4886 R. S. (35 U.S.C. 31) from receiving a patent containing the count of Interference No. 83,587, and of whether Allen is barred from receiving a patent containing the counts of Interference No. 83,588, are referred to the primary examiner of Division 45 for his determination. Since public use and sale were not issues in the priority proceedings decided by the Board of Interference Examiners and by the Court, the examiner should give Allen and Blaisdell opportunities to take additional testimony upon these questions. If no additional testimony is taken, the evidence presented on priority will be considered by the examiner in determining the questions of public use and sale."

It seems to us that the Commissioner in referring to the counts of the two interferences with respect to the parties in whose applications they were then present was merely indicating the character of the subject matter with respect to which the Examiner was to conduct proceedings to determine whether the claims in each application were barred by public use generally. We find nothing in the language of the quoted excerpt from the Commissioner's Order of June 11, 1952 that restricts the investigation of public use as a possible statutory bar against Allen's claims to Allen's own acts or, on the other hand, that restricts the consideration of the question with respect to Blaisdell's claims to Blaisdell's own acts. As we see it, the Commissioner's Order directed the Examiner to investigate the general question of whether there had been acts performed by either Blaisdell or Allen under circumstances which would constitute public use. Since there is no distinction between public use by another and by the inventor himself, the acts of either Blaisdell or Allen, if found to constitute public use, would bar any claims of either party readable upon or not patentably distinct from the article publicly used by either party.

In our opinion, the Commissioner's Order of October 12, 1950 found that a prima facie case of public use was made out by the records of both Blaisdell and Allen. It is further our opinion that the language of the Commissioner's Order of June 11, 1952 does not restrict the consideration of public use against Allen to his own acts. The Examiner's letter of June 25, 1952 invited Allen to take further testimony in pursuance of the terms of the Commissioner's Order of June 11, 1952 if he so desired. Appellant elected not to do so. We do not agree with appellant that any injustice has been done him.

As to the second point in appellant's petition, we cannot agree that the limitation in claim 16 that the center of the shim is at least twice as thick as the ends distinguishes from Blaisdell's public use. (See R.91, XQ.101 and R.117, Q.15). Also, we do not consider that the limitation to the shim being of "foil-like thickness," which appears in many of the claims, is a patentable distinction, if it is any distinction at all, over the Blaisdell unitary shim which was made of shim stock of only a few thousandths of an inch thickness at the center and which was so flexible as to be bendable around the bearing insert. Webster's Collegiate Dictionary, 5th Edition, defines "foil" as "A leaf or very thin sheet of metal." We think shim stock can be said to answer this description. We cannot engage in speculation as to why the Examiner did not suggest claims 16 and 20 to Blaisdell or why Blaisdell did not move to adopt them in his application. We think the rejection of claims 16 to 20, inclusive, and 22 to 26, inclusive, on the public use of Blaisdell's unitary shim was warranted.

Coming now to appellant's third point that our distinction of the instant case from the Goodwin et al. v. Borg-Warner case is not supported by the record, we must presume that the Court had full knowledge of the record testimony by Daukus, referred to in appellant's brief, and nevertheless the Court stated that "this record does not show that it was sold with Daukus' knowledge or consent." We are not disposed to go contrary to the holding of the Court in this regard.

In reviewing our decision we note typographical errors on pages 9 and 12 in the spelling of the name Daukus. These errors have been corrected in the original copy.

The petition is granted to the extent that we have reconsidered our decision in the light of the contentions advanced but it is denied as to making any change in the decision.

Mark Taylor.
Examiner-in-Chief)
)
)
B H Carpenter) BOARD
Examiner-in-Chief) OF
) APPEALS
M. H. Friedman)
June 24, 1955 Examiner-in-Chief)

A. Yates Dowell and
A. Yates Dowell, Jr.,
1158 Munsey Building,
Washington 4, D. C.

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116 Filed May 6, 1957. Harry M. Hull, Clerk.

May 3, 1957.

A. Yates Dowell, Esq.,
A. Yates Dowell, Jr., Esq.,
1158 Munsey Building,
Washington 4, D. C.
(Attention: Mr. Cochran.)

E. L. Reynolds, Esq.,
Solicitor, United States Patent Office,
Washington 25, D. C.

In re C. A. 3236–55—*Allen* v. *Watson.*

Gentlemen: Upon consideration of the pleadings, the record before the Patent Office, testimony here taken, and argument thereon by respective counsel, I find there was no public use which would bar applicant's claims. See *Goodwin* v. *Borg-Warner Corporation,* 157 F. 2d 267, which is not distinguishable. Claims 16 through 26 will therefore be granted.

I further find that Claims 27 and 28 are not patentable for failure to disclose adequately method claims. Claims 27 and 28 will therefore be denied.

Counsel for plaintiff will please prepare and submit promptly appropriate findings of fact, conclusions of law, and order.

Sincerely yours,

/s/ Richmond B. Keech.

AVAILABLE
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In the United States District Court for the District of Columbia

Civil Action No. 3236–55

THOMAS J. ALLEN, PLAINTIFF,

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS,
DEFENDANT

Filed May 9, 1957. Harry M. Hull, Clerk.

Findings of Fact

1. Thomas J. Allen, applicant for patent, brought this action under 35 U. S. C. 145 to authorize the Commissioner of Patents to issue letters patent to him containing claims 16 to 20 inclusive and 22 to 28 inclusive, the Patent Office already having allowed claims 29 to 32 inclusive, for an application for patent entitled, INSERT BEARING STRUCTURE AND SHIM THEREFOR, SERIAL No. 663,494, filed April 19, 1946.

2. The application in suit relates to a shim for use in compensating for wear in bearings such as those at the crankshaft end of an automobile engine connecting rod. Such bearings may have relatively thin bearing inserts which surround the crank pin or other shaft and are clamped in position by a bearing cap. The wear on the inserts is greatest in a direction longitudinally of the connecting rod and decreases from the central portion of the bearing outwardly. In

order to compensate for such wear, Allen produced a shim thickest in the middle portion for underlying the insert in the region of greatest wear, and tapering outward the sides in order that the insert would support the shaft evenly around its circumference. The thickness of the shims at their mid portions is so selected as to compensate for the wear on the inserts in order that when the bearing cap is bolted against the body of the connecting rod or other shaft, the inserts will be deformed in such a manner as to bring the bearing surface back to circular configuration and in proper fit with the crank pin or other shaft. The shim stock is formed as shown in Figure 5 so as to enable shims of desired width to be cut from the stock as required. The shim stock sheet is formed by rolling a single piece of metal so that the thickest part at the midportion is about twice the thickness of the stock at the edges and since this cross-section or shape is produced by a rolling process, the metal is denser at the edges where it is compressed to greater degree than at the center.

3. The instant application was involved in an interference No. 83,587, *Blaisdell* v. *Allen* v. *Cocklin,* on the following count:

> A bearing shim adapted to be placed under a shaft bearing and formed of shim stock, said shim being tapered from the center to both edges thereof.

Allen and Blaisdell took testimony but Cocklin did not. Priority was awarded to Blaisdell by the Board of Interference Examiners and this decision was affirmed by the Court of Customs and Patent Appeals on appeal by Allen. During the interference, Cocklin urged the Board of Interference Examiners to direct the attention of the Commissioner, under Rule 259, to the fact that public use had been found on the basis of the testimony by Blaisdell and plaintiff. This, the Board declined to do. On appeal by appellant from the award of priority to Blaisdell, the Court stated that the question of public use was not before it.

4. When the Board of Interference Examiners refused to recommend that public use proceedings be instituted, Cocklin filed a petition to the Commissioner requesting that this be done. Action on the petition was held in abeyance pending termination of Allen's appeal to the Court. After the decision by the Court the Examiner was directed by the Commissioner to conduct public use proceedings. Neither Allen nor Blaisdell took any additional testimony but stood upon the testimony taken in the interference proceeding.

5. At the time of his invention, Allen was a skilled automotive mechanic and had been for many years. During October 1939 in San Antonio, Texas, Allen owned a 1934 Oldsmobile which consumed oil excessively. To remedy this he decided that he "was going to try an experiment". He produced a laminated, tapered shim from pieces of tinfoil and installed it in his Oldsmobile. He testified in detail how he

made the shim by ironing out pieces of tinfoil with his wife's iron and pressing the pieces together to form the shim. The Patent Office Board of Appeals conceded that the shims were installed experimentally to see if they would effectively reduce the oil consumption in the Oldsmobile.

Before installation of the shim, the car had low oil pressure and was smoking at the exhaust pipe, but after the installation, the oil pressure was back up to normal. Furthermore, the car had been using about one quart of oil to every 250 miles, but after the installation it used about one quart every 1000 miles. In December 1940, after driving the car 12,000–14,000 miles with the shims in place, Allen bounght a new Ford and put up the Oldsmobile at the trailer park, and it was not driven except for a few months in 1941, until January 1942 when it was sold to A. M. James for $75.

6. Although Allen was satisfied with the performance of the laminated tinfoil shim in his car, he was not satisfied with the product even though he found that it did the job at the time; he thought that the lamination steps would not form a perfect seat and therefore decided to attempt to produce a one-piece shim. He talked about it to Lee A. White, in whose shop the installation was made, and told him that he was looking for something to sell that would stay sold without a come-back. There was considerable testimony about Allen's long hours in attempting to design a machine to produce a one-piece shim.

7. During the years from 1937 until November 1948, Allen sold piston expanders to raise funds to

support himself and his wife, and had a full-time job with the Government at Kelly Field from 1942 to 1945. He continued, however, to study, make sketches and plans for making tapered one-piece shims throughout the years 1939 to 1946.

8. On or about January 1942, Allen sold the 1934 Oldsmobile to A. M. James. Allen did not tell Mr. James that the shims were in the car, nor even that the car was in pretty good condition. He sold the car so cheaply ($75) because he needed the money; he had no use for the car and it was just sitting unused and deteriorating. After he sold the car, Allen did not keep track of it, until these Interferences were declared. The widow of Mr. James, and all subsequent purchasers of the car including its present owner, were produced and testified that they had never had overhaul work done on the motor. The motor was taken down during the Interference Proceedings, in the presence of counsel for Allen, Blaisdell and Cocklin, examined and found to contain the tinfoil shims originally placed there by Allen.

In 1946, Allen succeeded in completing a machine for producing the one-piece tapered shim and placing on the market shims of this character.

9. The instant application was involved in another Interference No. 83,588, *Allen* v. *Cocklin* on the following counts, which are Allen's claims 16 and 20, as follows:

> 16. A shim for disposition between a shaft engaging bearing insert and its holder for compensating for a greater degree of wear over an intermediate portion of said insert than at the

ends thereof, said shim comprising a metal sheet of foil-like thickness and of such thickness and flexibility as to be readily distortable about said insert, the intermediate portion of said shim which is designed to be disposed adjacent the portion of the insert having the greater degree of wear being at least substantially twice the thickness of one of the portions of the shim to be disposed adjacent the ends of the insert.

20. In a bearing a bearing cap, a removable bearing insert carried by said cap, and a shim located between said cap and said insert, said shim comprising a metallic sheet of foil-like thickness and of such flexibility as to be readily distortable about said insert, said shim having a thickened portion intermediate the ends thereof adapted to be disposed adjacent the portion of the greatest wear of the insert.

10. Although the two Interferences No. 83,587 and 83,588 were declared by the same Division of the Patent Office on the same date the narrower claims of Interference 83,588 were not suggested to Blaisdell nor did Blaisdell make any attempt to copy them in order to become a party to the Interference with Allen and Cocklin.

11. Blaisdell started out by making experimental installations of one-piece tapered shims in several cars. The shims were made by hand-grinding solid pieces of shim material to obtain the necessary taper from the center toward the side edges. The estimony in the interference shows that a man by the name of George A. Mitchell operated a used car business and employed Blaisdell to do mechanical recon-

ditioning work on cars that were to be sold. One of these cars was a Plymouth which was sent to Blaisdell's shop because of worn bearings. Blaisdell installed hand-made tapered unitary shims in this Plymouth without charge to Mitchell on an experimental basis about November 1934. This car was sold by Mitchell with a mechanical guarantee. Blaisdell kept track of the Plymouth for about four months after installation of the shims and was satisfied that they were effective for their intended purpose. When the car was sold, the purchaser was not told of the presence of the shims.

Blaisdell also installed his tapered shim in 1936 in an Oldsmobile owned by Mitchell which had loose bearings. He kept track of this car also for about four months and was satisfied that the shims were functionally effective.

There was another used car dealer by the name of C. S. Prowell who sent cars to Blaisdell for mechanical work. In 1935 Blaisdell installed unitary tapered shims on an experimental basis and free of charge in a DeSoto car owned by Prowell that had loose bearings. Prowell drove the car for several months and then sold it with the shims still in place. He stated that the shims operated satisfactorily in eliminating the loose bearings and reducing oil consumption.

Blaisdell explained the construction and manner of use of his shims to various people including Mitchell and Prowell.

12. Blaisdell filed an application for patent on his unitary tapered shim on March 24, 1936, Serial No. 70,637, which was prosecuted to allowance on Novem-

ber 23, 1937, and was forfeited and abandoned for failure to pay the final fee. He testified that he was satisfied with his tapered shim before he filed his first application. However, he tried unsuccessfully to get someone to manufacture his unitary tapered shim for him and it was because of that fact and the fact that he could not make the shim himself at a price the public would pay and because he was short of money that he abandoned the application.

Blaisdell ceased his attempts to manufacture a unitary shim and turned his attention to the production of a laminated shim for the reason that it would enable a mechanic to remove as many layers as necessary to bring the shim to the desired thickness. He made his first laminated shim in July of 1945, and put it on the market in September 1945.

13. The Examiner, in his decision on the Public Use Proceedings, held claims 16 to 20 inclusive and 22 to 26 inclusive unpatentable because of Allen's public use, either alone, or in view of the patent to Flinn, No. 1,421,441. Allen appealed to the Board of Appeals which affirmed the Examiner's decision as to claims 16–20, 22 and 25, but disagreed with the Examiner with respect to claims 23, 24, and 26, holding that the subject matter of these claims was not in public use by Allen; the Board of Appeals rejected all of claims 16–20 and 22–26 on a ground not previously used, namely that they were barred by the public use of Blaisdell, or by Blaisdell's public use in view of the patent to Flinn.

14. Claims 27 and 28, directed to the method of producing a tapered shim, were rejected by the Exam-

iner and the Board of Appeals on the basis that they did not define the details of the rolling procedure by which the rolling is made possible.

15. Allen's witness, Augustus P. Sasscer, the Vice President and Fleet Manager of Jacobs Transfer Company, Washington, D. C., testifying from personal experience with automotive and truck maintenance problems during the past 30 years, testified that a mechanic could not manufacture a tapered shim of the type under consideration by hand honing shim material of foil-like thickness, because of the difficulty of holding the same and the fact that the inherent weakness of metal this thin would result in its tearing during the attempted honing process.

16. Allen installed shims in his automobile to determine whether they would perform the intended function so that this use of his invention was experimental and did not constitute public use regardless of whether he removed them or not. Further, his continued effort to make shims which would be an improvement over those he had installed likewise was experimental and this experimental period extended to a date less than one year prior to the filing of his application.

17. Blaisdell's shims, as in Allen's case, were installed for experimental purposes. Blaisdell, however, sought to produce an improved laminated shim in order that a mechanic could remove as many layers as necessary to bring the shim to the desired thickness. His efforts resulted in his placing such a shim on the market in September 1945 which was less than one year prior to the filing date of Allen's application.

Blaisdell's activities prior to one year before the filing of Allen's application were therefore experimental and not public use.

18. Even if Blaisdell's early activities should be regarded as public use under the statute, the evidence lacks the certainty required by law, of identity between the early shims made by Blaisdell and the subject matter of Allen's claims 16 to 20 and 22 to 26. Accordingly, Allen's claims are not barred because of Blaisdell's early activities, even if these should be regarded as public use by Blaisdell.

Conclusions of Law

1. Allen made no public use of his invention more than one year prior to the filing of his application.

2. Blaisdell made no public use of Allen's invention more than one year prior to the filing of the Allen application.

3. In accordance with the holding in *Goodwin* v. *Borg-Warner Corporation,* 157 F. 2nd 267, which is not distinguishable, there was no public use of the invention defined by claims 16 to 20 and 22 to 26 of the Allen application Serial No. 663,494, filed April 19, 1946.

4. Claims 27 and 28 are not patentable because they fail to disclose adequately the details of the rolling procedure.

5. Plaintiff is entitled to a patent containing claims 16 to 20 inclusive and 22 to 26 inclusive of his application Serial No. 663,494, filed April 19, 1946. Plaintiff

is not entitled to a patent containing either of claims 27 or 28 of that application.

R. B. KEECH, *Judge.*

5/9/57.

In the United States District Court for the
District of Columbia

Civil Action No. 3236–55

THOMAS J. ALLEN, PLAINTIFF
v.
ROBERT C. WATSON, COMMISSIONER OF PATENTS,
DEFENDANT

Filed May 9, 1957. Harry M. Hull, Clerk.

Judgment

This action came on to be heard at this term, and thereupon upon consideration thereof, it is this 9th day of May, 1957,

Adjudged that plaintiff is entitled to receive a patent for his invention as specified in claims 16 to 20 and 22 to 26 inclusive of his application at bar and this adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. The complaint is dismissed as to claims 27 and 28 of plaintiff's application.

R. B. KEECH, *Judge.*

Approved as to Form:

C. W. Moore,
C. W. MOORE,
Solicitor, U. S. Patent Office,
Attorney for Defendant.

In the United States District Court for the District of Columbia

Civil Action No. 3236–55

THOMAS J. ALLEN, PLAINTIFF

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS, DEFENDANT

Filed July 2, 1957. Harry M. Hull, Clerk.

Notice of Appeal

Notice is hereby given this 3rd day of July, 1957, that defendant Robert C. Watson, Commissioner of Patents, appeals to the United States Court of Appeals for the District of Columbia Circuit from the Order of this Court entered on May 9, 1957, in favor of the plaintiff, Thomas J. Allen, against said defendant, Commissioner of Patents, said Order authorizing the defendant to issue letters patent of the United States based upon the patent application of said Thomas J. Allen, Serial No. 663,494, filed April 19, 1946, and containing claims 16 to 20 and 22 to 26 thereof.

Respectfully submitted.

C. W. MOORE,
Solicitor, U. S. Patent Office,
Attorney for Defendant.

JULY 3, 1957.

S. W. COCHRAN,
Of Counsel.

U. S. GOVERNMENT PRINTING OFFICE: 1957

BRIEF FOR APPELLANT

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 14,066

ROBERT C. WATSON,
COMMISSIONER OF PATENTS, APPELLANT

v.

THOMAS J. ALLEN, APPELLEE

Appeal from the Judgment of the United States
District Court for the District of Columbia

CLARENCE W. MOORE,
Solicitor, United States Patent Office,
Attorney for Appellant.

S. WM. COCHRAN,
Of Counsel.

United States Court of Appeals
For the
District of Columbia Circuit

FILED SEP 9 - 1957

Joseph W. Stewart
CLERK

INDEX

Page

Statement of Questions Presented III

Jurisdictional Statement 1

Statement of the Case 3

Subject Matter of the Claims Involved in the Appeal 3

Prosecution History of Appellee's Application 3

Summary of Evidence Relating to Public Use 5

The Flinn Patent 9

Statutes Involved 9

Statement of Points 10

Summary of Argument 11

Argument 13

Public Use of Shims Made by Blaisdell bars Allowance of Claims 16 to 20 and 22 to 26 14

Claims 16 to 20 and 22 to 26 Describe the Blaisdell Shims 20

Public Use of Shims Made by Appellee Should Bar Allowance of Claims 16 to 20, 22 and 25 24

Claims 18, 25 and 26 Present No Separate Issue 28

Conclusion 29

AUTHORITIES CITED

Cases:

Allen v. Blaisdell et al., 39 C.C.P.A. 951, 196 F.2d 527 14

American Ballast Co. v. Davy Burnt Clay Ballast Co., 220 Fed. 887 19

Blaisdell, In re, 44 C.C.P.A. , 242 F.2d 779, 113 USPQ 289 .... 11, 14

Bradley v. Eccles, 138 Fed. 911 16

Cline Mfg. Co. v. Kohler, 27 F.2d 638 18

Eastman v. Mayor, 134 Fed. 844 .... 18, 19

Egbert v. Lippmann, 104 U. S. 333 17

Appeal No. 14,066

STATEMENT OF QUESTIONS PRESENTED

The questions presented are:

(1) Whether the District Court properly held that the use or sale of automobiles in which Abram H. Blaisdell installed tapered shims prior to April 19, 1945 did not constitute public use or sale which would bar the grant of a patent containing claims 16 to 20 and 22 to 26 of appellee's application in accordance with 35 U.S.C. Section 102(b);

(2) Whether the District Court properly held that the evidence does not establish that tapered shims answering to the limitations of claims 16 to 20 and 22 to 26 were installed in one or more automobiles by Abram H. Blaisdell prior to April 19, 1945; and

(3) Whether the District Court properly held that the appellee's use and sale of an automobile in which he had installed tapered bearing shims in 1939, or the use of the automobile by the public after the sale, did not constitute public use which would bar the grant of a patent on the tapered shims in accordance with 35 U.S.C. Section 102(b).

United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 14,066

ROBERT C. WATSON,
COMMISSIONER OF PATENTS, APPELLANT

v.

THOMAS J. ALLEN, APPELLEE

Appeal from the Judgment of the United States District Court for the District of Columbia

BRIEF FOR THE COMMISSIONER OF PATENTS

JURISDICTIONAL STATEMENT

This is an appeal from the order of the District Court for the District of Columbia (App. 150)* in which the defendant (appellant) was authorized to issue to plaintiff (appellee) letters patent of the United States based upon a patent application of the appellee, Thomas J. Allen, Serial No. 663,494, filed in the Patent Office on April 19, 1946, entitled "Insert Bearing Structure and Shim Therefor." Claims 16 to 20 and 22 to 26 were held patentable by the District Court.

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* References to the joint appendix are designated "App. ."

The action was instituted by a complaint (App. 1) filed by the appellee in the District Court for the District of Columbia pursuant to the provisions of Title 35 of the United States Code, Section 145. The complaint describes the various stages of prosecution of the appellee's application in the Patent Office culminating in the refusal by the Board of Appeals, in decisions rendered April 29, 1955 and June 24, 1955, to allow claims 16 to 20 and 22 to 28 in the application. The complaint asserts that such refusal was erroneous and contrary to law and prays for judgment that the defendant be authorized to issue to plaintiff letters patent including the rejected claims.

Aside from pointing out an error in the complaint of no consequence in this proceeding, the answer (App. 8) of the defendant admits the allegations of the complaint. It denies that the plaintiff is entitled to a patent containing the rejected claims for the reasons given, and in view of the prior patent cited in the Examiner's Answer and the decision of the Board of Appeals (App. 116).

In its final judgment (App. 150) the District Court (1) authorized the defendant to issue a patent to appellee containing claims 16 to 20 and 22 to 26 of appellee's application and (2) dismissed the complaint as to claims 27 and 28 of the application. This appeal is from that part of the District Court's order authorizing the issuance of a patent containing claims 16 to 20 and 22 to 26. Jurisdiction of the appeal arises from Title 28, United States Code, Section 1291.

SATEMENT OF THE CASE

Subject Matter of the Claims Involved in the Appeal

Claims 16, 17, and 22 to 25 are directed to a shim adapted to be disposed between a bearing insert and its holder. As claimed, the shim is of "foil-like" thickness and is substantially twice as thick at the center as at the ends. In repairing a bearing, the thickened portion is placed behind that part of the insert which has received the greatest wear to permit adjustment thereof to properly fit a shaft.

Claims 18, 25 and 26 are directed to a stock sheet from which individual shims may be detached. Claims 19 and 20 call for the shim in combination with the bearing holder and insert.

Prosecution History of Appellee's Application

As indicated by the Board of Appeals in its decision of April 29, 1955 (App. 118), review of the historical background of the application is necessary to an understanding of the rejection of the claims on appeal. A portion of the Board's description of that background was adopted by the District Court as Findings of Fact 3 and 4 App. 141) which read as follows:

> "3. The instant application was involved in an interference No. 83,587, Blaisdell v. Allen v. Cocklin, on the following count:
>
> > 'A bearing shim adapted to be placed under a shaft bearing and formed of shim stock, said shim being tapered from the center to both edges thereof.'
>
> Allen and Blaisdell took testimony but Cocklin

> did not. Priority was awarded to Blaisdell by the Board of Interferences Examiners and this decision was affirmed by the Court of Customs and Patent Appeals on appeal by Allen. During the interference, Cocklin urged the Board of Interference Examiners to direct the attention of the Commissioner, under Rule 259, to the fact that public use had been found on the basis of the testimony by Blaisdell and plaintiff. This, the Board declined to do. On appeal by appellant from the award of priority to Blaisdell, the Court stated that the question of public use was not before it.
>
> "4. When the Board of Interference Examiners refused to recommend that public use proceedings be instituted, Cocklin filed a petition to the Commissioner requesting that this be done. Action on the petition was held in abeyance pending termination of Allen's appeal to the Court. After the decision by the Court the Examiner was directed by the Commissioner to conduct public use proceedings. Neither Allen nor Blaisdell took any additional testimony but stood upon the testimony taken in the interference proceeding."

On the basis of this evidence, the examiner found, in the Public Use Proceeding, that tapered shims had been put into public use by both the appellee and Abram H. Blaisdell prior to one year before appellee's application was filed. The examiner finally rejected claims 16, 17, 19, 20, 22, 23, and 24 as reading directly on the device put into public use by Allen or as reciting nothing patentable thereover. Claims 18, 25 and 26 were rejected as presenting nothing patentable over Allen's device in public use in view of the patent to Flinn No. 1,421,441 (App. 114). Claims 27 and 28 were rejected as improper method claims. Claims 29 to 32, filed after the final rejection, were indicated not to be allowable in the Examiner's Answer.

In its decisions (App. 116, 134), the Board of Appeals affirmed the examiner in his rejection of claims 16 to 20, 22, 25, 27 and 28 but reversed the examiner as to claims 23, 24, 26 and 29 to 32. The Board, however, made a new rejection of claims 16 to 20 and 22 to 26,* on the ground that those claims were barred by Blaisdell's public use of a tapered shim or Blaisdell's public use in view of the patent to Flinn.

Summary of Evidence Relating To Public Use

Evidence bearing on public use of the shims made by the appellee is accurately summarized in Findings of Fact No. 5 and 6 (App. 142), as follows:

> "5. At the time of his invention, Allen was a skilled automotive mechanic and had been for many years. During October 1939 in San Antonio, Texas, Allen owned a 1934 Oldsmobile which consumed oil excessively. To remedy this he decided that he 'was going to try an experi-

---

* Authority for new rejections of previously rejected claims is expressly provided for in paragraph (b) of Rule 196 of the Rules of Practice of the United States Patent Office in Patent Cases, 37 CFR, Part 1, Section 1.196(b), USCA Appendix I. See also *Watson* v. *Bruns,* 99 U. S. App. D. C. 327, 239 F.2d 948, 111 USPQ 325.

ment. He produced a laminated, tapered shim from pieces of tinfoil and installed it in his Oldsmobile. He testified in detail how he made the shim by ironing out pieces of tinfoil with his wife's iron and pressing the pieces together to form the shim. The Patent Office Board of Appeals conceded that the shims were installed experimentally to see if they would effectively reduce the oil consumption in the Oldsmobile.

"Before installation of the shim, the car had low oil pressure and was smoking at the exhaust pipe, but after the installation, the oil pressure was back up to normal. Furthermore, the car had been using about one quart of oil to every 250 miles, but after the installation it used about one quart every 1000 miles. In December 1940, after driving the car 12,000-14,000 miles with the shims in place, allen bought a new Ford and put up the Oldsmobile at the trailer park, and it was not driven except for a few months in 1941, until January 1942 when it was sold to A. M. James for $75.

"6. Although Allen was satisfied with the performance of the laminated tinfoil shim in his car, he was not satisfied with the product even though he found that it did the job at the time; he thought that the lamination steps would not form a perfect seat and therefore decided to attempt to produce a one-piece shim. He talked about it to Lee A. White, in whose shop the installation was made, and told him that he was looking for something to sell that would stay sold without a come-back. There was considerable testimony about Allen's long hours in attempting to design a machine to produce a one-piece shim."

The record shows (App. 91, X.Q. 79) that the Oldsmobile was sold to Mr. James without his being told of the shims that had been installed in the bearings. Appellee made no attempt to follow up the performance of the shims in the car until his application became involved in interference six years later (App. 92, X.Q. 93). During that time the car had passed through the hands of several owners all of whom were unaware of the presence of the shims (App. 101, 103, 105).

An accurate summary by the Board of Appeals of evidence bearing on public use of tapered shims made by Abram H. Blaisdell was adopted by the District Court as the following portion of Finding of Fact No. 11:

> "11. Blaisdell started out by making experimental installations of one-piece tapered shims in several cars. The shims were made by hand-grinding solid pieces of shim material to obtain the necessary taper from the center toward the side edges. The testimony in the inteference shows that a man by the name of George A. Mitchell operated a used car business and employed Blaisdell to do mechanical reconditioning work on cars that were to be sold. One of these cars was a Plymouth which was sent to Blaisdell's shop because of worn bearings. Blaisdell installed hand-made tapered unitary shims in this Plymouth without charge to Mitchell on an experimental basis about November 1934. This car was sold by Mitchell with a mechanical guarantee. Blaisdell kept track of the Plymouth for about four months after installation of the shims and was satisfied that they were effective

> for their intended purpose. When the car was sold, the purchaser was not told of the presence of the shims."

The Board of Appeals added to its summary, with apparent accuracy (App. 122):

> "Blaisdell made no attempt to preserve the construction and manner of use of his shims in secrecy but freely explained them to various people including Mitchell and Prowell."

The remainder of the Board's description of Blaisdell's activities was adopted by the District Court as Finding of Fact No. 12:

> "12. Blaisdell filed an application for patent on his unitary tapered shim on March 24, 1936, Serial No. 70,637, which was prosecuted to allowance on November 23, 1937 and was forfeited and abandoned for failure to pay the final fee. He testified that he was satisfied with his tapered shim before he filed his first application. However, he tried unsuccessfully to get someone to manufacture his unitary tapered shim for him and it was because of that fact and the fact that he could not make the shim himself at a price the public would pay and because he was short of money that he abandoned the application.
>
> "Blaisdell ceased his attempts to manufacture a unitary shim and turned his attention to the production of a laminated shim for the reason that it would enable a mechanic to remove as many layers as necessary to bring the shim to the desired thickness. He made his first laminated shim in July of 1945, and put it on the market in September 1945."

The Flinn Patent

The Flinn patent No. 1,421,441 (App. 114) discloses a method of making shims from thin sheet metal which involves folding a sheet 1 (Figure 1) on fold lines 2 to form a blank, shown in Figure 2. As stated in lines 69 to 71 of page 1 of the patent specification (App. 115) "From this blank, so folded, shims of the desired size and form may then be cut or stamped."

STATUTES INVOLVED

The following are the pertinent sections of Title 35 of the United States Code:

> "35 U. S. C. 101. *Inventions patentable.* Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."
>
> "35 U. S. C. 102. *Conditions for patentability; novelty and loss of right to patent.* A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, * * * "

> "35 U. S. C. 103. *Conditions for patentability; non-obvious subject matter.* A patent may be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF POINTS

The points upon which appellant relies in this appeal are:

(1) The District Court erred in holding that use by the public of tapered shims installed by appellee was experimental because the shims were originally installed for an experimental purpose (Finding of Fact No. 16, App. 148).

(2) The District Court erred in holding that appellee's "continued effort to make shims which would be an improvement over those he had installed likewise was experimental and this experimental period extended to a date less than one year prior to the filing of his application" (Finding of Fact No. 16, App. 148), since such finding is not dispositive of the issue as to whether the appellee's shims were being used experimentally.

(3) The District Court erred in holding that "Blaisdell's activities prior to one year before the filing of Allen's application were, therefore, experi-

mental and not public use" (Finding of Fact No. 17, App. 148), since such finding is not dispositive of the issue as to whether Blaisdell's shims were being used experimentally.

(4) The District Court erred in holding that the evidence lacks the certainty required by law, of identity between the shims put into use by Blaisdell and the subject matter of the claims on appeal (Finding of Fact No. 18, App. 149).

(5) The District Court erred in concluding that Allen made no public use of tapered shims more than one year prior to the filing of his application (Conclusion of Law No. 1, App. 149).

(6) The District Court erred in concluding that Blaisdell made no public use of tapered shims more than one year prior to the filing of appellee's application (Conclusion of Law No. 2, App. 149).

(7) The District Court erred in concluding that there was no public use of the invention defined by claims 16 to 20 and 22 to 26 of appellee's application Serial No. 663,494, filed April 19, 1946, and in authorizing the issuance of a patent containing those claims (Conclusion of Law No. 3, App. 149).

(8) The District Court erred in not dismissing the complaint.

SUMMARY OF ARGUMENT

The holding by the District Court that Blaisdell's shims were not in public use is in direct conflict with the decision of the Court of Customs and Patent Appeals in *In re Blaisdell*, 44 C.C.P.A. , 242

F. 2d 779, 113 USPQ 289, which was released for publication after the District Court's decision. In the cited case, the Court concluded, on the basis of the same record as is presented here, that the Blaisdell shims were in public use, and claims were refused to Blaisdell by reason of the provisions of 35 U. S. C. 102(b).

The decision in *In re Blaisdell, supra,* is in accord with the accepted authorities and the principles underlying the public use bar. The public should not be suffered to use an invention, supposing it to be free to the public, and then be subjected to suits for infringement. Absence of profit does not affect the character of the use. Specific knowledge of the invention by the user is not essential to a public use.

The burden was on appellee to prove by clear, unequivocal and convincing evidence that the use of Blaisdell's shims was experimental. Such use was not, in fact, experimental since the shim had been proven successful and its invention was complete. Experiments to produce an improvement on those shims related to another invention and did not make continued use of the original shims experimental.

If Blaisdell's shims can be said to have been "foil-like," they answer to the limitations of the appealed claims. Shim stock, of which Blaisdell's shims were made, comes within the accepted definition of "foil" as a "very thin sheet of metal." Blaisdell's uncontroverted testimony is that his shims were six thousandths of an inch thick. Appellee's witness testified that a sheet of that thickness could be considered "foil-like." The evidence, hence, seems to establish beyond question that Blaisdell's shims were "foil-like" and their public use would bar allowance of the appealed claims.

Claims 16 to 20, 22 and 25 are broad enough to read on a laminated shim and would be barred by public use of Allen's original shim, if such use be established. The use of Allen's shims was similar, in essential respects, to the use of Blaisdell's in that the shims were originally installed as an experiment, were proved acceptable, and were voluntarily released to public use. The experimental period, in accordance with the authorities, lasted only until the shims were proved functionally acceptable. Experimentation on another invention, a machine for making a one-piece shim, did not make use of the shims by the public experimental. Use of appellee's shims was, therefore, a public use within the meaning of 35 U.S.C. 102(b).

Since the evidence shows that it is common in the art to supply shims in the form of a stock sheet from which individual shims are cut, claims 18, 25 and 26 present no issue of patentability separate from the other rejected claims.

ARGUMENT

This appeal requires consideration of three separate issues as indicated in the Statement of Questions Presented. Each of those issues calls for consideration of different evidence and needs separate discussion.

As to one of those issues, the District Court's decision is in direct conflict, on the same facts, with the recent decision of the Court of Customs and Patent Appeals in *In re Blaisdell*, 44 C.C.P.A. , 242 F.2d 779, 113 USPQ 289. That issue will, therefore, be discussed first.

Public Use Of Shims Made By Blaisdell Bars Allowance of Claims 16 to 20 and 22 to 26

In interference proceeding No. 83,587, Abram H. Blaisdell was awarded priority of invention over appellee and a third party, Cocklin, on the following count:

> "A bearing shim adapted to be placed under a shaft bearing and formed of shim stock, said shim being tapered from the center to both edges thereof."

This ruling was affirmed by the Court of Customs and Patent Appeals, *Allen* v. *Blaisdell et al.*, 39 C.C.P.A. 351, 196 F.2d 527. As the result of a Public Use Proceeding in the Patent Office following that decision, allowance of Blaisdell's claims was held to be barred by public use. Blaisdell appealed that decision to the Court of Customs and Patent Appeals. At the time of the trial in the District Court in the instant case, the Blaisdell appeal had been argued but a decision therein had not been published. The Judge in the District Court rendered his decision in the instant proceeding on May 3, 1957 (App. 139). The decision in *In re Blaisdell, supra,* was released for publication on May 6, 1957.

In that decision, the Court of Customs and Patent Appeals, on the basis of essentially the same record as is before the Court here, held that Blaisdell's right to a patent was barred by public use of tapered shims which he had made and installed in several automobiles. In view of that finding, the Court held that it was not "necessary to review or consider the facts relating to the alleged public use of the Allen shim."

Insofar as it deals with public use of the Blaisdell shims, the decision of the District Court in this case (Finding of Fact No. 17, App. 148; Conclusion of Law No. 2, App. 149) is in direct conflict with the cited decision of the Court of Customs and Patent Appeals.

The reasoning adopted in the latter decision would seem to meet the substance of every point and argument advanced at the trial by the instant appellee concerning the use of Blaisdell's shims. Blaisdell, like Allen below, contended that the public use bar should not apply to the shims made by him because (1) those shims were installed as an experiment, (2) as the result of continued experiments the shim finally adopted for commercial use was different from those used by the public, (3) Blaisdell received no profit from the installation of the shims and (4) it would be unreasonable to require that Blaisdell disassemble the several automobile engines to remove the shims.

In meeting these contentions, the Court of Customs and Patent Appeals referred to the leading authorities on public use as establishing (1) that "use of an invention * * * by way of experiment, and in order to bring the invention to perfection, has never been regarded as a public use." *Elizabeth* v. *Pavement Company*, 97 U. S. 126; (2) to qualify under that exception, the experiments must be directed toward perfecting the invention claimed and not something else, *Star Mfg. Co.* v. *Crescent Forge & Shovel Co.*, 179 Fed. 856; and (3) that an article need not be used or sold for a profit to constitute a public use, *Elizabeth* v. *Pavement Company, supra.* The Court also pointed out that Blaisdell could have obviated all difficulties involved in removing the shims merely by taking the necessary steps, within the statutory period of one year, to secure a patent thereon. The Court agreed with Blaisdell that the factual background of the case *Goodwin* v. *Borg-Warner Corp.* 6 Cir., 1946, 157 F.2d 267, as described in the decision therein, made that case "squarely in point in this case." The Sixth circuit Court of Appeals seemed to base its conclusion, it is pointed out in *In re Blaisdell*, on the facts that the device in the *Goodwin* case was not sold for profit (or the profit was incident to experimentation) and it was sold without the knowledge or consent of the patentee. Since none of these circumstances constitute an exception to the public use bar (*Elizabeth* v. *Pavement Company, supra*, and *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5), the Court of Customs and Patent Appeals concluded that the decision in the *Goodwin* case was unsound and could not be followed.

The conclusion thus reached by the Court of Customs and Patent Appeals is believed to be well founded both in logic and precedent. The public use bar does not arise solely from the need to curtail the period of commercial exploitation of the invention. Even more fundamental is the thought expressed in *Bradley* v. *Eccles*, 138 Fed. 911:

> "The public should not be permitted by the inventor to use a machine or a device, supposing it to be free to the public, and then subjected to suits for infringements. This will be the result unless the rules as to prior use, as distinguished from experimental use, are defined and maintained."

As indicated by the Court in *In re Blaisdell, supra*, neither profit nor use by a large number of persons is required to constitute a bar. In *Egbert* v. *Lippmann*, 104 U. S. 333, the inventive article was a corset stay given by the inventor to a lady-friend for use in her corsets, the use, thus, being without profit and confined to a single person.

Actual knowledge by the user, likewise, would not seem essential to a public use. It is not clear from the record whether the users of the automobiles had actual knowledge of the presence of Blaisdell's shims therein. It would seen apparent, however, that this is immaterial. The presence or absence of such knowledge could in no way affect the character of the use. The deciding circumstance is the *availability* of the shims to anyone who happened to disassemble the engine of one of the automobiles, and it matters not if this actually took place. As stated in *Egbert* v. *Lippmann, supra:*

> "An invention may consist of a lever or a spring, hidden in the running gear of a watch, or of a rachet, shaft, or cog-wheel covered from view in the recesses of a machine for spinning or weaving. Nevertheless, if an inventor sells a machine of which his invention forms a part, and

> allows it to be used without restriction of any kind, the use is a public one."

To avoid the public use bar appellee must, therefore, establish that the use of Blaisdell's shim comes within the "experimental" exception to the general rule.

The burden which the appellee must assume in this respect has been clearly defined. Where a patentee alleges that use by the public of an invention was experimental, "the proof on the part of the patentee, the period covered by the use having been clearly established, should be full, unequivocal and convincing," *Smith and Griggs Mfg. Co.* v. *Sprague*, 123 U. S. 249, 264. See also *Guy et al.* v. *Stein*, 239 Fed. 729, *Eastman* v. *Mayor*, 134 Fed. 844, 857, *Cline Mfg. Co.* v. *Kohler*, 27 F.2d 638, *Wilkie* v. *Manhattan Rubber Mfg. Co.* 14 F.2d 811.

The question is, then, whether the appellee has established, by "full, unequivocal and convincing" evidence that the use by the public of the Blaisdell shims was "by way of experiment, and in order to bring the invention to perfection" (*Elizabeth* v. *Pavement, supra*).

Not only does the evidence fall short of any such standard, but the record, in a positive sense, shows to the contrary. Blaisdell, in his testimony in the interference, freely and repeatedly admitted that he failed to check on the cars having shims therein after 3 or 4 months of operation (App. 37, 41). It is admitted that he so acted because he was fully satisfied with the operation of the shims at the time he ceased to check upon their operation (App. 37

39, 40, 41). He, in fact, made application for patent on the shim within the statutory period (App. 29) but allowed the application to go to abandonment. Blaisdell freely described his shims to a number of people (App. 46, 49), seemingly cautioned no one to secrecy, nor otherwise took any steps to prevent the appearance of abandonment of the invention to the public.

Since Blaisdell was satisfied that his shim was functionally successful, how can it be said that any subsequent use was experimental? "Where the idea of an appliance has been conceived and the conception carried into effect by its construction, which is used or capable of being used for the purpose for which designed, it is no longer an experiment, but an invention," *W-R Co.* v. *Sova,* 106 F.2d 478, 481.

Any experimentation by Blaisdell prior to the filing of his second application was not to perfect the one-piece shim. That device had ben tested and proven. Such experimentation as did occur was directed toward an *improvement* of the completed invention, i. e. to develop a shim which could be manufactured more cheaply (App. 34). The experiments related, then, not to the one-piece shim invention but to a separate invention. It is well established that, to be effective against a public use bar, experimentation must be directed to the invention *claimed, American Ballast Co.* v. *Davy Burnt Clay Ballast Co.,* 220 Fed. 887, *Eastman v. Mayor, supra; Midland Flour Milling Co.* v. *Bobbitt,* 70 F.2d 416.

Controlling authorities are believed, therefore, to indicate that Blaisdell's shims were voluntarily released by him to public use which, out of protection of the public and as provided by law (35 U.S.C. 102b), should bar the grant of a patent to appellee on those shims. It is believed that the District Court erred in holding otherwise.

Claims 16 to 20 and 22 to 26 Describe the Blaisdell Shims

If the conclusion be reached that Blaisdell's one-piece shims were in public use, such use would constitute a bar only to claims which describe those shims or do not define invention thereover. There still remains, then, the question whether claims 16 to 20 and 22 to 26 describe the shims put into public use by Blaisdell. Appellee contended in the District Court that they do not and the Court held that "the evidence lacks the certainly required by law, of the identity of the early shims made by Blaisdell and the subject matter" of the identified claims (App. 149).

Contrary to that holding, it is believed that the record includes clear and uncontroverted evidence that Blaisdell's shims answer to every limitation of the claims on appeal.

The precise issue is whether the Blaisdell shims were "of foil-like thickness and of such thickness and flexibility as to be readily distortable about" the bearing insert, as specified, for example, in claim 16 (App. 4).

It is not understood that appellee would contend that Blaisdell's shims were not "of such thickness and flexibility as to be readily distortable" about the bearing insert. Such contention, if made, would be clearly contrary to the record which shows that the Blaisdell shims were of "pliable metal" and were adapted to be "bent around the bearing insert" (App. 52). Moreover, prior to insertion, the shims were "flat—for different size shafts" (App. 63), a shape which would, of necessity, require that they be "readily distortable" about the insert.

Appellee's principal contention has been that the shims put in use by Blaisdell would not answer to the description "of foil-like thickness." Justification for such a view is not apparent. By definition (Webster's New International Dictionary, 2nd Edition, unabridged, G & C Merriam Company, Springfield, Mass., 1937), "foil" is "a leaf or very thin sheet of metal—." Blaisdell's uncontradicted testimony (App. 35) was that his original shims were made from "shim stock," which by its very nature, is a "very thin sheet of metal." Blaisdell testified, for example, that the shims put into public use were ".006 of an inch at the thickest part and .002 at the thinnest." (App. 40). Although one witness, Lyle M. Lane, (App. 47), described the shim as a "heavy brass deal" there can be no uncertainty as to the actual thickness of the Blaisdell shims. It stands uncontroverted on the record that they were of "shim stock," six thousandths of an inch at the thickest portion.

It seems apparent that shims of such thickness are "foil-like." The testimony by appellee's witness at the trial would seem to confirm this view rather than otherwise. For example, he volunteered the definition of shim stock as "a thin piece of metal" about "the thickness of a newspaper" (App. 14). If there were any remaining doubt on this point, it would seem to be settled by the witness' testimony on cross-examination, as follows:

> "Q Mr. Sasscer, you testified that something which was a foil-like thickness was very thin. In your opinion is foil-like thickness any particular thickness? Can you pin that down to thousandths of an inch which might constitute the boundaries of something that is a foil-like thickness?
>
> A Yes, sir, a foil-like thickness is a sheet of metal that is less than ten thousandths of an inch thick. That's as we term it in our trade. In other words, when it gets beyond ten thousandths of an inch it isn't foil any more.
>
> Q Something that is six thousandths of an inch is a foil-like thickness?
>
> A That would be foil-like thickness, yes, sir."

This would seem to constitute a flat admission that the six thousandths inch thick shims put in public use by Blaisdell were "of foil-like thickness."

Moreover, contrary to the apparent purpose of his testimony, the witness furnished no proof that "foil-like" shims could not be tapered by a hand hone, as Baisdell's were made. The witness' difficulty in hand honing was encountered with shims four thousandths of an inch in thickness (App. 18). There was no testimony with respect to foil-like shims of six thousandths inch thickness. The evidence shows that Blaisdell successfully hand honed shims of such thickness without, apparently, encountering the difficulties experienced by the witness with thinner material. Finding of Fact No. 15 does not appear, therefore, to be supported by the witness' testimony.

It is true, as appellee has asserted, that the Patent Office examiner failed to include Blaisdell in interference with appellee and Cocklin on a claim limited to a shim "of foil-like thickness." It is idle to speculate, as observed by the Board of Appeals (App. 137), whether he did so because he applied a limited interpretation to the Blaisdell application disclosure (App. 20) or for some other reason. The exact nature of the early Blaisdell shim, with which we are concerned here, was not revealed until the taking of testimony in Interference No. 83,587 (App. 32). It is the evidence now available which should determine if the shims were "foil-like", rather than assumptions based on the failure of the examiner or Blaisdell to take action in some respect.

In brief, the phrase "of foil-like thickness" embraces thin metal sheets such as shim stock, of which the Blaisdell shims were made. Further, that stock was of a thickness (.006 in.) which appellee's witness admits would be "foil-like." It would seem that the evidence of the identity of Blaisdell's shims and the subject matter of claims 16 to 20 and 22 to 26 could not be more certain. The District Court, therefore, is believed to have erred in holding that the evidence "lacks the certainty required by law."

Public Use of Shims Made By Appellee Should Bar Allowance of Claims 16 to 20, 22 and 25

Claims 23, 24 and 26 are limited to a shim or shim stock of one-piece construction. Since the shims made and installed in an Oldsmobile by Allen in 1939 were formed of laminated metal foil, public use of those shims would not constitute a bar as to claims 23, 24 and 26. The Patent Office rejection based on public use of Allen's laminated shims, therefore, applies to claims 16 to 20, 22 and 25.

The circumstances under which Allen's shims were put into use by the public are similar, in all essential respects, to those under which Blaisdell's shims were used. Appellee made and installed laminated shims in an Oldsmobile in 1939 as an experiment. The car was driven from 12,000 to 14,000 miles (Finding of Fact No. 5, App. 143) and the shims were found to accomplish the purpose for which they were designed (Finding of Fact No. 6, App. 143). Appellee's view of the results of the experiment is revealed in the following exchange (App. 91):

> "XQ. 75. You are not answering my question. I was not referring to the late shim, Mr. Allen. Remember my question: At the time you sold this car you were satisfied that the shims you placed there were satisfactorily performing the function for which you inserted them?
>
> A. Yes, up until that time.
>
> XQ. 76. The bearings were satisfactory, as far as you know, at the time you sold that car?
>
> A. I think so.

> XQ. 77. The oil consumption was satisfactory for a car of that age?
>
> A. Yes."

Early in 1942 the car was sold for $75.00. The purchaser was not told of the presence of the shims (App. 91). Appellee made no attempt to follow up on the car until after his application was filed (App. 92).

Although satisfied with the performance of the laminated shim, appellee felt that a one-piece shim would be even better (App. 82), but manufacture of such a shim offered difficultites (App. 84). Appellee, over a period of years, developed a machine for rolling one-piece shims and, only after such development work, filed his application. His reason for not filing sooner was explained as follows (App. 89):

> "At first I did not know whether I could make the shim or not. A patent on the product I have made would not be any good to me, money was scarce and I wanted to see if I couldn't figure out some way to make it to where I would be satisfied that I could produce a shim without spending the money necessary to make out an application."

The fact that Allen's shims were originally installed in the automobile as an experiment does not, as Finding of Fact No. 16 seems to assume, permanently stamp all subsequent use of the shims in the automobile as experimental. Such subsequent use was experimental only until the laminated shims had furnished proof of their practical operation. The following statement, induced by a similar factual situation in *W-R Co.* v. *Sova, supra,* is particularly apt:

> "By his experiments he had proved the capacity of his appliance to effect what he had proposed. When he had done this the patent law assigned to him at that time the merit of having produced a complete invention.
>
> "Where the idea of an appliance has been conceived and the conception carried into effect by its construction, which is used or is capable of being used for the purpose for which it is designed, it is no longer an experiment but an invention."

When Allen's laminated shims had proved their capacity "to effect what he had proposed" the experimental phase of their use in his car had come to an end. By his own admission (App. 90, 91, this phrase ended before he sold the car. It seems self-evident, therefore, that the period of experimentation would not embrace a part of the later portion of the period of appellee's use of the shims and would embrace none of the long period of use by the various persons who later purchased the car.

Finding of Fact No. 16, however, holds that Allen's "continued effort to make shims which would be an improvement over those he had installed likewise was experimental." Allen's "experimental" effort was, insofar as the record shows, limited to the development of a *machine to make* a one-piece shim. The record shows no experiments directed toward an improvement of the laminated shim, as, indeed, none were necessary. Although not directly pertinent to the issue, there was likewise no experimental testing of a one-piece shim. Allen, seemingly, felt no need for such experiments in view of the success of the laminated shim.

Thus, the truth of the Finding may be admitted without disturbing the conclusion by the Board of Appeals that Allen's shims were in public use. Allen's "efforts" were, indeed, "experimental" but those experiments were directed toward the perfection of an invention other than the shim. The efficacy of the shim had been demonstrated and its invention was completed at the moment of that occurrence.

In *Midland Flour Milling Co.* v. *Bobbitt, supra*, the invention related to the shape of the cone in a separator. The patentee contended that an installation, which otherwise would have been a bar, was experimental. The evidence indicated, however, that the experiments related to use of several different fans in the separator, which led the Court to point out that the patentee "conducted no experiments whatever with reference to the sole matter covered by the patent—". The conclusion was reached that "the experiments were, therefore, immaterial."

Such reasoning applies with even more force in the instant case. The experimentation here was not on some part of the same device, as in the *Midland* case, but on another device entirely, a rolling machine.

It is submitted, therefore, that Finding of Fact No. 16, while accurate, does not support the conclusion that Allen's shims were not in public use (Conclusion of Law No. 1, App. 149). If, on the other hand, Finding of Fact No. 16 had been so worded as to indicate that Allen's experiments were directed toward completion of the *shim* invention, it would not be supported by the evidence.

The fact that Allen received no substantial profit from the sale of his shims (in view of the low sale price of the car), or the fact that the users of the car seemingly had no knowledge of the presence of the shims therein, would not stay the running of the public use period. Accepted authorities, as pointed out hereinbefore in connection with the Blaisdell shims, are to the contrary.

The essential facts are that (1) Allen proved the efficacy of the shims, (2) he did not apply for a patent when the experiment was over because the preferred form of shim would be difficult to make, and (3) he voluntarily relinquished control of the shims upon sale of the car, taking no precautions against their discovery by subsequent purchasers or other members of the public.

Under every test supplied by the applicable authorities, the use of Allen's shims would seem to be a public use which should act as a bar to the grant of claims 16 to 20, 22 and 25.

CLAIMS 18, 25 AND 26 PRESENT NO SEPARATE ISSUE

The District Court made no finding that the Flinn patent was not effective for the purpose for which it was cited and no extended discussion of that phase of the decision of the Board of Appeals would seem to be indicated. The patent was cited to show that it was common in the shim art to supply shims in the form of a stock sheet from which separate shims could be severed. Claims 18, 25 and 26 are directed to a shim stock sheet rather to than an individual shim. Appellee's witness admitted (App. 19) that the reference would suggest the use of such a stock sheet and this would seem to end the matter.

CONCLUSION

It is submitted that the record in the case and the applicable authorities are devoid of any basis for a holding that the Blaisdell and Allen shims were not in public use, and that the District Court was in error in so concluding. It is believed that the Court likewise erred in holding that there is uncertainty as to whether claims 16 to 20 and 22 to 26 describe Blaisdell's original shim. It is submitted accordingly that the decision of the District Court should be reversed.

Respectfully submitted,

CLARENCE W. MOORE,
Solicitor, United States Patent Office,
Attorney for Appellant.

S. WM. COCHRAN,
Of Counsel.

August, 1957

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BRIEF FOR APPELLEE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

United States Court of Appeals
For the
District of Columbia Circuit

FILED OCT 1 1957

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Appeal No. 14,066

ROBERT C. WATSON, Commissioner of Patents, *Appellant*

v.

THOMAS J. ALLEN, *Appellee*

Appeal from the Judgment of the United States District Court for the District of Columbia

A. YATES DOWELL
A. YATES DOWELL, JR.
1345 Pa. Ave., N.W.
Washington 4, D. C.
Attorneys for Appellee

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

STATEMENT OF QUESTIONS PRESENTED

In the opinion of appellee the questions are:

(1) Whether the placing in the bearings of his automobile of admittedly experimental shims and selling the automobile for $75 "junk value" approximately two years later, the inventor continuing to work to produce an improved shim over that which was installed in his car, raises the public use or sale bar, 35 USC 102(b).

(2) Assuming that Blaisdell in the late 30's installed one or more sets of experimental shims from which the claims are not distinguishable, did Blaisdell's installation constitute public use or sale under the statute 35 USC 102 (b) where Blaisdell continued development work to produce an improved shim.

(3) Whether the evidence of Blaisdell's manufacture of a shim of "foil-like thickness" meets the test of proof beyond a reasonable doubt required to sustain the public use bar of 35 USC 102(b).

INDEX

Page
Counter-Statement of the Case 1
The Flinn Patent 4
Summary of Argument 4
Argument 6
The Non-Removal of Experimentally Installed Shims From Automobile Bearings in an Automobile Subsequently Disposed of to a Third Party, No Commercial Motive Being Present, Does Not Raise the Statutory Public Use Bar Where the Inventor Continues His Experimental Efforts Resulting in an Improved, Commercially Acceptable Form of His Inventive Concept 6
Blaisdell's Activities Did Not Constitute Public Use 13
Even If It Be Assumed Arguendo That Blaisdell's Shims Were in Public Use the Evidence of the Physical Form of Those Shims Lacks the Requisite Certainty Required of Identity With Allen's Claims to Hold the Latter Unpatentable 14
The Flinn Patent Has No Pertinency To This Proceeding 15
Conclusion 16

AUTHORITIES CITED

Cases:

American Ballast Co. v. Davy Burnt Clay Ballast Co., 220 F. 887 12
Andrews v. Hovey, 123 U.S. 267, 275 10
Blaisdell, In re, 242 F. 2d 779 ....5, 10
Cline Mfg. Co. v. Kohler, 27 F. 2d 638 ....11, 14
Eastman v. Mayer, 134 F. 844 11
Egbert v. Lippman, 104 U.S. 333 ....10, 12, 13

Page

Electric Storage Battery Company v. Shimazdzu, 307 U.S. 5 11
Elizabeth v. Pavement Co., 97 U.S. 126 ......8, 9, 10, 13
General Motors Corporation v. Bendix Aviation Company, 123 F. Supp. 506, 102 USPQ 58 7
Goodwin v. Borg-Warner, 157 F. 2d 267 ....5, 7, 9
Guy et al. v. Stein, 239 F. 729, 732 11
Lorenz v. Colgate-Palmolive-Peet Company, 167 F. 2nd 423 11
Martin, In re, 74 F. 2nd 951, 24 PQ 244, 1935 CD 255 11
Midland Flour Milling Co. v. Bobbitt, 70 F. 2d 416.. 12
Muncie Gear v. Outboard Company, 315 U.S. 759, 768 14
Smith and Griggs Mfg. Co. v. Sprague, 123 U.S. 249, 253, 254, 264 11
Star Mfg. Co. v. Crescent Forge & Shovel Co. et al., 179 F. 856 10
Wilkie v. Manhattan Rubber Co., 14 F. 2d 811 12
W. R. Co. v. Sova, 106 F. 2d 478, 43 USPQ 35 11

STATUTES:

35 U.S.C. Section 102(b) I

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 14,066

ROBERT C. WATSON, Commissioner of Patents, *Appellant*

v.

THOMAS J. ALLEN, *Appellee*

Appeal from the Judgment of the United States District Court for the District of Columbia

BRIEF FOR APPELLEE

COUNTER-STATEMENT OF THE CASE

The applicant Allen has had an arduous passage, having appeared before various tribunals of the Patent Office (in addition to the Court of Customs and Patent Appeals and the District Court) in apparently every type of proceeding affecting patents which is utilized in the Patent Office. His application for patent was filed April 19, 1946. Allen's original attorney William D. Hall, and Blaisdell's original attorney H. A. Dreckman, have died in the meantime.

The appellant's statement of the case omits certain essential facts. Appellant correctly points out that the Board of Interference Examiners refused to recommend the institution of public use proceedings. The pertinent excerpt from the decision of the Board of Interference Examiners appears in the Joint Appendix at pp. 109-111. (The entire decision is reprinted in plaintiff's Exhibit 5 at pp. 289-302). Appellant admits that the installations of the shims by both Allen and Blaisdell on which the Patent Office's contention of public use is based were done for experimental purposes.

In the Interference 83,587, *Blaisdell* v. *Allen* v. *Cocklin*, the sole count or claim was that stated on page 3 of appellant's brief, namely:

> "A bearing shim adapted to be placed under a shaft bearing and formed of shim stock, said shim being tapered from the center to both edges thereof."

A separate Interference No. 83,588 was set up between Allen and Cocklin, excluding Blaisdell, based on Allen's claims 16 and 20 (App. 4, 5). The same Examiner set up both Interferences and if he had been of the opinion that Blaisdell could have made the more limited claims 16 and 20 of Allen, he would have set up only one Interference instead of two. Blaisdell had access to Allen's application and knew of the other Interference and could have requested the Patent Office to make him a party, but he did not do this. Explanation is found in the limitations contained in these claims that the shim is comprised of a sheet of "foil-like thickness". Blaisdell testified (App. 40, 41) that his attorney Dreckman had obtained information from him which was stated in the attorney's remarks accompanying an amendment that Blaisdell's shim varied in thickness from .006 "to .002"; but this had reference to Blaisdell's conception of his invention as presented in his description of it to the Patent Office and is not equivalent to testimony by Blaisdell that the shim actually made by him had such characteristic. Dreckman, who himself testified, admitted that the claim in Interference 83,587 was broad enough to read on a shim whether of foil-like thickness or not (App. 44, XQ 43, 44).

In order to point up the issues in this case reference is made to the following facts:

1. The shims made by Allen which the Patent Office admits were installed experimentally were laminated from several pieces of tin foil (appellant's Brief, page 6, Pl. Exhs. 2A, 2B).

2. Allen directed his further efforts to the production of a unitary shim. The Patent Office admits that these further efforts were experimental. In its decision the Board of Appeals wrote (App. 125):

> "It is doubtless true that from the original installation of the laminated shim in 1939 all the way through to 1946 when he put the unitary shim on the market appellant was seeking to develop what he thought was a commercially acceptable product."

The Patent Office brief on page 27 states:

> "Allen's 'efforts' were indeed 'experimental' but those efforts were directed toward the perfection of an invention other than the shim."

3. The shims made by Blaisdell which the Patent Office admits were made for experimental purposes were of one piece or unitary construction honed down (appellant's Brief, page 7).

4. Blaisdell directed his further efforts to the production of a laminated shim. In its decision the Board of Appeals wrote (App. 123):

> "Blaisdell ceased his efforts to manufacture a unitary shim and turned his attention to the production of a laminated shim for the reason that it would enable a mechanic to remove as many layers as necessary to bring the shim to the desired thickness. He

> made his first laminated shim in July of 1945 and put it on the market in September 1945."

The foregoing was adopted by the District Court in its Finding of Fact No. 12, and quoted without question in the Patent Office brief at page 8.

5. The Patent Office recognizes that claims 16 to 20, 22, 25 and 26 cover a one piece or a laminated shim (appellant's Brief, pages 13, 24) and that claims 16 to 20 and 22 to 26 cover a one piece shim (appellant's Brief pages 14 and 20).

6. The *present* Patent Office position is that Allen's efforts subsequent to his laminated shims and Blaisdell's efforts subsequent to his one piece shims were for different inventions and therefore cannot be considered as the continuation of experiments of the same inventions (appellant's Brief, pages 19, 27).

The Flinn Patent

The Flinn patent is relied on by the Patent Office as an anticipation of Allen's feature as presented in claims 25 and 26 (App. 6, 7 and see Fig. 5, page 28). The Flinn patent suggests stamping from *folded* material a plurality of shims, whereas Allen's claims are directed to the removal of shims of a desired width one at a time from a sheet formed as in Fig. 5 (see Pl's. Exh. 1). Allen's expert witness, Sasscer, the Fleet Manager for Jacobs Transfer Company, who has been in the automotive and truck repair business practically all of his life (App. 10) testified that he found no reference in the Flinn patent to cutting a shim of the desired width from a sheet (App. 17).

SUMMARY OF ARGUMENT

The decision of the District Court is consistent with the decision of the Patent Office Board of Interference Examiners who, after consideration of all the evidence before the Patent Office, refused to recommend the institution of public use proceedings (App. 109-111); the decision of the District Court is consistent with the decision in *Goodwin* v. *Borg-Warner Corporation,* 157 F. 2d 267 (CA 6, 1946), c. d. 335 U.S. 911, conceded by the Patent Office to be squarely in point (appellant's Brief page 16). The contrary decision by the Court of Customs and Patent Appeals in *In re Blaisdell* 242 F. 2d 779 is without precedent and misconstrues the purpose and intent of the public use or sale provisions of the statutes.

Allen's installation of his tinfoil shims admittedly was experimental. His selling of the car with the shims therein was not public use or sale because there was no commercial motive involved and Allen continued to work on the production of an improved shim. Even though the tinfoil shims he installed were satisfactory in that they reduced oil consumption it was in the public interest that Allen improve his invention so that the public could have the use of it and the law does not require that Allen act in an unreasonable manner. His removal of the shims would have indicated failure of the experiment. One successful experiment does not foreclose an inventor from further experimentation to improve his brainchild.

Blaisdell's installation of shims in vehicles on used car lots admittedly was experimental, no commercial motive being present with respect to Blaisdell who did not make any charge or receive compensation for the work. The commercial aspect was a mere incident to the experimentation and did not create the bar. Blaisdell continued to experiment to produce an improved shim and therefore his installation in the used cars was not public use.

Blaisdell's record indicates that he did not manufacture a shim of foil-like thickness in accordance with Allen's claims. If he thought that he had done so he would have copied the claims and become a party to the other Interference. If the primary examiner in the first instance had thought so he would have suggested the claims. Appellee's witness, an expert of long experience and holding a position of high responsibility with the Jacobs Transfer Company, testified that prior to the initiation of this action he attempted to taper shim material of foil-like thickness using a hand whetstone as Blaisdell testified he did but that it was impossible to do so because of the fragile nature of such thin material. The testimony of Blaisdell's witness Lyle Lane that he saw Blaisdell working on a "heavy brass deal" indicates that Blaisdell either was honing shim material heavier than "foil-like" or that he was honing the bearing insert itself. Certainly, more than a reasonable doubt is raised.

ARGUMENT

The Non-Removal of Experimentally Installed Shims From Automobile Bearings in an Automobile Subsequently Disposed of to a Third Party, No Commercial Motive Being Present, Does Not Raise the Statutory Public Use Bar Where the Inventor Continues His Experimental Efforts Resulting in an Improved, Commercially Acceptable Form of His Inventive Concept

Allen installed laminated shims in his Oldsmobile in 1939 as an experiment. He was satisfied with the principle but recognized that the particular form of the shim was not commercially practicable. He bent his efforts to producing a shim having the same essential features but formed of one piece and which would be commercially practicable.

The Patent Office Board of Appeals held that Allen's leaving his experimental shims in his automobile amounted to a public use or sale. The Solicitor apparently recognizes the weakness of this position as he now contends that Allen's subsequent efforts were directed toward a "separate" invention. The utter inconsistency of this latter position is demonstrated by the fact that Allen's claims 16, 17, 18, 19, 20, 22 and 25 are readable equally on both of the so-called "separate" inventions, i.e., either a one piece shim or a laminated shim of more than one piece as the Patent Office recognizes in its contention that Blaisdell's installation of a one piece shim and Allen's installation of a laminated shim are equally applicable to prove public use of the identical claims, namely 16 to 20, 22 and 25.

The contention of the Patent Office is based on the erroneous separation of a unitary inventive concept into a multiplicity of separate inventions. The invention of the tapered shim as defined broadly in the claims was a unitary concept on which only one patent has been sought by Allen and Blaisdell, individually.

In the early part of its brief, the Patent Office views claims 16-20, 22 and 25 as reading on *all* forms of the invention. It then inconsistently bases its argument on the assertion that "separate" inventions are involved.

No question of separate inventions was raised during the nine years of proceedings in the Patent Office.

There is no authority in established law nor in principle for the Patent Office proposition that the successful reduction of an invention to practice is inconsistent with further experimentation to produce a commercially usable or practicable device. It certainly is in the public interest, as the District Court recognized (Trans. page 54), to bring an invention to a state of perfection in which it is usable by the public rather than to leave it in rudimentary form in which the public is unable to receive its benefits. *General Motors Corporation* v. *Bendix Aviation Company,* 123 F. Supp. 506, 102 USPQ 58 (D ND Indiana 1954).

During the hearing before the District Court, that Court's attention was directed to the fact that the Court of Customs and Patents Appeals had rendered a decision in the Blaisdell case contrary to the decision in *Goodwin* v. *Borg-Warner,* 157 F. 2d 267 (CA 6, 1946), but the District Court chose to follow the *Borg-Warner* case rather than that of the Court of Customs and Patent Appeals.

The error in the reasoning of both the Patent Office and the Court of Customs and Patent Appeals lies in the falacious assumption that experimentation only takes place if modification and testing of the *original* physical embodiment in specie of the invention takes place. It is reasonable to suppose that in the *Elizabeth* v. *Pavement Co.* case, 97 U.S. 126, the inventor may have observed and possibly replaced certain blocks in the pavement. A shim is quite a different thing. Being of a fragile nature and of inexpensive material it is simpler in the course of experimentation to make additional shims rather than to attempt to remove a shim of foil from an automobile and modify it. This follows since the act of removing an installed shim may result in tearing the foil of which it was made and the cost of material to produce additional shims is so slight that salvage and reuse of the original shim material is not reasonable or economically worthwhile.

The first shims produced by Allen and Blaisdell were produced manually for experimental purposes. Both Allen and Blaisdell were satisfied with the performance in principle. Both Allen and Blaisdell recognized that the physical embodiment of the shim must be modified and each bent his efforts to produce an improved shim which would be commercially acceptable. Neither Allen nor Blaisdell thereafter commercially produced a shim having the physical embodiment of his experimental shim. Thus, if it can be said that Allen and Blaisdell were ''satisfied'' with the *performance* of their experimental shims it can be stated with equal force that they were dissatified with the *physical form* and lack of perfection of the invention.

The Patent Office view, that satisfaction of an inventor with the degree of progress attained or the *function* of a physical embodiment of his invention is inconsistent with further experimentation, is wholly incorrect. The Supreme Court in *Elizabeth* v. *Pavement Co.,* 97 U.S. 126 stated with authority that the public use bar is not raised by a delay occasioned by an bona fide effort to bring the invention to perfection or to ascertain whether it will answer the purpose intended.

Aside from its inconsistency the Patent Office position finds no authoritative support. On the contrary and in direct conflict with the Patent Office position is *Goodwin* v. *Borg-Warner,* 157 F. 2nd 267 (CA 6, 1946) in which Daukus installed an experimental clutch in a car of a third party over which he had no control and the third party sold the car with the clutch in it.* The court held, this did not constitute public use. This case is conceded by the Patent Office to be on all fours and the criticism including that it is bad law is not justified since the criticized language in that decision is not the basis of the court's decision.

The Patent Office takes exception to the case because of the language:

> "The plate, so far as this record shows, was never used for a profit, nor was it within the terms of the statute put on 'sale'. 35 U.S.C. Sec. 31. It was placed in the Cadillac purely for experimental purposes and

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* Patent Office Interference No. 77,723.

The record on behalf of Daukus includes the following (Pl. Exh. 6):

Q. How long did you operate this clutch plate in the Cadillac car?

A. We experimenting about three, four weeks, and returned it to the owner. Few weeks later owner report he have very nice clutch.

Q. 51. What happened to that car with this clutch plate in it?

A. Owner disposed of car.

Q. 52. When did he dispose of it? How long after you had made the installation?

A. 1932—springtime, he drive about six, eight months.

Q. 53. Do you know where that Cadillac car and clutch plate are now?

A. No.

Q. 54. Have you attempted to locate it?

A. Yes.

Q. 55. And you haven't been able to do so?

A. No.

> this record does not show that it was sold with Daukus' knowledge or consent."

Reference to the absence of profit was entirely sound, as indicating that Daukus had no commercial motive. While it is true that a profit which is incident to experimentation does not raise the bar, many cases have turned on the point that the existence of substantial commercial exploitation is inconsistent with the so-called experiment being the primary motivation. See for example: *Star Mfg. Co.* v. *Crescent Forge & Shovel Co. et al.,* 179 F. 856, (CA 7, 1910), (which involved four years of regular commercial use) relied on by the CCPA in *In re Blaisdell, supra.*

The absence of profit and knowledge or consent are consonant with a finding that Daukus had no substantial commercial motive, thus distinguishing his situation from that of many cases in which a holding of public use was based on a predominating commercial motive. Since all that Daukus did was to install the clutch plate in the car and the evidence did not establish that the car was sold with his knowledge or consent, it naturally follows he did not intend to reap a profit from the installation of his clutch plate in the car.

So far as knowledge and consent are concerned the law is well settled that these elements are not a prerequisite to the finding of statutory public use. Beginning with *Andrews* v. *Hovey,* 123 U.S. 267, 275, "knowledge, consent or allowance" by the inventor of the use of his invention by others is no longer necessary to establish the public use bar of the statute. Until this ruling, which was subsequent to the well known case of *Egbert* v. *Lippman,* 104 U.S. 333, and the case of *Elizabeth* v. *Pavement Company, supra,* unless the public use was with the knowledge or consent of the inventor, the bar was not established. Since this case, however, the law has been clear that the element of knowledge or consent of the inventor is not a pre-requisite to establishment of the public use bar. See for example, 69 Corpus Juris Secundum 365 in which it is stated:

> "* * * it is now settled that public use may bar the right to a patent regardless of whether it was with the inventor's knowledge, consent or allowance * * *",

citing *Electric Storage Battery Company* v. *Shimazdzu,* 307 U.S. 5; *Lorenz* v. *Colgate-Palmolive-Peet Company,* 167 F. 2nd 423 (CCA NJ); *In re Martin,* 74 F. 2nd 951, 24 PQ 244, 1935 CD 255 (CCPA).

The reasonable interpretation of the basis for the Court's use of the reference to Daukus' knowledge or consent is that the Court was considering whether he intended to commercially profit from the inclusion of the clutch plate in the vehicle.

The other cases relied on by the Patent Office turned on the presence of a substantial and predominating commercial motive. In *W.R. Co.* v. *Sova,* 106 F. 2d 478, 43 USPQ 35, 150,000 rings were produced on the inventor's machine and passed into regular production, and no subsequent change was made in the machine; In *Smith and Griggs Mfg. Co.* v. *Sprague,* 123 U.S. 249, 253, 254, 264 the patented machine for making buckles had been used to produce 7,000,000 buckle levers in the regular conduct of business. In *Guy et al.* v. *Stein,* 239 F. 729, 732 (CCA 7, 1916) the invention was in a dropper for a miner's carbide lamp which the patentee admitted that he had shown to over a hundred miners for the purpose of creating a market and that "he kept up the habit of showing his lamps right along through four or five years and explained it at different times to various people."

In *Eastman* v. *Mayer,* 134 F. 844 (CCA 3, 1905) the invention was applied to at least two fire engines in the normal course of business, following extensive public testing and demonstration on an earlier engine, and the form of the invention was not thereafter changed.

In *Cline Mfg. Co.* v. *Kohler,* 27 F. 2d 638 (CCA 7, 1928) the court denied the defense of public use because of the Master's finding that the alleged prior use was experimental and that the defendant had failed to establish public use beyond a reasonable doubt.

In *Wilkie* v. *Manhattan Rubber Co.,* 14 F. 2d 811, (CCA 3, 1926) sales of the patented devices were found by the court to be "outright business transactions unaffected by any intent, then appearing, to use them for experiments."

American Ballast Co. v. *Davy Burnt Clay Ballast Co.,* 220 F. 887 (CCA 7, 1915) involved use in the regular course of business of a machine for making ballast, the decision stating "the testing was merely incidental, and, moreover, was directed solely to matters forming no part of the invention or the claims."

Midland Flour Milling Co. v. *Bobbitt,* 70 F. 2d 416, (CCA 8, 1934) involved a regular commercial use of a dust collector in which the only structural change was on a fan forming no part of the invention.

The corset case, *Egbert* v. *Lippmann,* 104 U.S. 333 is sound but has no direct pertinency. In it the inventor gave corset stays to a friend for her use over a period of years. Eleven years after her initial use he applied for a patent. There was no thought of experiment or testing, nor was any change made in the physical form of the invention. While he slept on his rights the invention came into general, almost universal use.

In Allen's and Blaisdell's cases the experimentation and physical modification of the form of the invention were paramount.

The Patent Office argument that the public had access to Allen's and Blaisdell's inventions seems beside the point as this would appear to be true in every case in which members of the public have actual use of an invention, as for example, in *Elizabeth* v. *Pavement Co., supra.* Furthermore, the evidence indicates that the public was incapable of recognizing the shim invention installed in an automobile, since the service manager and mechanic who disassembled Allen's former automobile failed to perceive it from an inspection of the disassembled bearing, until it was pointed out to them (App. 106-109). Certainly, no basis is present for application of the *Egbert* v. *Lippman* doctrine.

Blaisdell's Activities Did Not Constitute Public Use

Blaisdell's early shims were installed in automobiles admittedly for experimental purposes. The purchasers of the cars were not told of the shims and Blaisdell did not ask for nor receive payment for these experimental installations. Blaisdell recognized the soundness of the principle and attempted unsuccessfully to interest manufacturers and filed a patent application. Neither of these is inconsistent with Blaisdell's further experimentation to produce the invention in a physical form which he thought would insure its commercial usefulness and success.

The record is clear that Blaisdell's subsequent commercial shim was laminated rather than of one piece. The Patent Office position that these are separate inventions and the latter not the invention claimed (appellant's Brief page 19) is utterly inconsistent. If Allen's claims 16 to 20 and 22 and 25 read on both physical forms of the invention, how can it be said that Blaisdell's further efforts to produce one form of the invention is not directed to the invention *claimed.*

Even If It Be Assumed Arguendo That Blaisdell's Shims Were in Public Use the Evidence of the Physical Form of Those Shims Lacks the Requisite Certainty Required of Identity With Allen's Claims to Hold the Latter Unpatentable

Allen's claims contain limitations not found in Blaisdell's early shims. In order to raise the statutory bar there must be a public use of the devices which the claims cover. *Muncie Gear* v. *Outboard Company,* 315 U.S. 759 768. Allen's rights should not be struck down in the absence of proof beyond a reasonable doubt. In *Cline Elec. Mfg. Co.* v. *Kohler,* 27 F. 2nd 638, 641 (CA 7) c.d. 278 U.S. 646, the Court said:

> "It is quite elementary that, to strike down a patent upon the ground that the patented article was in public use more than two years before the application was filed, this fact must be established by evidence so clear as to satisfy beyond reasonable doubt; and the evidence must so satisfy, not alone as to the time, but also that the use was of the very thing which was patented. James Heddon's Sons, Inc., v. South Bend Bait Co., (C.C.A.) 14 F. 2nd 805."

Allen's witness Sasscer, the Vice president and Fleet Manager of Jacobs Transfer Company, was familiar from long years of experience with shims of this nature. He testified that a mechanic could not produce a tapered shim from a metal sheet of foil-like thickness using a whetstone and doing the job by hand, the method indicated by Blaisdell. He testified that he had attempted to produce a tapered shim by this method many times but that in the process of honing the flimsy material was destroyed. From the testimony of Blaisdell's witness, Lyle Lane, who stated that he saw Blaisdell working on "a heavy brass deal", it appears likely that he saw Blaisdell honing the bearing insert itself which is a thick piece of metal next to which the shim fits, rather than the shim. Honing of the insert would reduce the thickness and thus accomplish the desired result.

The Flinn Patent Has No Pertinency to This Proceeding

The Patent Office has misinterpreted the testimony of Allen's witness Sasscer with reference to the Flinn patent. Sasscer testified that he found no reference or disclosure in the Flinn patent to cutting from a sheet a shim of a width to correspond to that of a particular insert (App. 17). His answers to the questions are in no wise inconsistent. The Flinn patent Fig. 3 shows a shim which may have been stamped from material such as that shown in Fig. 2 and this is as far as the witness went. It is clear, however, from an examination of the Flinn patent that it suggests the folding of a strip of sheet material and stamping a number of shims therefrom at the same time, which is entirely different from Allen's claims (See Pl. Exh. 1).

CONCLUSION

Allen's application for a patent on a commercially successful device, on which there is no question of any lack of invention, has been subjected to a most rigorous and prolonged examination. The Patent Office Board of Interference Examiners decided in the first instance, in Allen's favor on the public use issue, basing its decision on authority squarely in point with no authority to the contrary, which should have concluded the matter. But the Patent Office, created to grant patents, had not exhausted every effort to prevent the issuance of a patent, so rather than follow the decision of its own Board of Interference Examiners and the Court of Appeals of the Sixth Circuit, it undertook to create a new basis of refusal for which there is no legal precedent. Without justification Allen was forced into District Court. Certainly, the Patent Office had fulfilled to overflowing and beyond its responsibility to safeguard the public interest and in a manner most unfair to Allen.

Nevertheless the Patent Office again has forced Allen, at *his* expense, and in the face of the decisions of the

Sixth Circuit Court of Appeals and that of the District Court of this city to appear before this tribunal.

The decision of the CCPA is no justification because it is without basis in law or in principle, and our District Court made its decision with knowledge of the CCPA decision.

It is difficult for us to understand why the professedly undermanned Patent Office, having well over 100,000 applications awaiting action, and whose purpose is to promote science and invention and not merely to deny patents, should have forced this applicant to such unusual, burdensome and unreasonable expense as this Appeal, particularly when the District Court has given the only decision to satisfy both the law and justice.

Never in the annuals of the law has an inventor been penalized by being refused a patent because he tried out his invention and left an admittedly experimental embodiment thereof assembled or intact, rather than tear it down or go to the trouble of taking it apart. The law does not require a man to act unreasonably but according to the Solicitor of the Patent Office this is the only way Allen or Blaisdell could have avoided the bar of public use.

It is submitted that the District Court in its judgment was correct, upholding the principles for which it was established and that its decision should be sustained.

Respectfully submitted,

A. Yates Dowell
A. Yates Dowell, Jr.
1345 Pa. Ave., N.W.
Washington 4, D. C.
Attorneys for Appellee